

DISPUTE RESOLUTION SERVICE

D00022540

Decision of Independent Expert

Vorstar Investment Ltd

and

Digitalink Consultants Limited

1. The Parties:

Complainant: Vorstar Investment Ltd
Thiseos 4, 2413 Egkomi
Nicosia
Cyprus

Respondent: Digitalink Consultants Limited
Simon Nolan, Ziferblat, 23 Edge Street
Manchester
United Kingdom
M41HW
United Kingdom

2. The Domain Name:

ziferblatuk.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.

09 April 2020 15:19 Dispute received
14 April 2020 12:35 Complaint validated
14 April 2020 12:42 Notification of complaint sent to parties
01 May 2020 02:30 Response reminder sent
04 May 2020 16:24 Response received
04 May 2020 16:25 Notification of response sent to parties
07 May 2020 08:14 Reply received
07 May 2020 08:14 Notification of reply sent to parties
07 May 2020 08:19 Mediator appointed
07 May 2020 12:53 Mediation started
07 May 2020 12:54 Mediation failed
07 May 2020 12:54 Close of mediation documents sent
11 May 2020 11:04 Expert decision payment received

4. Factual Background

This DRS complaint seems to be another round in a series of disputes between individuals and companies connected to the parties. From the parties' submissions and supporting exhibits the following relevant chronology is apparent:

- a. In 2010 or 2011 Mr Ivan Mitan, a Russian individual connected to the Complainant, started a café and meeting space business under the name ZIFERBLAT. The name in Russian and German can be translated into English as 'clockface'. Rather than selling customers food and drinks like a traditional café, the business model created or adopted by Mr Mitan was to give food and drinks away for free but charge customers by the minute for the time they spent in the premises. The Complainant's business has used the <ziferblat.net> domain name extensively and now operates in a number of locations in cities in several countries.
- b. In November 2013, Ziferblat Ltd, a wholly owned subsidiary of the Complainant, registered the domain name <ziferblat.co.uk> and subsequently commenced using it and <ziferblat.net> in relation to a pay-per-minute café and meeting place business in London, pursuant to a franchise agreement with the Complainant dated 1 March 2014.
- c. In October 2014, the Complainant and Ziferblat Ltd entered into a franchise agreement with a company named as My Happy Place (Holdings) Ltd, by which that company was granted a licence to use the ZIFERBLAT name to operate pay-per-minute café and meeting place venues in the UK and Ireland. My Happy Place (Holdings) Ltd is a company controlled by Mr Gareth Harold. However, I note that according to Companies House

online records, this company was not actually incorporated until March 2015, so it is not clear how it was named as a party to the October 2014 agreement.

- d. But for whatever reason, that franchise agreement did not survive long and appears to have been replaced by a similar franchise agreement dated 15 January 2015 but between the Complainant and My Happy Place Ltd (incorporated in March 2014), which is now a subsidiary of My Happy Place (Holdings) Ltd.
- e. My Happy Place Ltd then operated pay-per-minute café and meeting place venues under the ZIFERBLAT name in Liverpool and Manchester. The Complainant says this was pursuant to the franchise agreement, which it terminated for cause on 6 March 2019. The Respondent claims the My Happy Place Ltd franchise agreement was terminated in 2015 and the pay-per-minute café and meeting place venues operated by My Happy Place Ltd under the ZIFERBLAT name in Liverpool and Manchester between then and when it entered into liquidation proceedings on 30 November 2018, was unconnected to and unchallenged by the Complainant.
- f. In the meantime, the Complainant also operated a pay-per-minute café and meeting place venue under the ZIFERBLAT name in London. It closed around October 2018 but has since reopened. It now also operates a ZIFERBLAT pay-per-minute café and meeting place venue in Coventry.
- g. On 20 December 2018 the Domain Name was registered by Mr Gareth Harold, the person who controls My Happy Place (Holdings) Ltd and, until liquidators were appointed, My Happy Place Ltd.
- h. In or around January 2019, My Happy Place (Holdings) Ltd filed a Nominet DRS complaint (DRS No. D00020914) against the Complainant's subsidiary, Ziferblat Ltd, in relation to the <ziferblat.co.uk> domain name seeking a transfer of it. For some reason, the complaint was not defended by Ziferblat Ltd, but the complaint still failed and the transfer request was refused.
- i. The pay-per-minute café and meeting place business previously operated by My Happy Place Ltd (which is now in liquidation) in Manchester under the ZIFERBLAT name now seems to be operated by My Happy Place Management Services Ltd and is in the process of being rebranded from ZIFERBLAT to CLOCKWORK. That company is another subsidiary of My Happy Place (Holdings) Ltd and is controlled by Mr Gareth Harold.
- j. The Domain Name currently resolves by automatic redirection to the website at www.workslikeclockwork.co.uk, which has a "Copyright 2020" claim by My Happy Place Management Services Ltd at the foot of the home page. A visitor to the website is met with the following message.

