

## DISPUTE RESOLUTION SERVICE

D00011264

Decision of Independent Expert

Last Minute Network Limited

and

last minute liverpool

### 1. The Parties:

Complainant: Last Minute Network Limited  
77 Hatton Garden  
London  
EC1N 8JS  
United Kingdom

Respondent: last minute liverpool  
19 cornwallis street  
liverpool  
merseyside  
L1 5DG  
United Kingdom

### 2. The Domain Name:

lastminuteliverpool.co.uk

### 3. Procedural History:

06 August 2012 16:01 Dispute received  
07 August 2012 13:05 Complaint validated  
07 August 2012 13:17 Notification of complaint sent to parties

27 August 2012 02:30 Response reminder sent  
30 August 2012 12:08 No Response Received  
30 August 2012 12:10 Notification of no response sent to parties  
05 September 2012 13:52 Expert decision payment received

#### **4. Factual Background**

The Nominet records show that the Domain Name was registered on 22 October 2011.

Based on the Complainant's submissions (see section 5 below) and a review of the materials annexed to the Complaint, set out below are the main contentions which I have accepted as fact in reaching a decision in this case:

- a. The Complainant has operated under the lastminute.com name on a substantial scale for over 10 years in the travel and related leisure services sector, and is well-known under that name.
- b. The Complainant operates via its website [www.lastminute.com](http://www.lastminute.com) and also owns the domain name lastminute.co.uk.
- c. The Complainant is the proprietor of several UK trade mark registrations for LASTMINUTE and LASTMINUTE.COM.
- d. The Complainant has not authorised the Respondent to register or use the Domain Name.
- e. Shortly after registering the Domain Name, the Respondent sent an email to hotels in Liverpool, asking for price lists and referring to the success of the Complainant.

#### **5. Parties' Contentions**

##### Complaint

The Complainant's submissions are set out below.

*The Complainant has rights in the Domain Name because:*

- (1) *The Complainant was incorporated on 1 April 1998 and has been trading continuously under its "lastminute.com" and "lastminute" trade marks since 1998. (A summary of results of a search using the Internet Archive Wayback Machine are annexed to the Complaint to illustrate the Complainant's longstanding and continuous internet trading presence.)*
- (2) *The Complainant is one of the UK's leading providers of online travel services and related leisure services. It operates via its website*

*www.lastminute.com. The domain name lastminute.co.uk is also owned by the Complainant.*

- (3) The Complainant is the owner of the following registered United Kingdom trade marks: No. 2481359 lastminute.com in Classes 1 to 45 inclusive; No. 2481352 LASTMINUTE in Classes 1-38, 40-42, 44 and 45; No. 2481325 lastminute in Classes 1-38, 40-42, 44 and 45; No. 2359399 LASTMINUTE.COM in Classes 39, 41 and 43; and No.2314058 lastminute.com in Classes 35, 38, 39, 41, 42 and 43.*
- (4) The Complainant has 1.65 million visitors to its website every week and sold 578,000 airline tickets to 1300 destinations worldwide last year. It has over 50,000 hotels available on its website worldwide and a booking via lastminute.com is made approximately every 15 minutes.*
- (5) The Complainant regularly wins travel awards. In 2011 it won the Best Holiday Attraction/Ticket Provider at the British Travel Awards. (Details of some of the awards it has won are annexed to the Complaint.)*

*The Domain Name in the hands of the Respondent is abusive because:*

- (1) There is no relationship between the Complainant and Respondent and the Complainant has not authorised the Respondent to use their trade mark "lastminute". The Domain Name is not currently in use.*
- (2) The Domain Name in the hands of the Respondent is abusive because it has been used and is likely to be used in a way that 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.*
- (3) On 25 October 2011, the Respondent sent an email to various hotels in Liverpool that are hotel partners of the Complainant. The email asked for price lists to be supplied and referred to the success of the Complainant stating "As you have probably seen the success of lastminute.com we are launching last minute sites specifically to certain cities". (A copy of the 25 October 2011 email is annexed to the Complaint.) The Complainant was made aware of the matter because the email was forwarded by one of the hotel partners to the Complainant to check whether there was a connection with lastminute.com.*
- (4) Not only is use of the Domain Name likely to cause consumer confusion, such use seeks to gain an unfair advantage based on the Complainant's longstanding use of and goodwill in its "lastminute" and "lastminute.com" trade marks. It is clear from this email that the Respondent intends to rely on the Complainant's reputation in order to launch its own new business and that there is the potential for serious customer confusion, both on the part of trade customers, such as hotels, and ultimate customers making bookings through the website.*

- (5) *The Respondent was made aware of the Complainant's concerns in a cease and desist letter sent dated 7 November 2011 and has failed to provide the letter of undertaking requested or to surrender the Domain Name.*
- (6) *Mr Effiong of Last Minute Liverpool Limited telephoned the Complainant's legal representative on 7 November 2011 confirming receipt of the cease and desist letter and verbally acknowledged that the reference in his email of 25 October 2011 was "wrong".*
- (7) *An email reminder was sent to Mr Effiong on 15 November 2011, regarding the need for a substantive reply and provision of the letter of undertaking. An email reply was received on 17 November 2011 (a copy of which is annexed), which acknowledges that the reference in the email of 25 October 2011 to "lastminute.com" was a reference to the Complainant.*

#### Response

No Response has been submitted by the Respondent.

