



**NOMINET**

DISPUTE RESOLUTION SERVICE

D00019749

**Decision of Independent Expert**

*TouchBistro UK Limited*

and

*personal Yang HongJuan*

**1 The Parties:**

Lead Complainant: TouchBistro UK Limited

TouchBistro UK Limited

Ashcombe Court

Woolsack Way

GODALMING

SURREY

GU7 1LQ

United Kingdom

Respondent: personal Yang HongJuan

No.4 ZhuLin Road, Futian District

Shenzhen

China

518000

China

## **2 The Domain Name(s) :**

touchbistro.co.uk

## **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.

12 January 2018 00:45 Dispute received

17 January 2018 13:27 Complaint validated

17 January 2018 13:33 Notification of complaint sent to parties

05 February 2018 01:30 Response reminder sent

07 February 2018 08:55 Response received

07 February 2018 08:56 Notification of response sent to parties

12 February 2018 01:30 Reply reminder sent

14 February 2018 09:20 Reply received

14 February 2018 09:26 Notification of reply sent to parties

19 February 2018 14:06 Mediator appointed

22 February 2018 13:56 Mediation started

15 March 2018 17:48 Mediation failed

15 March 2018 17:50 Close of mediation documents sent

29 March 2018 02:30 Complainant full fee reminder sent

29 March 2018 12:22 Expert decision payment received

#### **4 Factual Background**

4.1 The Complainant TouchBistro UK Limited is the UK branch of TouchBistro Inc. of Toronto, Ontario, Canada and was incorporated on 2 October 2017. It offers a suite of restaurant technology tools on a business to business basis. TouchBistro Inc. is the owner of registered trade marks for the word "TouchBistro" in the USA, Canada and the EU. The US mark was filed on 6 December 2011 and registered on 17 November 2011. The Canadian trade mark was filed on 17 November 2011 and registered on 10 October 2013. The EU trade mark was filed on 11 July 2017 and registered on 9 November 2017.

4.2 TouchBistro Inc. is also the registrant for the following domain names: touchbistro.com; touchbistro.net; touchbistro.org; touchbistro.ca; touchbistro.biz; touchbistro.com.mx; touchbistro.mx; touchbistro.info; touchbistro.io; The touchbistro.com domain was registered on 4th January 2011.

- 4.3 The Respondent registered the Domain Name on 14 November 2013 which was the same day that venture capital funding of \$4.5m was publicly announced for TouchBistro in Canada.
- 4.4 The Respondent is an individual based in Shenzhen, China. He owns numerous other UK domain names and has been the subject of eight previous Nominet Complaints in all of which he has been ordered to transfer the relevant domain names to the relevant Complainant. These decisions are as follows: DRS12473 dated 15 April 2013(baupost.co.uk); D12682 dated 3 June 2013(lyxor.co.uk); DRS14289 dated 7 July 2014(lytro.co.uk); DRS18025 dated 15 December 2016 (stitchfix.co.uk); DRS18171 dated 1 March 2017(sprinklr.co.uk); DRS18863 dated 21 July 2017(dollarshaveclub.co.uk); DRS18867 dated 2 August 2017 (kespry.co.uk); and notably DRS19380 dated 15 January 2018 (chromeriver.co.uk) which was only three days after the current Complaint was received by Nominet.
- 4.5 The Domain Name is currently resolving to a page which states "touchbistro.co.uk may be for sale" and "the owner of touchbistro.co.uk has chosen to receive offer enquiries regarding this domain name. Note that the owner may disregard your enquiry if your offer does not meet his or her expectations."

## **5 Parties' Contentions**

### **The Complainant's Rights**

- 5.1 The Complainant states that it was established some seven years ago in Canada as a global organisation and that it has Offices in the USA (New York NY, Chicago IL, Austin TX), Mexico and London, UK and owns the domain names as listed above. The Expert assumes that the Complainant is

referring here to its related Canadian entity TouchBistro Inc. as opposed to itself namely TouchBistro UK Limited. The Complainant has also provided evidence that on 14 November 2013 \$4.5m in funding was raised from Relay Ventures for the TouchBistro business. It also provides a link to the website at [www.touchbistro.com](http://www.touchbistro.com). The information on that site suggests that the overall TouchBistro business was founded in 2010 and provides a suite of restaurant technology tools. It also claims it has helped over 12,000 venues with these and that its products/services are used in 100 countries.

