

DISPUTE RESOLUTION SERVICE

D00008453

Decision of Independent Expert

Bharat Travel Limited

and

New Bharat Coaches Ltd

1. The Parties:

Complainant: Bharat Travel Limited
147 Firs Drive
Cranford
Hounslow
Middlesex
TW5 9TB
United Kingdom

Respondent: New Bharat Coaches Ltd
11 Laburnum Grove
Hounslow
Middlesex
TW3 3LU
United Kingdom

2. The Domain Name:

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

26 August 2014 17:00 Dispute received
27 August 2014 09:13 Complaint validated
27 August 2014 12:17 Notification of complaint sent to parties
01 September 2014 09:20 Response received
01 September 2014 09:20 Notification of response sent to parties
04 September 2014 02:30 Reply reminder sent
05 September 2014 11:39 Reply received
05 September 2014 11:42 Notification of reply sent to parties
05 September 2014 11:42 Mediator appointed
10 September 2014 14:07 Mediation started
29 September 2014 14:28 Mediation failed
29 September 2014 14:38 Close of mediation documents sent
09 October 2014 02:30 Complainant full fee reminder sent
10 October 2014 14:13 Expert decision payment received

4. Factual Background

The Complainant and the Respondent operate directly competing passenger coach businesses based in the same area of Southall, London.

The Respondent was incorporated in 1983 and has always traded under the name "New Bharat Coaches" or similar.

The Complainant was incorporated in 1997 by Mrs Balbir Dhillon, a former director of the Respondent. The Complainant initially traded under the name "Bharat Travel" or similar. In 2002 the Complainant started trading under the name "Dhillon of London".

On 8 March 2005, the Complainant registered dhillonoflondon.com and set up a website at that domain name.

On 29 April 2005, the Respondent registered the Domain Name. At some point thereafter, the Respondent redirected the Domain Name to its own website at www.newbharat.co.uk.

The Complainant owns UK registered trade mark no. 2534806 for the word "DHILLON" in class 39 in respect of "Transport; travel arrangement; passenger coach services; arranging of coach tours and coach travel; coach hire", filed on 18 December 2009.

5. Outstanding Procedural Issue

The "Response" is in the form of an email to Nominet which did not comply with various formal requirements specified in paragraph 5c of DRS Procedure, including the requirement for a Statement of Truth.

Paragraph 15c of the DRS Procedure states that if, in the absence of exceptional circumstances, a party does not comply with the procedure, the expert will draw such inferences from the party's non-compliance as he or she considers appropriate. Paragraph 12b of the Procedure states: "The Expert shall determine the admissibility, relevance, materiality and weight of the evidence."

I will treat the email as a formal Response but I will bear in mind the lack of a Statement of Truth insofar as it is necessary for me to consider the veracity of the matters asserted in the email.

6. Parties' Contentions

Complaint

As to rights, the Complainant relies on its registered trade mark for DHILLON.

The following is a summary of the Complainant's submissions regarding abusive registration.

The fact that the parties are competitors based in the same area of Southall and the close historic link between the families who own their respective businesses are *prima facie* evidence that the Respondent was aware of the Complainant's rights when it registered the Domain Name.

Registration of the Domain Name infringes the Complainant's registered trade mark.

The Respondent has used the Domain Name to confuse customers by diverting the Domain Name to its own site.

The Respondent has deliberately sought to disrupt fair competition between the parties, and profit, by confusing internet users into thinking that the parties are connected.

Response

The Response simply consists of the following brief email addressed to Nominet:

"Dear Sir,

We are responding to your complaint and defending it.

We have owned dhillonoflonon.co.uk for nearly 10 years as exactly the same time your client as owned their .com. At no time has any complaint been received in all these years.

Prior to 2005 the words dhillonoflondon were not registered as trade marks or patents by your clients. As also they are common names.

So we are free to own them and use them, should your client wish to buy the domain number from us. We would consider significant offers.

*best regards,
T S Dhaliwal”*

Reply

In its Reply, the Complainant draws attention to the Respondent’s admission that it registered the Domain Name at the same time as the Complainant rebranded its business, saying that this adds weight to the Complainant’s assertion that the Respondent deliberately registered the Domain Name to cause confusion.

7. Discussions and Findings

General

To succeed, the Complainant has to prove in accordance with paragraph 2 of the DRS Policy on the balance of probabilities, first, that it has rights (as defined in paragraph 1 of the DRS Policy) in respect of a name or mark identical or similar to the Domain Name and, second, that the Domain Name, in the hands of the Respondent, is an abusive registration (as defined in paragraph 1 of the DRS Policy).

Complainant’s rights

The meaning of “rights” is clarified and defined in the DRS Policy in the following terms:

“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”

First, the Complainant has rights in the term “DHILLON” based on its registered trade mark.

This conclusion is not altered by the fact that the trade mark was registered after the Domain Name. It is well established under the DRS that the relevant date for assessment of rights is the date when the Complaint was filed, although of course the timing of acquisition of rights is potentially relevant to the issue of abusive registration.

In my view the trade mark is similar to the Domain Name. The first and dominant term in the Domain Name is the word "Dhillon"; the additional geographical / descriptive term "of London" simply indicates that "Dhillon" is located in London and is therefore far from sufficient to differentiate the Domain Name and trade mark.

