

DISPUTE RESOLUTION SERVICE

D00012913

Decision of Independent Expert

Morgans Group LLC

and

Garry

1. The Parties:

Lead Complainant: Morgans Group LLC
475 10th Avenue
11th Floor
New York
NY 10018
United States

Respondent: Garry
16, Burutu Street
Burutu
Bayelsa
101286
Nigeria

2. The Domain Name(s):

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

3. Procedural History:

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 a such a nature as to call in to question my independence in the eyes of one or both of the parties.

06 June 2013 17:06 Dispute received

07 June 2013 10:14 Complaint validated
07 June 2013 10:23 Notification of complaint sent to parties
26 June 2013 02:30 Response reminder sent
01 July 2013 10:04 No Response Received
01 July 2013 10:05 Notification of no response sent to parties
11 July 2013 02:30 Summary/full fee reminder sent
11 July 2013 09:17 Expert decision payment received

4. Factual Background

- 4.1 The Complainant is a company which operates boutique hotels worldwide, including in London (UK).
- 4.2 The Complainant is the owner of a number of trade marks including Community Trade Mark number 009258997 for the word mark SANDERSON, which was filed on 20 July 2010 and a Community Trade Mark number 001496215 for the word mark SANDERSON HOTEL, which was filed on 1 February 2000.
- 4.3 The Complainant is the owner of the domain name sandersonlondon.com which promotes the Complainant's services and/or its hotel in London. The domain name was registered on 13 May 2005.
- 4.4 The Respondent is an individual based in Nigeria who registered the Domain Name on 3 December 2012.
- 4.5 The Domain Name points to a parking page which contains sponsored links relating to domain names.

5. Parties' Contentions

- 5.1 The Complainant contends that it has rights in a name or mark which is similar or identical to the Domain Name for the following reasons:
 - 5.1.1 The Complainant has operated the Sanderson in London under the name SANDERSON or SANDERSON HOTEL since the hotel's opening in April 2000;
 - 5.1.2 The Complainant is the owner of several trade marks which include or consist of the mark SANDERSON. These include Community Trade Mark number 009258997 for the word mark SANDERSON, Community Trade Mark number 001496215 for the word mark SANDERSON HOTEL and UK Trade Mark number 2204608 for the word mark SANDERSON HOTEL.
 - 5.1.3 The Complainant is the owner of the domain name sandersonlondon.com which incorporates the Complainant's trade marks in its entirety and differs only by the addition of ".com".

- 5.1.4 The Complainant has expended a significant amount of time, effort and revenue in promoting and marketing its hotel. For example, the Complainant has purchased Google adwords so that its website appears as a sponsored advert in Google search results and has also purchased keywords on Bing and Yahoo. The Complainant has also purchased advertising space for the Sanderson in various on-line and print publications and has negotiated arrangements with numerous leading hotel booking companies who offer hotel stays at the Sanderson on their websites;
- 5.1.5 When a search is carried out in the Google search engine for “Sanderson London” and “Sanderson London Hotel”, the Complainant’s domain name come out top of the searches and subsequent hits relate to the Complainant’s hotel;
- 5.1.6 As a result of the above, the Complainant has acquired a substantial reputation and goodwill in the UK associated with the names and marks: SANDERSON, SANDERSON HOTEL, SANDERSON LONDON and SANDERSON LONDON HOTEL.
- 5.2 The Complainant contends that the Domain Name is an Abusive Registration for the following reasons:
- 5.2.1 The Domain Name was registered for the purposes of, and is being used by the Respondent for, an elaborate fraudulent scam;
- 5.2.2 the Domain Name is identical and/or confusingly similar to the Complainant’s name and marks;
- 5.2.3 the Domain Name was registered and has been used in a manner which took unfair advantage of and was unfairly detrimental to the Complainant’s rights;
- 5.2.4 The Respondent has engaged in a pattern of domain name registrations where the domain names correspond to well known names and/or trade marks in which the Respondent has no apparent rights. The Domain Name in question is part of that pattern.
- 5.2.5 The Domain Name has been used by the Respondent in such a way, namely to advertise employment opportunities at the Complainant’s London hotel, so that members of the public are misled into believing that the advertisements are being made by the Complainant when such is not the case. This has confused people into thinking that the Domain Name is controlled by the Complainant. The position can be outlined as follows:
- 5.2.5.1 The Respondent has set up the email address: recruitment@sandersonlondonhotel.co.uk at the Domain Name. Using this email address, the Respondent emailed various people who had posted their resumes on various

websites informing them that they were being considered for a position at the Complainant's London hotel. The email attached two documents: a 'Sanderson London Employment Application' and a 'Sanderson London On-line Interview Questionnaire', both of which request details of the recipients' personal information. The forms also contained the Complainant's address as well as a photograph which appears to be the same as that on the Complainant's website. In addition, the email is purported to be sent from a Regional HR Manager of the Complainant's hotel group. The name adopted is a genuine employee of the Complainant;