### **Abusive Registration**

5.2 The Complainant asserts that the Domain Name is an Abusive Registration because the Respondent has registered it for the sole purpose of it being sold to them or to a competitor. It also asserts that the Domain Name has many links on the page to confuse users who come upon the page. It states that it has had multiple customers and potential customers from the UK stumble upon the website at the Domain Name and express confusion to its staff on where they can find information on its products. It states (and provides WhoIs evidence) that the domain name [touchbistro.com](http://touchbistro.com) was registered by TouchBistro Inc. in 2011 and the Domain Name was registered after this and after its product was launched in the Apple App store. It requests that the Domain Name be transferred.

### **Response**

#### **Rights**

5.3 The Respondent contends that he registered the Domain Name on 14 November 2013 for future online services and that it consists of a combination of commonly used words.

He explained that as his services are not online now he parked the domain name to earn "meagre income".

5.4 The Respondent argues that the word combination "TouchBistro" is an original creation by him and is not a generic term. Further he claims that although he does not have a trade mark for the word he is preparing to 'do this' and domain names may be registered on a first come first served basis. He alleges that before he registered the Domain Name he knew nothing about the Complainant. He asserts that the Complainant does not have Rights in the Domain Name. In this respect he states that the Complainant has claimed that they have the trade mark registered in the USA for the word "chromeriver" but that is just in classes 9, 41 and 42. Notably chromeriver is not anything to do with this particular case and was the subject of the domain name dispute DRS19380 and was decided against the Respondent only some three days after this Complaint was filed (15 January 2018). He highlights that there are other parties who could also register a trade mark with the word combination of touch and bistro within other classes. He suggests that the Complainant cannot stop others registering and using the words touch and bistro and TouchBistro in other classes exclusively. On this basis he claims to have the undisputed right to the Domain Name to use in the other classes.

5.5 He also claims that 'touch' and 'bistro' are commonly used English words. Their meaning is very broad and they do not belong to the Complainant uniquely. He also asserts that the Complainant does not provide any evidence that the word "TouchBistro" is commonly associated with it and asserts that it was not recognised with the public in the UK before the Respondent registered the Domain Name on 14 November 2013.

- 5.6 The Respondent also submits that the Domain Name is not an Abusive Registration. In this regard he denies knowledge of the Complainant before registering the Domain Name and states that he registered the Domain Name "for the good wish usage". He states that he did not stop the Complainant from registering the Domain Name before 14 November 2013 and that the Complainant could have registered the Domain Name after it filed a trade mark in the US and questions why it did not do this. He further suggests that this could indicate that the Complainant's service is just in the USA and that they did not want to do business in the UK. He suggests they gave up their rights to register themselves.
- 5.7 The Respondent also claims that he did not want to sell the Domain Name and that is being reserved for future online services. He states that it is parked now so that the pages that the park system shows are not the Respondent's true intention and it is just the park system automatically generating these. He states that he did not proactively promote the sale of the Domain Name to any person and did not contact anyone to sell it including the Complainant. This again suggests according to him that the Domain Name was registered for his own usage.
- 5.8 He states that he has registered some .UK domain names which "in addition to his own use, the Respondent mainly parked them to earn meagre income, and this did not affect other people's business including the Complainant." He states that the Complainant did not provide any evidence indicating that they have any commercial activities in the UK before he registered the Domain Name and provided no evidence indicating that they do any advertising or promotion in the UK before then. He

states that if the Domain Name is transferred to the Complainant this will be unfair to British companies and the Respondent.

- 5.9 He claims the Complainant is guilty of reverse domain hijacking. The Complainant only has the Domain Name touchbistro.com and this cannot allow them the right to touchbistro.co.uk automatically. As he is an individual and the Complainant is a company he is suspicious of being bullied by a big entity. The Respondent requests that the Expert rejects the Complainant's request.

