

DISPUTE RESOLUTION SERVICE

D00009818

Decision of Independent Expert

Saveoo.com Ltd

and

Savings.com

1. The Parties:

Complainant: Saveoo.com Ltd
46 Brown Candover
Alresford
Hampshire
SO24 9TN
United Kingdom

Respondent: Savings.com
629 State Street #222
Santa Barbara
0000
United States

2. The Domain Name(s):

savoo.co.uk (“the Domain Name”)

3. Procedural History:

The procedural history is as follows:

18 April 2011 13:01 Dispute received
18 April 2011 13:26 Complaint validated
18 April 2011 13:46 Notification of complaint sent to parties

11 May 2011 05:46 Response reminder sent
12 May 2011 16:07 Response received
12 May 2011 16:08 Notification of response sent to parties
17 May 2011 02:30 Reply reminder sent
19 May 2011 11:58 Reply received
19 May 2011 12:09 Notification of reply sent to parties
19 May 2011 12:10 Mediator appointed
25 May 2011 11:54 Mediation started
27 May 2011 11:37 Mediation failed
27 May 2011 11:51 Close of mediation documents sent
08 June 2011 10:30 Expert decision payment received

4. Factual Background

The Complainant is Saveoo.com Ltd (“Complainant” or “Saveoo”). Saveoo was registered at Companies House on 9 March 2007 and started trading on 1 June 2007. Saveoo is an online business offering consumers new auction methods to make savings on retail products. Complainant registered the domain name <saveoo.co.uk> on 20 April 2007 and the domain name <saveoo.com> on 2 March 2007.

The Domain Name in dispute, <savoo.co.uk>, was registered by the Respondent on 18 February 2009.

The Respondent applied for a Community Trade mark for SAVOO on 14 January 2010 and the mark was registered on 13 July 2010.

5. Parties’ Contentions

(1) Complainant’s Complaint:

The Complainant explains that it is extraordinarily difficult to develop a business name that suggests what your business does and then even more difficult to find domain names to match that name. After a significant amount of time, money and testing, the Complainant chose the term “saveoo”. Complainant believed this to be an excellent name as it can be pronounced in two different ways, one suggesting “to make savings” and the other “to be a savvy shopper”, either of which summarizes what the Complainant’s on-line auction business does and stands for. The Complainant emphasizes that SAVEOO is a made-up word.

The Complainant states that since launching in 2007, Saveoo has gained national media coverage in many publications (some of which are submitted in evidence) including The Sunday Times; Daily Telegraph; Woman and Home Magazine; Readers Digest; Gadget Speak; The Oxford Times; Money Saving Expert; The Digital Fix; and Homes and Bargains Magazine. The Complainant has continuously traded using the name Saveoo and the domain names <saveoo.co.uk> and <saveoo.com> (which resolve to the same web site) for four years. During this time, it has conducted over 12,000 auctions, while over 5,000 dealers/suppliers have registered with Complainant. The Complainant has referred to several search engine reports to show that the term ‘Saveoo’ has become associated with its business. The Complainant alleges that due to its trading activity, media coverage and

on-line presence it has established common law trade mark rights to the SAVEOO name within the UK, while also building an awareness for its <Saveoo.co.uk> and <Saveoo.com> domain names.

The Complainant contends that removing the letter “e” from the term “saveoo” to make it “savoo” does not make a clear distinction between the Respondent’s business and the Complainant’s business. The Complainant explains that if Respondent was in a different field of business, there would be no issue. However, the parties “are both in the field of offering savings to thousands of UK households and businesses”. Thus, there is a severe risk that an Internet user might mistype the name ‘Saveoo’ by entering ‘savoo’ instead. The results returned could mislead users into believing they had arrived at the correct site, even though this would not be the case. Another problematic scenario might involve a potential user who reads about Saveoo or receives a recommendation for its services, but believes it can be spelled as “savoo”, which would again result in the user mistakenly going to the Respondent’s site. The Complainant urges that it is not possible for these two businesses to use the same name simultaneously without some overlapping or incident that is confusing and ultimately misleading to the user. Further, it is entirely possible that emails intended for Saveoo (or vice versa) could end up with the wrong company, which could have very serious consequences.

