

DISPUTE RESOLUTION SERVICE

D00018364

Decision of Independent Expert

GEOFFREY, LLC.

and

Mr Mohammed Siddique Shaikh

1. The Parties:

Complainant: GEOFFREY, LLC.
One Geoffrey Way
Wayne,
New Jersey
07470
United States

Respondent: Mr Mohammed Siddique Shaikh
19 Manor Way
Batley
West Yorkshire
WF17 7BX
United Kingdom

2. The Domain Name(s):

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

3. Procedural History:

The Complaint was submitted to Nominet on 6 January 2017 and was validated and notified to the Respondent by Nominet on 9 January 2017. The Respondent was informed in the notification that he had 15 working days, that is until 30 January 2017, to file a response to the Complaint.

On 16 January 2017, the Respondent filed a Response. The Complainant did not file a Reply to the Response and the case proceeded to the mediation stage on 27 January 2017. On 22 February 2017, Nominet notified the Parties that mediation had been unsuccessful and, pursuant to paragraph 10.5 of Nominet's Dispute Resolution Service Policy Version 4 ("the Policy"), invited the Complainant to pay the fee for referral of the matter for an expert decision. On 1 March 2017, the Complainant paid the fee for an expert decision. On 1 March 2017, Andrew D S Lothian, the undersigned ("the Expert"), confirmed to Nominet that he was not aware of any reason why he could not act as an independent expert in this case. Nominet duly appointed the Expert with effect from 6 March 2017.

4. Factual Background

The Complainant is a wholly owned subsidiary company and the holder of intellectual property and other assets on behalf of Toys "R" Us, Inc. of New Jersey, USA. Toys "R" Us, Inc. is a leading dedicated retailer of toys and baby products which has its origins in a single toy store in 1948. It operates stores in more than 1,600 locations globally, maintaining a complement of over 62,000 employees and reporting worldwide revenue of \$12.4 billion USD in 2014. It has been placed on Forbes "Fortune 500" list of companies for the previous 22 years. In 2016, it spent \$326 million USD on advertising the TOYS R US brand and mark, having spent \$379 million USD and \$433 million USD in fiscal years 2015 and 2014 respectively.

Toys "R" Us Limited, a subsidiary of Toys "R" Us, Inc., began trading in the United Kingdom in 1985 and has grown from an initial five stores to a complement of 85 stores across the country. In 2015, Toys "R" Us Limited posted profits of £16.3 million GBP. In short, the Complainant's group of companies enjoys a significant reputation and trading history both in the United Kingdom and worldwide.

The Complainant is the proprietor of multiple registered trade marks in respect of words, stylized words and figurative marks all focusing on the term TOYS R US (it should be noted that since 2009, the Complainant has dropped the two quotation marks around the letter "R" from its logo). For example, the Complainant is the proprietor of European Union trade mark no. 8398869 for the word mark TOYS R US in Nice class 9, filed on 1 July 2009 and registered on 11 December 2009. The Complainant is also the proprietor of European Union trade mark no. 8726713 for the following figurative mark in Nice classes 35 and

45, filed on 1 December 2009 and registered on 2 June 2010:-



The Domain Name was registered on 4 March 2015. The Respondent appears to operate or is otherwise connected with a limited company named Softplay Toys 'R' Us Limited which was incorporated in England and Wales on 4 December 2014 under company number 9341115. According to screenshots taken by the Complainant, the website associated with the Domain Name is a business which offers off the shelf soft play products for children under the name and logo SOFTPLAY toys 'R' us. The logo has the following appearance:-



The website claims that the associated business offers the UK's largest selection of children's soft play products to local, national and global clients and offers to design and install tailored soft play environments.

5. Parties' Contentions

Complainant

The Complainant submits that it has rights in a name or mark which is similar to the Domain Name and that the Domain Name, in the hands of the Respondent, is an Abusive Registration.

The Complainant asserts that it has a well-known trade mark with a strong reputation among UK consumers in light of its 30 years of trading, very substantial turnover and advertising. The Complainant submits that it and its associated companies have used the name or mark in question for a very significant period, and to a substantial degree, commencing well before the creation of the Domain Name.

The Complainant contends that the Domain Name is being used by the Respondent in a way which is likely to confuse, and may already have confused, people into thinking that it was controlled by the Complainant, adding that the most logical conclusion reached by Internet users when confronted with the Respondent's website would be that the Complainant has begun to operate, by itself or via a licensee, a website focusing on soft play products in the UK. The Complainant asserts that the Domain Name would be read as a combination of the descriptive term

'softplay', which it indicates is a generic term for a playground for children equipped with fabric/foam toys and apparatus, together with the Complainant's well-known trade mark.