#### **Reply to the Response**

- 5.10 The Complainant asserts that the Domain Name is an Abusive Registration because the Respondent is not being truthful and is making statements in bad faith. The Domain Name was registered by the Respondent on the same day that the Complainant's Venture Funding of \$4.5m was publicly announced. The Complainant highlights that the Respondent has been found to have made similar abusive domain names registrations after venture funding was publicly announced in previous Nominet cases DRS19380, DRS18867 and DRS18863.
- 5.11 Whilst the words "touch" and "bistro" are two common words in the English language, combining them as TouchBistro results in a distinctive terms that would not be used in everyday conversation. It points out that the term "TouchBistro" only refers to one thing and that is the name of its company and software



5.12 The Complainant asserts that its brand TouchBistro, although not as known to the general public as, say, Ferrari or Mercedes, is a successful business to business organisation and one of the leaders in its industry. It states that it has been providing continuous services to multiple UK customers since July 2013 and has had a physical presence in the UK since 2017. It asserts that it is the only holder of a registered trade mark for the terms TouchBistro in the USA, Canada and the EU and that there are no other registered trade marks similar to its name registered in the USA, Canada or the EU.

5.13 The Complainant refers to the Respondent's Response where it states that the Complainant has claimed that it has a trade mark registered in the USA for the word "chrome river". The Complainant suggests that the Respondent is confused with the previous Nominet case DRS 19380 in which he was found to have made an Abusive Registration and was forced to transfer the domain name chromeriver.co.uk to the rightful owner.

5.14 The Complainant points out that the Respondent's claim that he did not promote sale of the domain name is false as there is a notice on the parking page offering the Domain Name for sale. It refers to Nominet case DRS19380 where it is stated that the Respondent owns "(328) domain names and that most are .co.uk versions of .com domain names owned by established entities". The Complainant also indicates that the Respondent has had over four years to launch a project in relation to the Domain Name but has failed to do so.

5.15 It contends that the Respondent's claims of corporate bullying and reverse domain hijacking are absurd. It states that it is a small to medium sized business with

rights to the name whereas the Respondent is a repeat cyber squatter with a history of registering domain names for the sole purpose of resale. It points out that the Respondent has been forced to transfer domains in eight out of eight previous Nominet cases and that in each of these previous disputes the Respondent has raised a similar argument that it registered the domain name for "future online service" and that "as the services is not online now, so I parked the domain to earn meagre income". The Complainant states that it finds it extremely improbable that the Respondent was ever planning on starting so many "online services" targeted to the UK market. The Complainant submits that the Respondent's claims have no merit, in view of its pattern of abusive registrations and decisions against them in cases which almost identically mirror this case.

## **6 Discussions and Findings**

6.1 Under paragraph 2.1 of the Policy for the Expert to order a transfer of the domain name the Complainant is required to demonstrate, on the balance of probabilities that:

*"2.1.1 The Complainant has Rights in respect of a name or mark which is identical or similar to the Domain Name; and*

*2.1.2 The Domain Name, in the hands of the Respondent, is an Abusive Registration."*

### **The Complainant's Rights**

6.2 Paragraph 1 of the Policy defines "Rights" as *"rights enforceable by the Complainant, whether under English Law or otherwise, and may include rights in descriptive terms which have acquired a secondary meaning."*

- 6.3 The Expert notes that that the Complainant's related Canadian entity TouchBisto Inc owns the registered trade marks and domains for the word TouchBistro/incorporating it. However she infers on the balance of probabilities that there is a licence granted in the Complainant's favour in relation to use of these and in particular the Domain Name that it would be able to enforce these under that licence or with the permission of TouchBistro Inc as licensor. In addition the Complainant's company name includes Touchbistro and accordingly it would be reasonable to infer that it has built up goodwill and reputation in that name in the UK, given the use that has been made of it.
- 6.4 Whilst the licensed trade mark registrations are limited to certain classes of goods or services, this is not relevant to whether the Complainant's Rights are legally enforceable. The EU registered trade mark to which the Expert has found the Complainant has a licence to use, constitutes Rights in the term TouchBistro for the purposes of the Policy. Furthermore it does not matter that this trade mark was registered after the registration of the Domain Name by the Respondent. Whether there are Rights established is assessed at the date of filing the Complaint. Whilst a domain name pre-dating a trade mark might be relevant when considering the Respondent's knowledge and intention in connection with Abusive Registration, it has no significance in relation to whether Rights have been established under the Policy.
- 6.5 Even if the Complainant had not demonstrated the existence of any trading or marketing activity in the UK, either before or after a registration of the Domain Name, it does not matter. A registered trade mark alone is

enough to generate Rights under the Policy. In addition overseas rights (unregistered and registered) can also be sufficient. See paragraph 1.5 of the DRS Experts' Overview. In any event here it is not necessary to take into account the claimed overseas rights given the Expert has found that the Complainant is likely on the balance of probabilities to have a licence to use and enforce an EU registered trade mark. Furthermore the Expert, as above, has found that there is goodwill and reputation in the name TouchBistro in the UK which is likely to have accrued to the Complainant and would give rights to unregistered UK trade mark rights.