ZIFERBLAT WORKS LIKE CLOCKWORK

We have some exiting news to share - From now on we will be known as Clockwork

- k. On 31 March 2020, in advance of filing its DRS complaint, the Complainant's solicitors made a 'data release request' to Nominet to identify the registrant of the Domain Name. Nominet responded by email on 1 April 2020 confirming that it was Mr Gareth Harold. As



is standard practice, Nominet also confirmed in its email that *“The registrant has been informed of your request.”*

- l. On 3 April 2020, the Complainant filed a DRS complaint citing Mr Harold as the respondent registrant of the Domain Name, however by then the registration of the Domain Name had been transferred by Mr Harold to the Respondent.
- m. On 9 April 2020, the Complainant filed this DRS complaint against the Respondent.
- n. The Respondent is a company controlled by a Mr Simon Nolan, who also operates a web design business called Bamboo Manchester. The contact details held by Nominet for the Respondent as the new registrant of the Domain Name are an email address "manage@bamboomanchester.uk" and the phone number of Bamboo Manchester. The 'Contact Us' page of their website at www.bamboomanchester.uk shows the following:

Phone	Post	Instagram
0161 465 3302	Bamboo Manchester	@bamboo_mcr
Email	Ziferblat	Twitter
hello@bamboomanchester.uk	23 Edge Street	@bamboo_mcr
	Northern Quarter	
	Manchester	
	M4 1HW	

We're in the Northern Quarter in the heart of Manchester

We are located in Ziferblat, right in the heart of Manchester and it's really easy to get to us! We're a minute's walk from the Shudehill Metrolink stop and there is plenty of parking at the nearby Arndale Centre.



- o. The 'Ziferblat' address given is the address of one of the three Manchester venues operated by My Happy Place Management Services, as listed on the website at www.workslikeclockwork.co.uk, to which the Domain Name resolves and which the website claims is now known as Clockwork, not Ziferblat as stated on the www.bamboomanchester.uk website. The ZIFERBLAT word and device logo comprising a person with a clock face beneath a bowler hat that is being used by Bamboo Manchester on the 'Contact Us' page of their website is the registered trade mark of the Complainant.
- p. The Respondent's response to the complaint confirmed that it is in the process of rebranding their pay-per-minute café and meeting place business from ZIFERBLAT to CLOCKWORKS and that Bamboo Manchester has been assisting with that.

5. Parties' Contentions

The Complainant's complaint, which was supported by a number of documentary exhibits, made a number of claims, which I have summarised below. In its response, the Respondent commented on the complaint on a 'point by point' basis. I have summarised the response to each point made in the complaint below, shown in italics. The Complainant then filed a reply

to the issues raised by the response, which I have also summarised and set out below, after the relevant response.

- Complaint:

The Complainant owns the rights in the ZIFERBLAT name, which has been used in connection with a 'pay-per-minute' cafe and franchising business since at least 2011. The opening of its first UK café in London in 2014 was reported in national press and media, such as The Guardian, The Telegraph and the BBC.

Response:

The pay-per-minute cafe business referred to by the Complainant was created in 2011 by Mr Ivan Mitin in Moscow, not by the Complainant. They provide no evidence that they own or started such a business and are attempting to usurp the name through nefarious use of the trade mark system in England. The Complainant is a shell Cypriot company with an office in a back street of Nicosia. It is not Russian or British and yet it claims to have originated and owned businesses in Russia and England. The Complainant's own accounts describe it as the owner of intellectual property, nothing else. This is a sham organisation. The Complainant is not able to control or own the concept of a pay per minute cafe. "Ziferblat" is a word in common usage in several languages including Russian, German and Swiss German.

Reply:

Other than the fact that the Complainant's pay-per-minute cafe and co-working space business was indeed founded by Ivan Mitin in Russia in or around 2010, these assertions are incorrect and not accepted. The fact that "Ziferblat" is a word in common usage in several languages including Russian, German and Swiss German is not a valid defence to an abusive domain name registration. The Complainant's rights in the Domain Name are described in the complaint.

- Complaint:

The Complainant is the registrant of domain names which incorporate the ZIFERBLAT name, including <ziferblat.net> and <ziferblat.co.uk>.

Response:

The Respondent also owns domain names which include the word Ziferblat. Such ownership does not automatically confer exclusivity. <ziferblat.co.uk> was run by the Respondent for 5 years until it was hijacked by the Complainant without notice or compensation. This action is subject to legal proceedings which are current and on-going.

Reply:

The Complainant was at all times the owner of the rights in the <ziferblat.co.uk> domain name. The Respondent is connected to a company called My Happy Place Ltd and its director, Mr Gareth Harold. Although the author of the Respondent's response is stated to be "Simon Nolan", it was actually signed-off "Best wishes Gareth Harold". The Complainant entered into a franchise agreement with My Happy Place Ltd dated 13 January 2015 under which it was given the right to use <ziferblat.co.uk> for the duration of the franchise agreement.