The Complainant states that having chosen the name SAVEOO, it also developed slogans incorporating this name for use on its web site, such as: “Have you Saveooed”, “They Saveooed!”, “Are you Saveooing?”, and “Saveoo saves U money”. The Complainant states that the Respondent is now using a similar slogan: “Have you Savoo’d today?” The Complainant states that its website predominantly uses the colours white, silver grey and then red as the dominate branding colour, and observes that Respondent’s web site now follows this design and most importantly uses almost the exact shade of red for the Respondent’s dominant branding colour. Design is a key determinant for building online trust with consumers and the Complainant urges that these similarities will only serve to confuse Internet users.

During December 2010, the Complainant was made aware of Respondent’s company called Savoo, which was using the domain <savoo.co.uk>. The name and business model were very similar to the Complainant’s as the Respondent also offers consumers savings on retail products. The CEO of Savoo has stated: “By launching savoo.co.uk as an easy to remember and simple to use site, we hope to bring more savings to thousands more UK households and businesses.” The Complainant emphasizes that this is why “we came up with the word in the first place, because it’s easy to remember, reflects what we do and stand for, and yes, we hope to bring more savings to thousands more UK households and businesses and actually have done since June 2007”. The Complainant emphasizes that Respondent’s use of the word ‘savoo’ dilutes the Complainant’s trade mark and ultimately causes confusion to Internet users.

On 24 March 2011 the Complainant wrote to the Respondent, but received no reply. On 7 April the Complainant followed with another letter and received a reply in which the Complainant claims that the Respondent indicated that it did not consider it was infringing the Complainant’s trade mark.

The Complainant also explains that it went through a corporate reorganization during 2009 to further develop and build the Saveoo brand. Having identified substantial investment funds, it was decided to dissolve its former company and set up a fresh

company to receive the investment. Thus, Saveoo Limited was dissolved on 28 September 2010 while the new successor company, Saveoo.com Limited, was immediately established.

The Complainant alleges that the Respondent was launched in October 2008 as <vouchernetwork.co.uk>, but then rebranded to the Domain Name <Savoo.co.uk> in April 2009. The Complainant also asserts that the Respondent is the sister company to Savings.com, one of the largest voucher sites in the United States, and that the Respondent filed for a trade mark for the term SAVOO on 14 Jan 2010. Considering the resources of the parent company and the use of legal representatives who are specialists in the area of trade marks, Complainant argues that “we consider it very unlikely that they didn’t search for the term ‘saveoo’ and/or were not aware of us. We take the view that they were aware of us and decided to proceed with the name ‘Savoo’. We believe they consider us to be a very small company who would not have the resources to challenge them and this view is reinforced by the fact they never responded to our first letter.”

In sum, the Complainant believes that the Respondent’s Domain Name is too closely similar and its use will only serve to confuse and mislead Internet users. The Complainant requests that the Domain Name be transferred.

(2) Respondent’s Response:

The Respondent challenges whether Complainant has any rights in the term “saveoo” and whether any confusion has been caused.

The Respondent states that the Complainant does not have any registered trade marks or pending applications, and therefore appears to be claiming rights in the unregistered mark SAVEOO. The Respondent contends, however, that the Complaint is confusing in relation to the rights claimed. A UK company, Saveoo Limited, was formed on 9 March 2007 and dissolved on 28 September 2010. The Complainant, Saveoo.com Limited, was formed on 21 December 2009. The Complainant refers to setting up a business in 2007 (which was presumably carried out under the name Saveoo Limited), the dissolved company. Any alleged rights in the name “saveoo” therefore would be owned by that company. In order for the Complainant to bring an action, any rights in that name would have to be transferred to it. There is no indication that the rights have been transferred to Saveoo.com Limited. No assignment has been produced nor any reference to this made in the Complaint. All of the press cuttings produced by the Complainant refer to the period 2007 prior to the incorporation of the Complainant. The only document produced after the incorporation of the Complainant is a letter about the firm RSM Tenon Plc providing corporate finance.