6.6 The Policy also requires that the name or mark in which the Complainant has Rights must be identical or similar to the Domain Name. The only difference between the TouchBistro trade mark /name and the Domain Name is the suffix '.co.uk.' It is well accepted under the Policy that the "co.uk" suffix may be discounted in the relevant comparison. Accordingly the Expert finds that the Domain Name is identical to a trade mark in which the Complainant has Rights.

6.7 The Expert therefore finds that the Complainant has Rights in respect of a name which is identical to the Domain Name and so the Expert finds that paragraph 2.2.1 of the Policy is satisfied.

#### **Abusive Registration**

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

A Complainant must prove one or both of these on the balance of probabilities.

6.9 As far as paragraph (i) above is concerned it is necessary to determine whether the Respondent was aware of the existence of the Complainant and its Rights at that time and furthermore, had the aim of taking advantage of such Rights (see DRS4331 verbatim.co.uk). In this case the Respondent has of course denied knowledge of the Complainant and its Rights at the time of registration of the Domain Name. He alleges that he registered it only for his own usage and that it is an originally created word made up by him and is not a generic term. Also the Respondent argues that the Complainant has not provided any evidence to show that its trade mark is known by the public in the UK.

6.10 In this regard the Expert refers to paragraph 5 of the Policy which provides a non-exhaustive list of factors which may be evidence of an "Abusive Registration", including:

*"5.1.6 The Domain name is an exact match (within the limitations of the characters set permissible in Domain Names) for the name or mark in which the Complainant has Rights, the Complainant's mark has a reputation and the Respondent has no reasonable justification for having registered the Domain Name."*

- 6.11 The Domain Name is an exact match of the EU registered trade mark and name in which the Expert has found that the Complainant has Rights. The Domain Name does not consist of descriptive or generic terms. The individual terms "Touch" and "Bistro" may be generic or common on their own. However the combination of these words is not common and in the Expert's view is somewhat inventive. In addition the Respondent has not provided an explanation as to why he chose this particular combination of words in the light of his assertion that he had no knowledge of the Complainant. That the Respondent should have chosen the Domain Name independently seems very far-fetched to the Expert.
- 6.12 The Expert also considers that on the balance of probabilities the Complainant's trade mark has acquired some goodwill and reputation and is at least reasonably well-known in relevant business circles. This is supported by the fact that in 2013 at the time of registration of the Domain Name it had raised \$4.5 Million in venture capital funding. It is also supported by the claims made by its website to having been founded in 2010 and that it has helped over 12,000 venues and that its products/services are used in 100 countries.
- 6.13 In view of all of this it is simply not credible in the Expert's opinion that the Respondent registered the Domain Name without prior knowledge of the Complainant or at least its Canadian related company, particularly in view of the timing of the registration which coincides with the exact day of the public announcement of the above funding.
- 6.14 On the balance of probabilities, the Expert is of the view that the Respondent's registration of the Domain

Name which is identical to the Complainant's trade mark cannot have been independent of and without such prior knowledge. It is far more likely that the Respondent was aware of the funding announcement and thus viewed the Domain Name as having potential value and that this was his true reason for the registration as opposed to anything else.

6.15 Based on the facts and evidence here the Expert considers that the Respondent registered the Domain Name in full knowledge of the Complainant's Rights and that he did so in order to take advantage of these. This is only emphasised by the Respondent's subsequent offering of the Domain Name for sale on a parking page (see below).

6.16 Accordingly the Expert finds that the Domain Name was registered in a manner which takes unfair advantage of, and is unfairly detrimental to the Complainant's Rights in accordance with paragraph 1 (i) of the Policy above.