No legal proceedings have been issued or received by the Complainant in relation to <ziferblat.co.uk> at all. The Complainant can only assume that this is a misguided reference to an undefended but unsuccessful DRS complaint submitted against Ziferblat Ltd (a wholly

owned subsidiary of the Complainant) by My Happy Place (Holdings) Limited (the parent company of My Happy Place Ltd and also connected to Gareth Harold) in 2018/19 (DRS case reference D00020914). In his summary decision in that case, the independent expert correctly declined to find that Ziferblat Ltd's ownership of <ziferblat.co.uk> was an abusive registration.

- Complaint

The Complainant is the registered proprietor of, amongst others, a registered trade mark (International Registration number WO0000001177847) for ZIFERBLAT (word and clock-face device), which has been protected in the United Kingdom since 28 December 2013 and has a priority date of 30 May 2013, covering goods and services in class 43 for 'cafeterias, rental of meeting rooms; self service restaurants'.

Response:

This is not relevant. It is not possible to own or control the business model.

Reply:

This is plainly incorrect. It is highly relevant.

- Complaint:

The Complainant is the owner of significant goodwill and reputation in 'pay-per-minute' cafes by reference to the ZIFERBLAT name as shown by the national press reports exhibited to the complaint.

Response:

The Respondent's Ziferblat business has received more than 700 pieces of press and 12 awards since 2014. It operated in Liverpool and Manchester. The Complainant's business operated in a different city, has received very little press coverage, none at all for some years and their London business closed in 2018. It is not possible for one business to be confused with the other. Any goodwill to which the Complainant refers was created by the Respondent, a quick search engine search would confirm this.

Reply:

The Respondent in this matter is Digitalink Consultants Limited, a website design company that recently became the registrant of the Domain Name as part of an attempt to frustrate the Complainant's first DRS complaint against the then registrant, Gareth Harold. The Respondent, Digitalink Consultants Limited, does not operate and has never operated a pay-per-minute cafe business under the mark ZIFERBLAT. Such activity was conducted by My Happy Place Ltd with authorisation from the Complainant until 6 March 2019, and then by Gareth Harold and others without authorisation from 6 March 2019. Accordingly, Digitalink Consultants Limited has no legitimate rights in the Domain Name and the allegations that the use of the ZIFERBLAT mark has been popularised by the Respondent and the <ziferblat.co.uk> domain name was operated by the Respondent for 5 years without objection are both unsubstantiated and wrong.

The Respondent is actually referring to the activities of My Happy Place Ltd, which was the Complainant's franchisee and operated its Ziferblat business under licence from the Complainant. Any goodwill generated by the Complainant's franchisees accrued to the Complainant pursuant to the franchise agreement.

- Complaint:

The Complainant currently operates a 'pay-per-minute' cafe franchise, under which it has granted franchisees the right to use the ZIFERBLAT name to operate 'pay-per-minute' cafes in Russia, the Ukraine and the United Kingdom.

Response:

This is the same point as already made above and is not relevant.

- Complaint:

The Complainant grants permission for third party franchisees to use the ZIFERBLAT name in the United Kingdom to operate one or more 'pay-per-minute' cafes. It granted its own wholly owned subsidiary company, Ziferblat Limited, permission to use the ZIFERBLAT name to operate a 'pay-per-minute' café located in London for the duration of a franchise agreement dated 1 March 2014. The franchise agreement with My Happy Place Limited dated 13 January 2015 was terminated for cause on 6 March 2019 by a letter from the Complainant's solicitors. Following the termination, My Happy Place Limited had no right to continue using the ZIFERBLAT name. The Domain Name was originally registered on 20 December 2018 by Gareth Harold, a director of My Happy Place Limited.

The Complainant has subsequently granted Philosophy Saloons Ltd permission to use the ZIFERBLAT name to operate a 'pay-per-minute' café located in, amongst other regions, the West Midlands pursuant to a franchise agreement dated 10 April 2019.

Response:

This is also not relevant. The franchise agreement entered into between us and the Complainant was ended in 2015, we have evidence of this, and the Complainant has failed to raise any objection in the 5 years since and during these 5 years the Complainant was not trading in the UK. The business model cannot be copyrighted or protected in any way. The Complainant does not control other people's ability to grant franchises and does not have a unique or protected business. The Respondent's business is meeting room hire, it is not a cafe, and in any event no cafe can be protected as a business model. The Domain Name is also not owed by My Happy Place Ltd as this business was liquidated in 2018.

Reply:

The Respondent in this matter is Digitalink Consultants Limited. The Complainant and Digitalink Consultants Limited have never entered into a franchise agreement.