The Respondent further asserts that, in any event, the Complainant has not produced evidence to show that it has rights in the name SAVEOO. No financial turnover figures have been produced in respect of the turnover produced by use of SAVEOO. The Companies House website indicates that Saveoo Limited was a small company before it was dissolved and therefore it is not known what turnover it made, but it must have been small (if any). No accounts have been filed at Companies House by Saveoo.com Limited. In addition, no figures have been given of the amount spent by the Complainant on advertising. All of the other documents produced refer to the launch of a service which does not show reputation.

The Respondent also emphasizes that there is no evidence as to any actual instances of confusion. Furthermore, the Respondent states “Domain Name Holder was not aware of the Complainant before it applied for the Domain Name.” The first it was aware of the Complainant was when it received the letter of 25 March. If the Complainant had had rights in SAVEOO, the Domain Name Holder would have been aware of them. The Complaint therefore does not contain any evidence at all of reputation in the name SAVEOO. It also does not contain any evidence of how the Complainant claims it acquired any rights from Saveoo Limited.

The Respondent stresses that “[t]he Complainant admits in its complaint that [the Respondent] is ‘one of the largest voucher sites in the USA’”, and that the Respondent applied for a Community trade mark registration for SAVOO. The Respondent asserts that it changed the name of an existing UK company to Savoo Limited on 26 October 2009. This was before the date of incorporation of Saveoo.com Limited and therefore before the date the Complainant can have acquired any rights. The Community application for SAVOO was applied for on 14 January 2010 and registered on 13 July 2010.

The Respondent asserts that it is carrying on legitimate trade through the Domain Name. The choice of SAVOO was part of its normal business decisions and was not in any way linked to the Complainant, as the Respondent had no knowledge of the Complainant until receiving the Complainant’s letter.

The Respondent is the owner of the following domain names:-

Savoo.compare.co.uk
Savoo-compare.com
Savoo.be
Savoo.com
Savoo.de
Savoo.es
Savoo.eu
Savoo.in
Savoo.it
Savoo.mobi
Savoo.ml
Savoocompare.co.uk
Savoocompare.com
Savoodev.co.uk
Savoostaging.co.uk

All of the above factors (the trade through the website, the Community registered trade mark, the domain names) show that SAVOO is a legitimate business carried on by what the Complainant concedes is one of the “one of the largest voucher sites in the US”.

The Respondent refers to the non-exclusive list of factors for considering whether a Domain Name is an Abusive Registration. The Respondent asserts that it did not register the Domain Name to sell or otherwise transfer it to the Complainant or a competitor of the Complainant, as a blocking registration, or for the purpose of unfairly disrupting the business of the Complainant. As stated above, the Savoo business is part of the legitimate business of the Respondent and the Respondent is using the Domain Name. The Respondent also asserts that it is not using the Domain Name in such a way that there is

confusion with the Complainant. As stated above, the Complainant has no reputation in the name, Saveoo. Finally, the Respondent is not engaged in a pattern of registrations in which it has no rights.

In conclusion, the Respondent contends that the Complainant has no rights in the name Saveoo, and that the Domain Name is not an Abusive Registration.

Complainant's Reply:

The Complainant replies to explain that Saveoo Ltd (the former entity) assigned "the benefit and ownership" of the domain name <saveoo.co.uk> to the new company Saveoo.com Ltd before the first company was dissolved. This was part of its business decision in line with further funding the company, and was taken with advice from their accountants and corporate advisors RSM Tenon Plc and Browne Jacobson LLP solicitors. The Complainant has submitted evidence of this assignment dated 3 February 2010, and ownership of the <saveoo.co.uk> domain name was transferred by Nominet to the company Saveoo.com Ltd.

The Complainant also explains that Saveoo Ltd was classified by Companies House as a small company and need not produce audited accounts, in accordance with the Companies Act. The Complainant asserts that its accountants and corporate advisors, RSM Tenon Plc, can confirm the business investment to be in excess of £200,000 and while Savoo may consider this a small sum, the Complainant does not. The Complainant also argues that the Respondent has not filed any accounts and furthermore has a share value of just £1,000.

The Complainant also contends that the Respondent is using the Domain Name in a way that will confuse people into believing that the Domain Name is registered to, operated or authorised by, or otherwise connected with Saveoo. In support of this, the Complainant emphasises that Domain Name <savoo.co.uk> is virtually identical to the trading name of Saveoo and therefore inherently likely to cause people to go to the Respondent's website, believing it to be the website of the Complainant.