6.17 As far as paragraph 1 (ii) of the Policy above paragraph 5 of the Policy is a non-exhaustive list of factors which may be evidence of "Abusive Registration" including:

*"5.1.1 Circumstances indicating that the Respondent has registered or otherwise acquired the Domain Name primarily:*

*5.1.1.1. for the purposes of selling, rent or otherwise transferring the Domain Name to the Complainant or to a competitor of the Complainant, for valuable consideration, in excess of the Respondent's documented out of pocket costs directly associated with acquiring or using the Domain Name;"*

6.18 The Respondent has used the Domain Name to resolve to a parking page offering it for sale. The Expert considers

that this constitutes an Abusive Registration within the meaning of paragraph 5.1.1.1 of the Policy above. As above it seems likely to the Expert that the Domain Name was registered for its value as a trade mark and brand as opposed to for any other reasons.

6.19 The Respondent claims that he does not wish to sell the Domain Name and it is reserved for future online services. He claims that the pages the park system shows do not demonstrate his true intention and they are just automatically generated by the park system. The Respondent has not provided any information at all to support his future plans for the Domain Name. Also as the Complainant has pointed out the Respondent has had almost four years to launch his alleged planned project in relation to the Domain Name but has failed to do so. In addition the Respondent seems to own over 300 domain names most of which are .co.uk versions of .com domain names owned by established entities. In addition there have been eight previous Complaints decided against the Respondent in similar circumstances and he has adopted similar arguments in each of them to the effect that the domain names were registered for future online services and the domains were parked to earn 'meagre incomes.'

6.20 The Expert agrees with the Complainant that it is extremely improbable that the Respondent was ever planning on starting so many online services targeted to the UK market. Notably the claim that the content on the parking page including the link offering the domain name for sale is automatically generated is irrelevant as clearly the Respondent is responsible for the content on the relevant website. Whether the Respondent approached the Complainant to sell the Domain Name is not relevant



as the offer for sale on the website is enough to demonstrate the Respondent's real intentions.

6.21 The Expert therefore finds that the Domain Name is being used in a manner which is taking unfair advantage of, and is also fairly detrimental to, the Complainant's rights in accordance with (ii) above.

6.22 For completeness paragraph 5.1.2 of the Policy states as another ground of Abusive Registration

*'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.'*

6.23 The Complainant cites such confusion here but has provided no evidence. However it seems to the Expert that such confusion is likely where an internet user is looking for the Complainant and stumbles across the Respondent's site instead. They are likely to believe that it is the site of the Complainant. There is at least the likelihood of initial interest confusion which in the Expert's view would also be sufficient for a finding of Abusive Registration in this case.

6.24 Finally and importantly there is a presumption of Abusive Registration that the Respondent has failed to rebut as set out in paragraph 5.3 of the policy: *"There shall be a presumption of Abusive Registration if the Complainant proves that the Respondent has been found to have made an Abusive Registration in three (3) or more DRS cases in the two (2) years before the Complaint was filed. This*

*presumption can be rebutted (see paragraphs 8.1.4 and 8.3).'*

- 6.25 In this case the Complainant has put forward evidence showing that the Respondent has been found to have made abusive registrations in eight DRS cases and at least four of these have been within the last two years. These include cases under similar circumstances (i.e. following a funding announcement), namely DRS1930, 18867 and 18863.
- 6.26 Although this evidence was submitted by the Complainant in Reply, to which there is no automatic right to respond, the Respondent could have asked to submit a 'non-standard submission' pursuant to paragraph 17 of the Policy, if he had a legitimate explanation to offer. Having been a party to the previous DRS proceedings relied on, the Respondent was of course well aware of them, and so the reply evidence did not contain anything new and surprising to him. Based on the foregoing the Expert finds that the Respondent has failed to rebut the presumption of the Abusive Registration set out in the Policy and as a result the Expert finds that the Respondent's pattern of abusive domain name registration in other cases is strongly indicative of Abusive Registration in the present case.
- 6.27 Again for completeness the Expert rejects the allegations by the Respondent of reverse domain name hijacking.
- 6.28 In the circumstances the Expert considers that the evidence demonstrates and she is satisfied that the Complainant has succeeded in proving on the balance of probabilities that the Domain Name is an Abusive Registration under the Policy.

**7 Decision**

7.1 The Expert accordingly finds that the Complainant has rights in respect of a name or mark which is identical to the Domain Name and that the Domain Name, in the hands of the Respondent is an Abusive Registration. Accordingly the Expert directs that the Domain Name is transferred to the Complainant.

Signed .....

Dated 23/4/18

UNSIGNED