The Complainant notes that the website associated with the Domain Name is a commercial site for a toy manufacturer and retailer and adds that it would be very unusual for the operator of such a site to be unaware of the Complainant, which is the largest standalone toy retailer in the UK. The Complainant asserts that the Respondent's logo also suggests a strong familiarity with the Complainant's trade mark and brand, noting similarities in the respective logos of colours used on alternate letters, which in the Respondent's case are only repeated in the "toys 'R' us" component of the logo, together with the prominence of the letter 'R'. The Complainant submits that the only reasonable explanation for such similarities is that the Respondent's intention was to bring the Complainant's mark and logo to mind in order to benefit from the significant goodwill and reputation enjoyed by the Complainant. The Complainant therefore concludes that the Domain Name and associated website were created in order to operate a retail site that would benefit from an association with the complainant's earlier trade marks and established brand with the aim of taking unfair advantage of the Complainant's rights.

Respondent

The Response is very brief and may be quoted *verbatim*:-

"Hi dear

i received complain about my website

so i m telling you fact and asking you quistion

1 we are ltd registered compney in uk it will allow us to register a name same as we registered

2 is there any law that alow you to do any action after we registered domain as we registered compney?

3 .is there any law that people cant registered name which is included 2/3 words from other companey name ?

4 .how can people contact them after our contact details?

5. do you know people mixed up in thousand of business in those days

6.we are manufacturing our desh in there is none in their store like us".

6. Discussions and Findings

General

In terms of paragraph 2.2 of the Policy the onus is on the Complainant to prove to the Expert on balance of probabilities each of the two elements set out in paragraphs 2.1.1 and 2.1.2 of the Policy, namely that the Complainant 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.

Complainant's Rights

Paragraph 1 of the Policy provides that 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".

The requirement to demonstrate Rights under the Policy is not a particularly high threshold test. Rights may be established in a name or mark by way of a trade mark registered in an appropriate territory, or by a demonstration of unregistered so-called 'common law rights'.

In the present case, the Complainant relies principally on its TOYS R US registered trade mark and the Expert has no hesitation in finding that it has rights in that mark for the purposes of the Policy. Turning therefore to a comparison between the mark and the Domain Name, the Expert begins by noting that the first (.uk) and second (.co) levels are typically disregarded for this purpose as being required for technical reasons only. Comparing the third level of the Domain Name with the Complainant's mark, the Expert notes that the latter is repeated in its entirety in the former, prefixed by the words "soft play". The Expert accepts the Complainant's evidence that these additional words denote a generic term.

The Domain Name might also be read as having an initial descriptive element "soft play toys" followed by a second component, "r us", which completes the phrase. Had the third level of the Domain Name consisted of only that first element, "soft play toys", the Expert would have taken the view that it constituted a wholly descriptive term which had no substantive similarity to the Complainant's mark for the purposes of the present analysis. However, in the Expert's opinion, the addition of the "r us" component changes the entire character of the Domain Name.

Taken as a whole, as it must be, the Domain Name features a relatively obvious presence of the Complainant's mark. In other words, as soon as readers of the Domain Name complete the phrase "soft play toys r us", they are refocused from any initial perception of a "soft play toys" element on to the Complainant's distinctive and well-known TOYS R US trade mark, which becomes immediately recognisable within the Domain Name. Furthermore, when the Domain Name is read in its entirety, the generic words "soft play" do not serve to distinguish the Domain Name from the Complainant's mark.

It should be noted that the Response does not engage with the issue of the Complainant's rights or the Complainant's case on the similarity between the name or mark in question and the Domain Name.

In all of these circumstances, the Expert finds that the Complainant has proved on the balance of probabilities that it has Rights in the mark TOYS R US within the meaning of the Policy and that such mark is similar to the Domain Name.

Abusive Registration

Paragraph 1 of the 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. is being or has been used in a manner which has taken unfair advantage of or has been unfairly detrimental to the Complainant's Rights;*

This general definition is supplemented by paragraph 5.1 of the Policy which provides a non-exhaustive list of factors which may be evidence that the Domain Name is an Abusive Registration. Paragraph 8.1 of the Policy provides a similar non-exhaustive list of factors which may be evidence that the Domain Name is not an Abusive Registration.

The essence of the Complainant’s case on Abusive Registration is that the Respondent registered the Domain Name with knowledge of the Complainant’s well-known trade mark in order to take unfair advantage of the significant goodwill and reputation in such mark by associating it with the Respondent’s business. The essence of the Respondent’s case, as far as the Expert can make it out, is that the Respondent has registered the company name Softplay Toys ‘R’ Us Limited and that it is therefore entitled to use this name in connection with the Domain Name and the associated business. A second assertion which may be gleaned from the Response is that no confusion is caused by the Domain Name because the Respondent offers a different type of product for sale and his contact details are different from those of the Complainant.