- Complaint:

The Domain Name in the hands of the Respondent is abusive because it incorporates the Complainant's ZIFERBLAT name, is highly similar to the Complainant's own domain names <ziferblat.co.uk> and <ziferblat.net> and is being used without authorisation to promote a chain of 'pay-per-minute' cafes in Manchester under the names ZIFERBLAT and/or ZIFERBLAT UK. This is highly likely to confuse the public into believing that the Domain Name is registered to, operated or authorised by, or otherwise connected with the Complainant when that is not the case.

Response:

The Complainant does not own the word 'Ziferblat' which is in common usage and has been popularised by the Respondent. The businesses are different, operate in different cities and would not be confused for each other. Moreover, the <ziferblat.co.uk> domain name was operated by the Respondent for 5 years without objection. "Authorisation" to use the Domain Name is not required. The Complainant is not recognised as the owner or operator of any UK business. They are a Cypriot company of opaque ownership and management and funding, making significant losses and are not in any way a public presence recognised in the UK. However, the Respondent has also ceased use of the Domain Name in all public facing formats, the Domain Name is now being used during a transition period to a new business name and as a 'catch all' for active email accounts for inbound email only during this transition to www.workslikeclockwork.co.uk. The Respondent has completed all digital rebranding to ensure that the Complainant cannot stake claim to the goodwill created by the Respondent. The Respondent is in the process of re-indexing all Google search data and has already redirected website domains and updated the DMZ.

[Expert's note: DMZ stands for 'de-militarised zone' and is a term used in computing to describe a separate perimeter security network positioned between the Internet and the internal private network of a business.]

- Complaint:

The Domain Name in the hands of the Respondent is abusive because it was chosen in a deliberate attempt to infringe the Complainant's intellectual property rights. It was registered by Gareth Harold who was a director of My Happy Place Limited, the Complainant's former franchisee, on 20 December 2018, more than 3 years after My Happy Place Limited had entered into a franchise agreement with the Complainant and only shortly before its right to use the ZIFERBLAT name ceased when the franchise agreement was terminated on 6 March 2019.

Response:

Having used the word 'Ziferblat' for 6 years this is not a new position. My Happy Place Ltd was put into liquidation in 2018, so the franchise agreement cannot have been terminated in 2019. The franchise agreement was ended by My Happy Place Ltd in 2015 not by the Claimant in 2019. If they had no objection for 4 years, why now?

Reply:

Whilst My Happy Place Limited is in the process of liquidation, it has not yet been wound-up. My Happy Place Limited merely commenced its winding up process on 30 November 2018, which does not affect the date of termination of the franchise agreement.

- Complaint:

The Domain Name in the hands of the Respondent is abusive because shortly after the Complainant submitted a DRS complaint to Nominet on 3 April 2020, the registrant of the Domain Name was changed from Gareth Harold to the Respondent, Digitalink Consultants Limited, which is a company connected to Gareth Harold and My Happy Place Limited. The change in registrant was a clear attempt to circumvent the Complainant's DRS complaint. In that regard:

- An email from Nominet on 9 April 2020 provided the new registrant details of the Domain Name and the contact is "Simon Nolan", the email address is "manage@bamboomanchester.uk" and the telephone number is "+441614653302".

Printouts from Companies House show that Simon Nolan is a director and person with significant control over Digitalink Consultants Limited and his LinkedIn page shows he is the Creative Director at Bamboo Manchester.

- The website to which the Domain Name resolves says it was designed by "Bamboo Manchester". The registrant's email address for the Domain Name referred to above is "@bamboomanchester.uk".
- Bamboo Manchester's website at www.bamboomanchester.uk shows that the telephone number for the Domain Name's registrant referred to above is the same as Bamboo Manchester, and that Bamboo Manchester's address is "Ziferblat, 23 Edge Street, Northern Quarter, Manchester, M4 1HW", the address from which an unauthorised pay-per-minute cafe is being operated.

Response:

There is no legal connection between My Happy Place Ltd and the Respondent, Digitalink Consultants Limited. They have different shareholders and directors and My Happy Place has been in liquidation since 2018. Digitalink has acted on behalf of the Respondent to change the trading name from 'Ziferblat' to 'ClockWork'. The Domain Name is similar to others used by us for 6 years with the Complainant's knowledge. They have not raised an objection before and their business is not capable of being harmed because there is no business. The Complainant does not trade as 'Ziferblat' and never has. The Complainant has only proven that Digitalink Consultants Limited and Bamboo Manchester have been working with the Respondent. It states this clearly on the bottom of our new website at www.workslikeclockwork.co.uk, as they are the creators of the website and have had a working relationship for the last 4 years.

No company requires authorisation from the Complainant to operate any kind of business anywhere.

- **Complaint:**

The Domain Name in the hands of the Respondent is abusive because it is highly similar to and incorporates the Complainant's ZIFERBLAT name and was registered either (i) as a blocking registration against a mark in which the Complainant has rights, or (ii) for the purpose of unfairly disrupting the business of the Complainant. The Respondent has no reasonable justification for holding the Domain Name.