5.2.5.2 After the forms have been completed by the recipients, the Respondent would email the recipients stating that their application was being reviewed and that shortlisted candidates would be emailed shortly;

5.2.5.3 The Respondent would then email the recipients from the same email address purportedly offering a job at the Sanderson London Hotel. The email contained a document purporting to be a 'Sanderson London Contract Terms of Agreement' which the recipients are asked to sign and return. The email also explained the need for recipients to pay an Accommodation Registration Fee for compulsory accommodation at the Sanderson London Housing Quarters. Fees for the "accommodation packages" ranged from £845.25 - £1,520.25. Again the contract contained a photograph which appears to have been taken from the Complainant's website;

5.2.5.4 After the recipients have paid the Accommodation Registration Fee, the Respondent directed the recipients to correspond with Rob Milligan purportedly at HMRC using the email address rob.milligan@hmrcgroup.co.uk whereby the recipients are asked to pay £894.50 for a Foreign Affairs Certificate. The registrant of the domain name hmrcgroup.co.uk is the Respondent;

5.2.5.5 The recipients then received emails from info.delivery@greyhoundcourier.co.uk requesting payments purportedly from Greyhound Couriers Limited for the courier fees for the delivery of various documents, including the Foreign Affairs Certificate. The registrant of the domain name greyhoundcouriers.co.uk is the Respondent;

5.2.5.6 The Complainant became aware of the Respondent's activities when victims contacted the Complainant in March 2013.

5.2.6 The Respondent has not submitted a Response.

6. Discussions and Findings

6.1 Paragraph 2(a) of Nominet's Dispute Resolution Policy ("the Policy") requires that the Complainant must prove, on the balance of probabilities, that:

- i. *The Complainant 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.*

6.2 As a first step I must therefore decide whether the Complainant has Rights in respect of a name or mark which is identical or similar to the Domain Name.

6.3 The definition of Rights in the Policy is 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.

6.4 This has always been treated in decisions under Nominet's DRS as a test with a low threshold to overcome and I think that must be the correct approach.

6.5 There can be no doubt that the Complainant has Rights in the word or mark SANDERSON or SANDERSON HOTEL in relation to hotel services, hospitality and such like.

6.6 The Domain Name also includes the word in which the Complainant has Rights, i.e. the name or mark SANDERSON in its entirety. Further, it seems to me that the name or mark SANDERSON is also the dominant or distinctive part of the Domain Name with the words LONDON and HOTEL being more descriptive. I therefore conclude that on the balance of probabilities the Complainant has Rights in a name or mark which is identical or similar to the Domain Name.

Abusive Registration

6.7 Abusive Registration is defined in Paragraph 1 of the Policy 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 took unfair advantage of or was unfairly detrimental to the Complainant's Rights.*
- 6.8 This definition allows me to consider whether the Domain Name is an Abusive Registration either at the time of registration/acquisition or subsequently through the use that was made of it.
- 6.9 Paragraph 3 of the Policy provides a non-exhaustive list of the factors which may evidence that a Domain Name is an Abusive Registration and Paragraph 4 of the Policy provides a non-exhaustive list of the factors which may evidence that the Domain Name is not an Abusive Registration.
- 6.10 The Policy provides for the Complainant to prove, on the balance of probabilities, that the Domain Name is an Abusive Registration. The burden of proof is therefore firmly on the Complainant.
- 6.11 The Complainant's case is, inter alia that the Respondent has registered and used the Domain Name to take unfair advantage of the Complainant's name or mark and has misled members of the public into thinking that the Domain Name is operated by the Complainant.
- 6.12 The Complainant's evidence is that the Respondent has used the Domain Name as part of an elaborate fraudulent scam. This scam involves the Respondent posing as the Complainant and accepting money from members of the public as part of an upfront accommodation fee in connection with a false employment offer. This evidence is not challenged by the Respondent who has not filed a Response and I therefore accept that on the balance of probabilities the Respondent is acting in a manner which takes unfair advantage of and which is unfairly detrimental to the Complainant's Rights.
- 6.13 I am therefore satisfied that the Complainant has established, on the balance of probabilities, that the Domain Name is an Abusive Registration. That of course is not the end of the story and I would now normally look at what the Respondent has said in Response and decide whether the Respondent has rebutted this presumption that the Domain Name is an Abusive Registration. However, in this case, no Response has been submitted and there is nothing further for me to consider.
- 6.14 Therefore on the balance of probabilities, I am persuaded that the Domain Name is an Abusive Registration.

7. Decision

- 7.1 I find that, on the balance of probabilities, the Complainant has Rights in a name or mark which is identical or similar to the Domain Name and that the Domain Name is in the hands of the Respondent an Abusive Registration. I

therefore direct that the Domain Name be transferred to the Complainant.

Signed : Nick Phillips

Dated 5th August 2013