Finally, the Complainant argues that the Respondent is owned by Savings.com and considering their resources and legal representation in the field of intellectual property, it should have been more diligent in checking the online marketplace before proceeding to use the Domain Name Savoo. When the Complainant invented the word SAVEOO, it spent considerable time searching for all variations of that word by placing and/or adding and deleting letters for similarity. Finally, the Complainant states that while Savoo produced a long list of additional domain names held by them, all but three of the domain names are parked, as follows:

Savoo.compare.co.uk	Parked domain
Savoo-compare.com	Parked domain
Savoo.be	Parked domain
Savoo.com	Main site
Savoo.de	Parked domain
Savoo.es	Parked domain
Savoo.eu	Parked domain
Savoo.in	Parked domain
Savoo.it	Parked domain

Savoo.mobi	Parked domain
Savoo.mi	Redirect
Savoo.compare.co.uk	Redirect
Savoocompare.com	Parked domain
Savoodev.co.uk	Parked domain
Savoo.staging.co.uk	Parked domain

6. Discussions and Findings

The Complainant is required under subparagraphs 2a. and 2b. of the Policy to prove to the Expert on the balance of probabilities both:

- that it has Rights in respect of a name or mark which is identical or similar to the Domain Name; and
- that the Domain Name, in the hands of the Respondent, is an Abusive Registration.

Rights in a Name or Mark which is Identical or Similar to the Domain Name

The objective behind this first element is simply to demonstrate that a complainant has a *bona fide* basis for submitting a complaint.

In this case the Expert finds that the Domain Name <Savoo.co.uk>, with the omission only of the letter “e” when compared to the Complainant’s name Saveoo, is manifestly identical or similar to the Complainant’s name.

The more difficult question, however, is whether the Complainant has established Rights in the Saveoo name. “Rights” are defined under the Policy to mean “rights enforceable by the Complainant, whether under English law or otherwise, and may include rights in descriptive terms which have acquired a secondary meaning.” Furthermore, the Procedure states in paragraph 16(a) that “[t]he Expert will decide a complaint on the basis of the Parties’ submissions, the Policy and the Procedure”. As such, the Expert must consider whether the Complainant’s submissions and any evidence are sufficient to demonstrate, on the balance of probabilities, that the Complainant has established Rights in its name.

When a complainant relies on an unregistered trade mark right, as is the case here, it is important that sufficient evidence is put before the Expert to demonstrate the existence of the right. This can include evidence to show that (a) the Complainant has used the name or mark in question for a not insignificant period and to a not insignificant degree (e.g., by way of sales figures, company accounts, etc.) and (b) the name or mark in question is recognised by the purchasing public as indicating the goods or services of the Complainant (e.g., by way of advertisements and advertising and promotional expenditure, correspondence or orders or invoices from third parties, and third party editorial matter such as press cuttings and search engine results).

Here, the Expert is of the view that the extent of any reputation or goodwill relied upon by the Complainant to establish Rights is not extensive, and this has an impact on the Expert’s later reasoning. See Wise Insurance Services Limited v. Tagnames Limited, Nominet DRS Appeal No. 4889. In particular, the mere registration of a company name at Companies House does not of itself give rise to sufficient Rights under the Policy.

Moreover, there is little or no evidence offered by the Complainant to show how its business has been marketed and reputation achieved among the relevant public, other than some early press clippings dating from 2007 and 2008 and several search engine results. In addition, there is little evidence of the Complainant's business turnover or scale of operations.

On the other hand, the Complainant has had a presence on the Internet at the domain names <saveoo.co.uk> and <saveoo.com> and commenced trading under the name "Saveoo" in 2007, having tried to invent a new name that was suggestive of the Complainant's on-line reverse auction business. A quick look at the Complainant's website suggests that it operates a genuine business, but we do not know how successful it has been. At a minimum, the Expert accepts the unchallenged assertion by the Complainant that it has continuously traded under the Saveoo name for the last 4 years, and there is also no challenge to the Complainant's claims to have conducted over 12,000 auctions, with over 5,000 dealers/suppliers registered with it. But despite these points, there remains insufficient evidence submitted in this case from which to judge the full scope of the Complainant's goodwill and reputation.