Response:

The Complainant is not stopped from trading, is not being disrupted and the Respondent has every reason to hold the Domain Name having held a similar one for 6 years. However, a change of name has been executed and we are in a transition period.

- **Complaint:**

At the end of the complaint, the Complainant answered 'Transfer' to the standard question "How would you like this complaint to be resolved?"

Response:

We object to any transfer of the Domain Name as it an asset of the Respondent and is currently being used to redirect our current trading business to our new business name.

- Complaint:

At the end of the complaint, the Complainant answered 'No' to the standard question "As far as you are aware have any legal proceedings been issued or terminated in connection with the Domain Name?"

Response:

This is an extraordinary response. There are legal proceedings in existence. It is extraordinary and credibly questionable, because the solicitor who initiated the legal proceedings on behalf of the Complainant is the very same person, a solicitor, who answers "no" to their existence. We have instructed solicitors to respond to these proceedings and the case is expected to go to trial. We suggest that it would be premature for Nominet to prejudice these proceedings as they are currently on going and request a stay of any investigation by Nominet until such time as all legal action is completed.

Reply:

This is incorrect. It is true that the Complainant has threatened to issue legal proceedings in connection with an infringement of the Complainant's intellectual property rights by Gareth Harold and others, and that Gareth Harold has instructed a firm of solicitors to respond to the Complainant's initial letter. However, no legal proceedings have at any point been issued or terminated. This Respondent's request that this DRS complaint be stayed is simply another attempt to frustrate it.

6. Discussions and Findings

Preliminary Matter

Before dealing with the details of the dispute I will deal with the Respondent's request that these DRS proceedings be stayed pending the conclusion of existing legal proceedings.

Paragraph 25 of the Nominet DRS Policy states as follows:

"25. Effect of court proceedings

25.1 If it is brought to our attention that legal proceedings relating to the Domain Name(s) are issued in a court of competent jurisdiction, and have been served, we will suspend the DRS dispute pending the outcome of those legal proceedings.

25.2 A Party must promptly notify us if it initiates legal proceedings in a court of competent jurisdiction relating to the Domain Name during the course of proceedings under the DRS."

The Respondent claimed that there are relevant legal proceedings in existence that have been initiated by the Complainant using the same solicitors as are dealing with this DRS complaint on its behalf. That was flatly denied by the Complainant in its reply, which was prepared and filed by those solicitors. The Respondent provided no evidence whatsoever to support its contention. As will also be noted below when discussing my decision, the Respondent's response contained numerous other statements that were clearly factually incorrect. In the circumstances, I find that there is no evidence to support the Respondent's request for a stay of these DRS proceedings and the request is denied.

General

In order to succeed the Complainant must prove, on the balance of probabilities, two matters, namely that:

1. the Complainant has Rights in respect of a name or mark which is identical or similar to the Domain Name; and
2. the Domain Name, in the hands of the Respondent, is an Abusive Registration.

These terms are defined in the Nominet DRS Policy 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.
- **Abusive Registration** means 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.

Does the Complainant have Rights?

The Complainant is the owner of the registered 'word and device' trade mark shown below.



Whilst the overall mark comprises a significant device element of a person depicted with a clock face underneath a bowler hat, it also prominently includes the word ZIFERBLAT in stylised form. That trade mark registration is sufficient to give some rights in relation to the word element of the overall mark.

In addition, the Complainant has a reasonably substantial franchise business which licenses others to use the ZIFERBLAT name and mark for the operation of a 'pay-per-minute' café and meeting venue business. It is usual for franchise arrangements expressly to confirm that all reputation and goodwill in the licensed marks generated by the franchisee's use of them will

be for the benefit of and belong to the franchisor. However, the only franchise agreement exhibited with the complaint was the one dated 13 January 2015 made between the Complainant as Franchisor and My Happy Place Ltd as Franchisee and it contains what may be an unfortunate typing error (in which the first appearance of 'Franchisor' should probably have been 'Franchisee') in clause 15.1(b), by which the Franchisee acknowledged as follows:

- (b) any goodwill (and any other rights) in the Trade Marks which result from the use by the Franchisor of the Trade Marks shall vest in the Franchisor.

The licensed 'Trade Marks' were defined as being the registered trade mark shown above and the <ziferblat.co.uk> domain "solely for the purpose of creating and operating a website for the Franchisee's Business during the Term" of the agreement.

However, there are other clauses in the agreement which the Complainant could point to, notably clauses 15.1(a) and 15.5 which are as follows:

15.1 The Franchisee acknowledges that:

- (a) it does not have any right, title or interest in the Intellectual Property or any updates or improvements to it, except as specifically set out in this agreement and in the Manual;

15.5 The Franchisee acknowledges and agrees that all Intellectual Property is, and shall remain, the exclusive property of the Franchisor. The Franchisee shall hold the

The 'Intellectual Property' was defined as including the Trade Marks.