Second, the Complainant has supplied some evidence of its trading activity by reference to the name "Dhillon of London". Although the evidence is limited, given that the Respondent does not dispute that the Complainant has been trading under that name for many years, and that rights is generally held to be a low threshold test under the DRS, I conclude that that the Complainant has established unregistered rights in the name "Dhillon of London", which is identical to the Domain Name.

The Complainant has therefore established rights in a name or mark which is identical or similar to the Domain Name.

Abusive registration

Is the Domain Name an abusive registration in the hands of the Respondent? Paragraph 1 of the DRS Policy defines "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 took unfair advantage of or was unfairly detrimental to the Complainant's Rights."*

For the reasons set out below I have little difficulty in concluding that the Domain Name has been registered and used abusively and therefore constitutes an abusive registration under both limbs of the test

Acquisition in an abusive manner

It is plain that, since it started, the Complainant's business has been very well known to the Respondent. The parties are direct competitors, located very close to each other in London, and have long-standing family connections - as outlined in section 4 above. The Respondent registered the Domain Name reflecting the Complainant's trading name within six weeks or so of the Complainant's registration of the .com version of its name. This can only have been intended to target the Respondent's business.

The Respondent observes that in 2005, when it registered the Domain Name, the term "Dhillon of London" had not been registered as a trade mark. However, it

suffices for abusive registration if the Respondent registered the Domain Name to target the Complainant's unregistered rights. The Respondent does not dispute that, at the time of registration of the Domain Name, the Complainant had been trading under its name for some three years. Nor does the Respondent deny that it was aware of this fact when it registered the Domain Name.

The Respondent claims that the name "Dhillon of London" comprises common terms. While the individual words may indeed be common, there is no reason to think that the combined term is common. Certainly, there is no evidence from the Respondent to that effect. In any case, I am satisfied that the Respondent did not register the Domain Name because it comprised a number of common terms but, rather, because it comprised the name of the Respondent's very close competitor.

Use in an abusive manner

Furthermore, the Respondent has used the Domain Name abusively by redirecting it to its own site.

Paragraph 3a(ii) of the Policy identifies the following as one of the non-exhaustive factors which may be evidence that a domain name is an abusive registration:

"ii. [c]ircumstances 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"

One form of confusion, known as "initial interest confusion", is explained as follows in paragraph 3.3 of the DRS Experts' Overview on Nominet's website:

"Commonly, Internet users will visit web sites either by way of search engines or by guessing the relevant URL. If the domain name in dispute is identical to the name of the Complainant and that name cannot sensibly refer to anyone else, there is bound to be a severe risk that a search engine, which is being asked for the Complainant, will produce high up on its list the URL for the web site connected to the domain name in issue. Similarly, there is bound to be a severe risk that an Internet user guessing the URL for the Complainant's web site will use the domain name for that purpose.

In such cases, the speculative visitor to the registrant's web site will be visiting it in the hope and expectation that the web site is a web site "operated or authorised by, or otherwise connected with the Complainant." This is what is known as 'initial interest confusion' and the overwhelming majority of Experts view it as a possible basis for a finding of Abusive Registration, the vice being that even if it is immediately apparent to the visitor to the web site that the site is not in any way connected with the Complainant, the visitor has been deceived. Having drawn the visitor to the site, the visitor may well be faced with an unauthorised tribute or criticism site (usually the latter) devoted to the Complainant; or a commercial web

site, which may or may not advertise goods or services similar to those produced by the Complainant. Either way, the visitor will have been sucked in/deceived by the domain name.

Findings of Abusive Registration in this context are most likely to be made where the domain name in issue is identical to the name or mark of the Complainant and without any adornment (other than the generic domain suffix). See for example DRS 00658 (chivasbrothers.co.uk)."

In my view there is a high likelihood of initial interest confusion arising in this case given that the Domain Name is identical to the name of the Complainant, without any adornment other than the generic domain suffix.

Delay

The Respondent has drawn attention to the fact that the Complainant has made no complaint about the Domain Name since it was registered in 2005. Certainly, the Complainant provides no explanation for the long delay in pursuing this case. Nor does the Complainant say when it first became aware of the Domain Name. I infer from this that the Complainant has known of the existence of the Domain Name for some considerable time.

However, there is no limitation period for filing complaints under the DRS. In my view, the time which has elapsed since registration of the Domain Name is simply one factor to weigh up when considering the issue of abusive registration. And the Respondent has not alleged that it has suffered any prejudice as a result of the delay, which may be said to weigh against a finding of abusive registration. For example, the Respondent has not suggested that the delay has in some way impeded its ability to defend the case owing to unavailability of evidence. Nor has the Respondent claimed that there has been acquiescence on the part of the Complainant which has in some way caused detriment to the Respondent.

Accordingly I do not consider that the Complainant's delay is a bar to its Complaint succeeding in this case.

8. Decision

For the reasons stated above I find that the Domain Name is an abusive registration in that it has been registered and used in a manner which took unfair advantage of or was unfairly detrimental to the Complainant's rights.

9. Decision

I find that 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, dhillonoflondon.co.uk, be transferred to the Complainant.

Signed: Adam Taylor

Dated: 6 November 2014