The Respondent has challenged whether the Complainant, which is a different corporate entity from the company that initially used the Saveoo name, has rights in the name as there was no indication in the Complaint that relevant rights had been transferred from the initial legal entity, Saveoo Ltd, to the Complainant. The Complainant responded in its Reply that it was restructured in order to receive additional investment, and submitted a copy of an assignment of "the benefit and ownership" of the domain name <saveoo.co.uk>, which corresponds to the Saveoo name. The Expert considers that there is no serious question that the Complainant is the proper legal successor to the initial company Saveoo Ltd and its name, despite the poor transactional approach as reflected in the assignment submitted in this case to demonstrate that a transfer of all rights (including goodwill) was properly completed.

Based upon the limited evidence provided by the Complainant to support its unregistered rights in the Saveoo name, the Expert is of the opinion that whilst the Complainant has sufficient Rights to submit its Complaint, those Rights are not particularly strong. The first requirement of the Policy has accordingly been met.

Abusive Registration

The Complainant has done enough to pass the first hurdle under the Policy and the Expert now turns to whether or not the Domain Name is an Abusive Registration in the hands of the Respondent. An Abusive Registration is defined in the Policy to mean a Domain Name which either:

- 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
- has been used in a manner which took unfair advantage of or was unfairly detrimental to the Complainant's Rights.

In this case the Respondent has denied knowledge of the Complainant at the time of registration of the Domain Name and up until the time of receiving the first letter from

the Complainant on 25 March 2011. This is really the key issue in this case. The question of whether the Respondent had knowledge of the Complainant when it registered the Domain Name in February 2009 is relevant not only to whether that registration took unfair advantage of the Complainant's rights, but also whether the subsequent use of the Domain Name by the Respondent was aimed at taking unfair advantage of the Complainant's Rights.

The Complainant contends that the Respondent has been using the virtually identical Domain Name in a manner that falls within paragraph 3(a)(ii) of the Policy by confusing people into believing that the Domain Name is registered to, operated or authorised by, or otherwise connected with the Complainant. Despite risks of confusion that might exist given the close similarity in the spelling between the Domain Name and the Complainant's name, and the similar manner in which the businesses of the Complainant and the Respondent operate, the Expert shares the view adopted by other Experts that paragraph 3(a)(ii) does not bite unless at the time of the allegedly abusive use in question, the Respondent had the Complainant and/or its name or mark in mind.

In this case, given the limited extent of the Complainant's goodwill as discussed above, and the fact that the Complainant has not applied for trade mark protection in any jurisdiction, the denial by the Respondent appears to the Expert to be genuine and reasonable. The Complainant argues that the Respondent is owned by Savings.com and considering their resources and legal representation, it should have been more diligent in checking the online marketplace before proceeding to choose the disputed Domain Name. However, even if the Respondent had performed searches in relevant trade mark databases, it would not have discovered the Complainant. The Respondent's principal business appears to be located in the United States, and there are insufficient grounds for suspicion such that imputing constructive notice to the Respondent would be proper in this case. In view of the denial of the Respondent and the lack of any substantial evidence to the contrary, the Expert finds that there is insufficient evidence to justify a finding that the Domain Name was registered or otherwise acquired in a manner which took unfair advantage of the Complainant's Rights.

Finally, because the Expert has insufficient grounds to disbelieve the Respondent's claim to have had no knowledge of the Complainant at the relevant time, the Respondent's use of the Domain Name in its business can be considered, under paragraph 4(a)(i)(A) of the Policy, as use taking place before being aware of the Complainant's cause for complaint "in connection with a genuine offering of goods or services". Such use is thus a defense against the finding of Abusive Registration.

Accordingly, in view of the Expert's determination that the Complainant's Rights in its Saveoo name are not particularly strong and the finding of likely genuine ignorance on the part of the Respondent, the Complainant has failed to satisfy the Expert that the Domain Name in the hands of the Respondent is an Abusive Registration.

7. Decision

The Complaint is dismissed.

Signed: Chris Gibson

Dated: 22 July 2011