The Complainant also exhibited national media coverage of the opening of its first London outlet, which I understand was operated by its own subsidiary company, Ziferblat Ltd, (but under the terms of a franchise agreement that I have not seen) and it also has its own website at www.ziferblat.net which prominently uses the ZIFERBLAT name.

In the circumstances I am satisfied that the Complainant has Rights in the ZIFERBLAT name and mark for the purposes of Nominet's Dispute Resolution Service.

The fact that, as pointed out by the Respondent, 'Ziferblat' (or 'Zifferblatt') may be a word in common usage in the Russian or German language does not, of itself, prevent it from becoming a registered trade mark or acquiring trade mark rights through use. Likewise, the Respondent has tried to make something of the fact that the Complainant company is registered in Cyprus and is merely the holder of intellectual property which it licenses others to use, but that does not preclude it from owning relevant Rights.

Are the Rights in respect of a name or mark which is identical or similar to the Domain Name?

In assessing whether a domain name is identical or similar to a name or mark, the relevant ".co.uk" suffix can be ignored, unless perhaps the name or mark concerned itself includes a particular domain suffix, which is not the case here.

The only difference between the ZIFERBLAT name in which the Complainant has Rights and the Domain Name is the addition of "UK" at the end of it. That adds nothing of any material distinction, particularly in relation to a <.co.uk> domain name such as this one. Accordingly,

I find that the Domain Name is identical or similar to the ZIFERBLAT name and mark in which the Complainant has Rights.

Is the Domain Name, in the hands of the Respondent, an Abusive Registration?

Despite the Respondent being Digitalink Consultants Ltd because it is the current registrant of the Domain Name, the response was clearly drafted and filed by the previous registrant, Gareth Harold. It was signed off in his name and the response contains numerous references to 'us' 'we' and 'the Respondent' that are clearly references to his previous business, My Happy Place Ltd and his current business My Happy Place Management Services Ltd, rather than to the Respondent itself. Some examples are set out below:

"the <ziferblat.co.uk> domain name was operated by the Respondent for 5 years without objection."

"The Respondent's Ziferblat business has received more than 700 pieces of press and 12 awards since 2014. It operated in Liverpool and Manchester."

"The franchise agreement entered into between us and the Complainant was ended in 2015, we have evidence of this"

"The Domain Name is similar to others used by us for 6 years with the Complainant's knowledge"

"Digitaink [sic] has acted on behalf of the Respondent"

"Digitalink Consultants Limited and Bamboo Manchester have been working with the Respondent"

In preparing much of the response, Mr Harold seems to have forgotten that he transferred the registration of the Domain Name to Digitalink Consultants Ltd immediately before the DRS complaint was filed, so it is this company that is the Respondent and, as he himself explained in the response, *"There is no legal connection between My Happy Place Ltd and Digitalink. They have different shareholders and directors"*.

The issue is whether or not the Domain Name is abusive in the hands of the Respondent and that largely depends upon the use the Respondent is and has been making of it. Once the registration of a domain name has been assigned to an genuinely unconnected entity, it is that entity which is the Respondent and what the previous registrant might have been able to say in defence of the complaint based upon his previous use of it, either directly or through his business, becomes irrelevant.

If Mr Harold had remained the registrant of the Domain Name when the DRS complaint was filed, or claimed and explained any continuing corporate connection with the new registrant, in his response to the complaint he might (and I make no judgement in this regard) have been able to point to elements of Paragraph 8 of the DRS Policy, which sets out a non-exhaustive list of factors which may be evidence that the Domain Name is not an Abusive Registration.

In particular, paragraph 8.1.1. states as follows:

"8.1.1 Before being aware of the Complainant's cause for complaint (not necessarily the 'complaint' under the DRS), the Respondent has:

8.1.1.1 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;

8.1.1.2 been commonly known by the name or legitimately connected with a mark which is identical or similar to the Domain Name;

.....”

But Digitalink Consultants Ltd cannot rely upon this because they only became involved as the registrant of the Domain Name (and therefore as the Respondent) at some time between 1 April 2020 and 3 April 2020, immediately after Mr Harold had been informed of the ‘data release request’ made to Nominet by the Complainant in order to identify the registrant of the Domain Name for the purposes of their DRS complaint.

Paragraph 5 of the DRS Policy sets out a non-exhaustive list of factors which may be evidence that the Domain Name is an Abusive Registration. In its complaint, the Complainant relied upon paragraph 5.1.1.2 and 5.1.1.3, which state as follows:

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

5.1.1.1

5.1.1.2 as a blocking registration against a name or mark in which the Complainant has Rights; or

5.1.1.3 for the purpose of unfairly disrupting the business of the Complainant;

I am not persuaded that the reason for the Respondent acquiring the Domain Name at some time between 1 April 2020 and 3 April 2020 was primarily for either of these purposes. At that time, My Happy Place Management Services Ltd, which now operates the www.workslikeclockwork.co.uk website and business, was part way through the process of rebranding the business from ZIFERBLAT to CLOCKWORK and was using the Domain Name to resolve by redirection to its website as part of that process. Mr Harold, the previous registrant of the Domain Name and owner of the company, knew that these DRS proceedings were coming, having been informed of the ‘data release request’ made by the Complainant. In those circumstances, it is much more likely that the reason for the transfer of the Domain Name registration to the Respondent was an attempt to buy more time for the rebranding process to be concluded before control of the Domain Name was lost.