## **6. Discussions and Findings**

### General

Paragraph 2 of the Policy provides that, to be successful, the Complainant must prove on the balance of probabilities that:

- i it has 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 (as defined in paragraph 1 of the Policy).*

### Complainant's Rights

In light of the factual findings set out in section 4 above, it is clear that the Complainant has Rights in the nature of legally protectable goodwill in the name lastminute.com; as well as Rights in the nature of registered trade marks in relation to LASTMINUTE and LASTMINUTE.COM. Disregarding the generic .co.uk suffix, and making allowance for the fact that the "liverpool" element of the Domain Name is descriptive, the Domain Name is very similar to the name and marks in which the Complainant has Rights.

I therefore find that the first limb of paragraph 2 of the Policy is satisfied.

### Abusive Registration

Paragraph 1 of the Policy defines an "Abusive Registration" as:

*"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 has been used in a manner which has taken unfair advantage of or has been unfairly detrimental to the Complainant's Rights."*

Paragraph 3 of the Policy sets out a non-exhaustive list of factors which may be evidence that a Domain Name is an Abusive Registration. The main factor under paragraph 3a on which the Complainant relies in this case is as follows:

- " 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 Complainant;"*

In considering whether the Domain Name is an Abusive Registration, I take into account that the Complainant's name lastminute.com is well-known and one of which the Respondent has shown it was aware at the time when the Domain Name was registered and during its subsequent use. Set out below is the full text of the email which the Respondent sent to hotels in Liverpool three days after registering the Domain Name:

*"As you have probably seen the success of lastminute.com we are launching last minute sites specifically to certain cities. Lastminuteliverpool.co.uk is launching in 10 days time.*

*1 thing that people want last minute in Liverpool is a hotel so all we are asking of the hotels is price on the rooms minus their laterooms or bookings.com premium that they will put on top so we can sell them on for you.*

*If you have any other services that you would like to offer please let me know by emailing myself Emmanuel. I look forward to hearing from you over the next few days as the sooner you let us know the sooner we can get you on the site in time for our launch.*

*Sent from Last minute Liverpool LTD"*

The content of this email is very relevant for a number of reasons. First, it shows clearly that the Respondent was fully aware of the Complainant. Second, it shows the Respondent's intention to operate in exactly the same field as the Complainant (and not, for example, as a site dedicated to goals scored in the last minute by Liverpool Football Club). Third, the Respondent does not seek in any way to make clear that it has no connection with the Complainant. In fact, the reverse is the case since the wording of the email strongly suggests that it is sent by the Complainant or by a connected company.

In other words, the way in which the Respondent has used the Domain Name, evidenced by this email, is likely to have confused people into believing that the Domain Name is operated by or connected with the Complainant, when this is not in fact the case. This falls squarely within the factor under paragraph 3a<sup>ii</sup> set out above.

It is highly pertinent that the Respondent's intention is to use the Domain Name to operate in precisely the same sector as the Complainant, running in effect a city-specific version of the Complainant's business. Putting on one side for now the wording of the Respondent's email, someone operating a city-specific travel bookings website consisting of the name Lastminute followed by the name of the city is, in my opinion, very likely to cause people to believe that the website is connected with the Complainant's lastminute.com business.

Looking at the wording of the Respondent's own email to the hotels, it is clear to me that the Respondent was setting out deliberately to create the impression of either being, or being connected with, the Complainant. If someone sets out with such an intention, it is reasonable to assume that they will succeed to at least some degree. Indeed, at least one hotel contacted the Complainant to ask whether there was a connection with the Complainant.

Needless to say, if some people are confused in this way, the Respondent will gain an advantage because it will be more likely to sign up hotels and other businesses to its website and more likely to generate business from people accessing and using the site to make bookings. Put another way, the Respondent is riding on the coat-tails of the reputation established by the Complainant by many years of successful trading. That kind of advantage is obviously unfair.

Taking all of the above into account, it is clear that the Respondent's use of the Domain Name has taken unfair advantage of the Complainant's rights, and that the Domain Name is therefore an Abusive Registration.

## **7. Decision**

Having found that the Complainant has rights in respect of a name and marks which are similar to the Domain Name, and that the Domain Name in the hands of the Respondent is an Abusive Registration, the Expert directs that the Domain Name *lastminuteliverpool.co.uk* be transferred to the Complainant.

**Signed Jason W.D. Rawkins**

**Dated: 2 October 2012**