The Expert notes that the Domain Name incorporates the Complainant’s well-known mark in its entirety and furthermore that the logo displayed on the Respondent’s website is markedly similar to that of the Complainant, featuring separated or spaced letters with alternating colours and a prominent letter ‘R’ in the “toys ‘R’ us” component while giving much greater prominence to the element which matches the Complainant’s mark than to the words “soft play”. The “soft play” component has been given a significantly smaller typeface and appears in only one colour. Given these features, it is inconceivable to the Panel’s mind that when registering the Domain Name and adopting the associated logo the Respondent could have been unaware of the Complainant and its rights and had no intent to target these. Furthermore, it is notable that there is no denial of the allegation relating to knowledge, either express or implied, in the Response.

In the Expert’s opinion, therefore, the Complainant makes a compelling case that the Respondent registered the Domain Name in the full knowledge of the Complainant’s rights in its TOYS R US mark, with the intention to take unfair advantage of those rights by associating himself and his soft play equipment business with the

Complainant. In addition, the Complainant's submissions and evidence regarding the presence of its mark within the Domain Name and the Respondent's adoption of a similar logo on the associated website give rise to a reasonable inference that the Respondent is using the name in a way which is likely to confuse people or businesses into believing that the Domain Name is connected with the Complainant in terms of paragraph 5.1.2 of the Policy.

The Expert considers that the Respondent could not argue that confusion is unlikely purely by virtue of the fact that his business offers equipment for soft play rather than conventional toys such as those the Complainant might market directly to children. A person viewing the Domain Name, and in particular, visiting the Respondent's associated website, would be more likely than not to assume that the Complainant had moved into the supply of soft play toys and equipment rather than that this was a domain name and website of an independent or unrelated business. It matters not that, as asserted in the Response, the Respondent has provided his own contact details on that website or that the Complainant does not currently supply soft play equipment; in the Expert's opinion those facts are insufficient to dispel the likely consumer confusion arising from the present use of the Domain Name.

Turning to the substance of the Response itself, although the Respondent does not directly address the terms of the Policy, it may be seen that his submissions regarding his company name and trading activity could be relevant to paragraphs 8.1.1.1 or 8.1.1.2 of the Policy. Each sets out a factor which may be evidence that the Domain Name is not an Abusive Registration. The factor provided in paragraph 8.1.1.1 is that the Respondent has used or made demonstrable preparations to use the Domain Name or a domain name which is similar to the Domain Name in connection with a genuine offering of goods or services. The factor in paragraph 8.1.1.2 is that the Respondent has been commonly known by the name or legitimately connected with a mark which is identical or similar to the Domain Name.

Both of the potentially relevant factors to the Respondent's case are qualified by paragraph 8.1.1 which requires that the circumstances concerned must have arisen before the Respondent is "aware of the Complainant's cause for complaint (not necessarily the 'complaint' under the DRS)". In the present case, the Respondent's limited company was incorporated on 4 December 2014. The Domain Name was registered on 4 March 2015. The Complainant asserts, and the Respondent does not deny, that for almost 30 years before either or both of those dates the Complainant had operated a very substantial business in the UK under the TOYS R US mark. As a consequence, that mark had already become extremely well-known.

This identifies a fundamental problem with the central core of the Respondent's case. Given the very compelling submissions and evidence of the Complainant regarding the nature of the Complainant's distinctive trade mark, its business and reputation in the UK, none of which are contradicted or even addressed by the Respondent, it would not be credible for the Respondent to assert in accordance with paragraph 8.1.1 of the Policy that it was unaware of the Complainant's cause

for complaint when it adopted the TOYS R US mark in the Domain Name. Furthermore, any business seeking to adopt the Complainant's distinctive mark in its name without authorisation in order to benefit from an association with that mark could not be described as making a *genuine* offering of goods or services in terms of paragraph 8.1.1.1 of the Policy [Expert's emphasis].

The Panel adds for completeness that the Respondent's belief expressed in the Response that he has an entitlement to use the Domain Name purely because he has been able to register a corresponding limited company name is wholly misconceived. It has been noted in previous cases under the Policy that the most that can be achieved by registration of a company name alone is that it will block anybody else attempting to register exactly the same name with Companies House. Such registration does not provide any entitlement to adopt in a domain name the name, trading style or trade mark of another with a view to taking unfair advantage thereof, or to use a corresponding domain name in a manner which is likely to lead to people or businesses being confused as to whether that domain name is operated, authorised by or otherwise connected with such other party.

In all of these circumstances, the Expert finds that the Complainant has proved on the balance of probabilities that the Domain Name, in the hands of the Respondent, is an Abusive Registration.

7. Decision

The Expert finds that the Complainant has Rights in a name or mark which is similar to the Domain Name and that the Domain Name, in the hands of the Respondent, is an Abusive Registration. The Expert therefore directs that the Domain Name be transferred to the Complainant.

Signed

Andrew D S Lothian

Dated 13 March, 2017