However, the Complainant also relied upon paragraph 5.1.2 of the DRS Policy, which states as follows:

5.1.2 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.

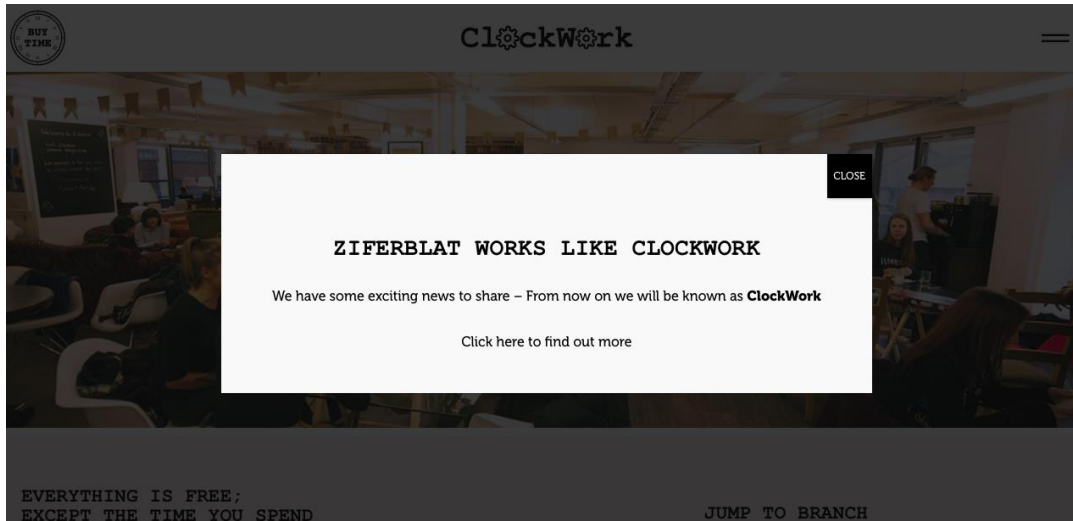
In the response, it was stated “... the Respondent has also ceased use of the Domain Name in all public facing format”. But that is not true, regardless of which entity Mr Harold was

actually referring to as 'the Respondent'. The continuing use to which the Domain Name has been put since Digitalink Consultants Ltd became the registrant is to resolve, by automatic redirection, to the website at www.workslikeclockwork.co.uk. That is public facing use of the Domain Name.

A simple Google search for the Domain Name (which I undertook) delivers the following results:

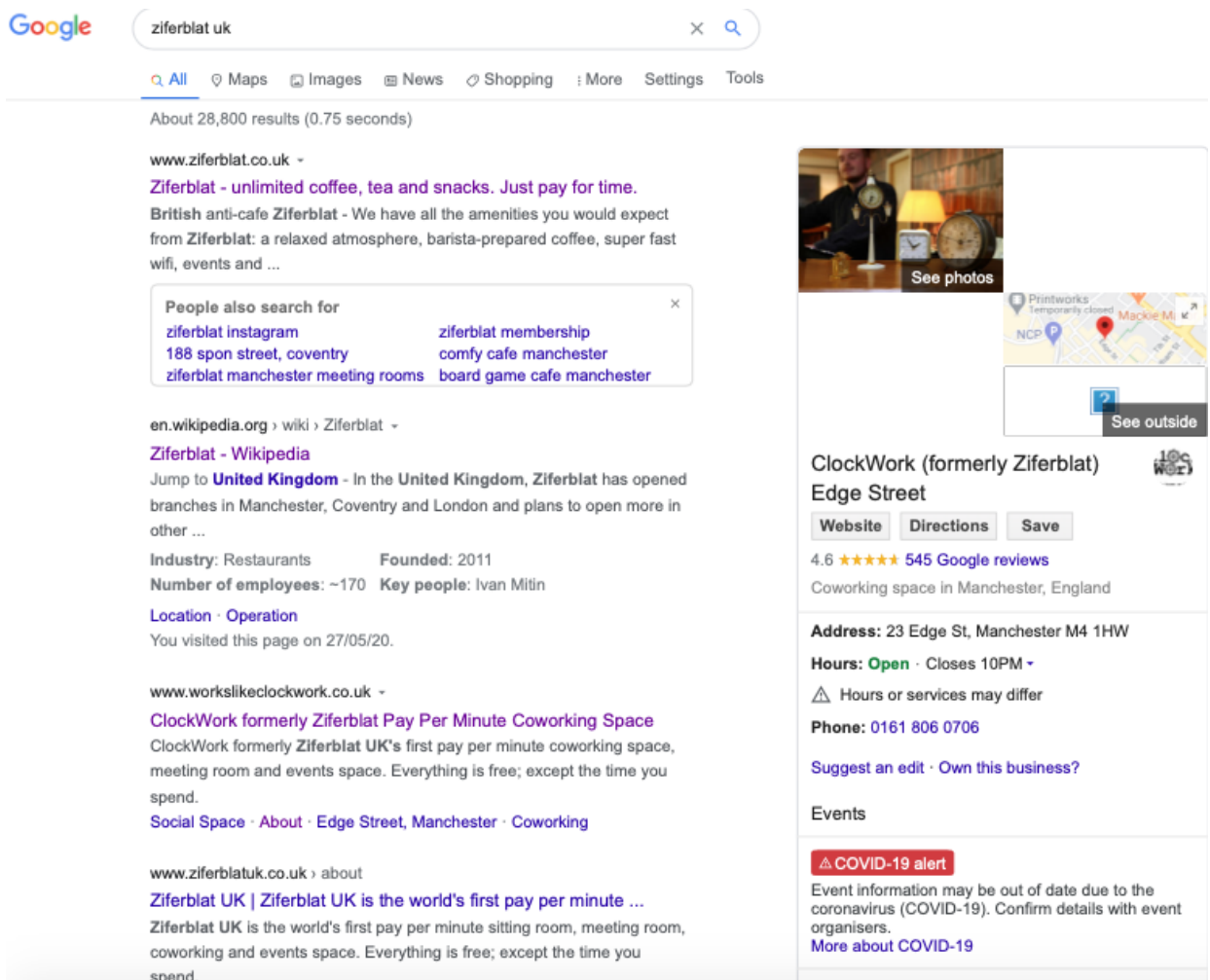
The screenshot shows a Google search interface. The search bar contains the text 'ziferblatuk.co.uk'. Below the search bar, there are navigation links for 'All', 'Shopping', 'News', 'Images', 'Maps', and 'More', along with 'Settings' and 'Tools'. The search results indicate 'About 1,090 results (0.40 seconds)'. A suggestion is provided: 'Did you mean: ziferblat.co.uk'. The first result is for 'www.ziferblatuk.co.uk' with the title 'ClockWork formerly Ziferblat Pay Per Minute Coworking Space'. The description states: 'ClockWork formerly Ziferblat UK's first pay per minute coworking space, meeting room and events space. Everything is free; except the time you spend. Edge Street, Manchester · Social Space · Coworking · Oxford Road, Manchester'. The second result is for 'www.ziferblatuk.co.uk > edge-street-northern-quarter' with the title 'The Dining Room - Ziferblat UK'. The description states: 'Floorplan. Room bookings are easily made! Email bookings@ziferblatuk.co.uk or use our online enquiry form below. Meeting Room Enquiry Form. Select your ...'. The third result is for 'www.ziferblatuk.co.uk > edge-street-northern-quarter' with the title 'The Study - Ziferblat UK'. The description states: 'Floorplan. Room bookings are easily made! Email bookings@ziferblatuk.co.uk or use our online enquiry form below. Meeting Room Enquiry Form. Select your ...'. The fourth result is for 'www.ziferblatuk.co.uk > edge-street'.

The Domain Name is clearly visible to the public in these results as part of the corresponding website address and the visitor who clicks on any of the links is automatically then taken to the website at www.workslikeclockwork.co.uk and met with the confusing message shown below:



The potential for confusion is readily apparent given that the Complainant continues to operate under the ZIFERBLAT name and to use the <ziferblat.co.uk> domain name to resolve to a website for its UK venues in London and Coventry.

Someone who does a Google search looking for 'ziferblat uk' is met with the even more confusing results shown below.



The first result is a reference to the Complainant's UK website and the second is a link to a Wikipedia article that seems to refer to both the Respondent's/My Happy Place Management Services Ltd's Manchester venue and the Complainant's Coventry and London venues as belonging to one and the same entity. The next two results are references to the business of the Respondent/My Happy Place Management Services Ltd, one showing a header for the www.workslikeclockwork.co.uk website and the other has a header for the website address that corresponds directly to the Domain Name, www.ziferblatuk.co.uk. Both links lead to the same website.

The Respondent, or rather Mr Harold, has successfully bought some further time for his continued use of the Domain Name as part of the rebranding of his business from ZIFERBLAT to CLOCKWORK. The sooner that is completed the better, but it is time to put an end to the Domain Name being used in this confusing and abusive manner.

7. Decision

For the reasons outlined above, I find that the Complainant has proved, on the balance of probabilities, 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.

In the circumstances I order that the Domain Name be transferred to the Complainant.

Signed Chris Tulley

Dated 5 June 2020