

Nominet UK Dispute Resolution Service

DRS 4630

Thomas Cook UK Limited v. Steve Roberts

Decision of Independent Expert

1. Parties

Complainant: Thomas Cook UK Limited

Address: Unit 17, The Thomas Cook Business Park
Coningsby Road
Peterborough
Cambridgeshire

Postcode: PE3 8SB

Country: GB

Respondent: Steve Roberts

Address: 8 Meadow Road
Hemel Hempstead
Herts

Postcode: HP3 8AH

Country: GB

2. Domain Name

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

3. Procedural Background

The Complaint was submitted to Nominet on 19 April 2007. Hardcopies were received in full on 20 April 2007 and the Complaint was validated by Nominet and sent to the Respondent by post and by email both to postmaster@[the Domain Name] and to the email address which Nominet held for the Respondent on the register database. The Respondent was informed in this correspondence that he had 15 working days, that is, until 15 May 2007 to file a response to the Complaint.

The Respondent did not file a response and the case did not proceed to the mediation stage. On 31 May 2007, the Complainant paid the fee for referral of the matter for an expert decision pursuant to paragraph 8 of Nominet's Procedure for the conduct of proceedings under the Dispute Resolution Service Version 2 ("the Procedure") and paragraph 7 of the corresponding Dispute Resolution Service Policy Version 2 ("the Policy"). On 5 June 2007, Andrew D S Lothian, the undersigned, ("the Expert") confirmed to Nominet that he knew of no reason why he could not properly accept the invitation to act as expert in this case and that he knew of no

matters which ought to be drawn to the attention of the parties, which might appear to call into question his independence and/or impartiality. Nominet duly appointed the Expert with effect from 7 June 2007.

4. Outstanding Formal/Procedural Issues

No response

The Respondent has failed to submit a response to Nominet in time in accordance with paragraph 5(a) of the Procedure.

Paragraph 15(b) of the Procedure provides inter alia that "If in the absence of exceptional circumstances, a Party does not comply with any time period laid down in the Policy or this Procedure, the Expert will proceed to a Decision on the complaint."

Paragraph 15(c) of the Procedure provides that "If in the absence of exceptional circumstances, a Party does not comply with any time period laid down in the Policy or this Procedure or any request by us or the Expert, the Expert will draw such inferences from the Party's non compliance as he or she considers appropriate." In the view of the Expert, if the Respondent does not submit a Response the principal inference that can be drawn is that the Respondent has simply not availed himself of the opportunity to attempt to demonstrate that the Domain Name is not an Abusive Registration. This does not affect the primary requirement upon the Complainant, on whom the burden of proof rests, to demonstrate Abusive Registration, nor does it in the Expert's view entitle an expert to accept as fact all uncontradicted assertions of the Complainant, irrespective of their merit.

5. The Facts

The Complainant is the well-known travel services company. It has used the name THOMAS COOK as a trading name for over one hundred years and owns a number of registered trade marks incorporating the name including Community Trade Mark nos. 266031, registered on 24 November 1998 (Thomas Cook); 1736677, registered on 20 February 2002 (THOMASCOOK.COM) and 2266922, registered on 14 January 2004 (Thomas Cook).

On 12 February 2007 the Complainant announced that it was to merge with a company named MyTravel to form an enlarged company named Thomas Cook Group in a £3 billion deal. The merger announcement was covered in the UK media.

The Respondent registered the Domain Name on 12 February 2007. On 22 March 2007, the Complainant wrote to the Respondent to request that he transfer the Domain Name. On 26 March 2007 the Respondent wrote to the Complainant stating that he was prepared to transfer the Domain Name in return for either £7,500 cash or £10,000 in holiday vouchers.

6. The Parties' Contentions

Complainant

1. The Domain Name is identical or similar to a name or mark in which the Complainant has rights. Thomas Cook is a trading name which has been used by the Complainant for over one hundred years. The Complainant operates a number of companies, the names of which include the words "Thomas Cook"; for instance, Thomas Cook Retail Ltd, Thomas Cook Airlines UK Ltd, Thomas Cook UK Ltd and Thomas Cook Tour Operations Ltd.
2. The Complainant has been arranging holidays for the public since 1840 and acts as a tour operator putting packages together and selling holidays to the public through a range of brochures branded Thomas Cook. The Complainant produces approximately thirty brochures each year. The Complainant's own holidays, and those of other companies,

are sold to the public through the Complainant's retail network of over 600 high street shops which are branded Thomas Cook. The Complainant also trades from a number of websites, including thomascook.com and flythomascook.com, and has registered a number of domain names which incorporate this name.

3. The Complainant operates in the UK and Europe, as well as other countries, and goodwill and brand recognition has been established in the name. The Complainant has registered a portfolio of trademarks worldwide for Thomas Cook, including numbers 002266922, 000266031 and 001736677. The Complainant asserts that Thomas Cook is a famous and well-known brand.
4. The Domain Name was acquired by the Respondent on the day that the Complainant announced an agreement to merge with MyTravel. Press announcements issued the same day stated that the two combined companies would be named Thomas Cook Group. The Complainant believes that the Respondent took unfair advantage of the situation when the announcement was made, to the detriment of the Complainant. It is clear that the Respondent has no genuine or bona fide reason to acquire the Domain Name, since he has no rights in the name Thomas Cook and no legitimate use could be made of it.
5. The Complainant wrote to the Respondent to advise of its rights in the name Thomas Cook, and to ask that the Domain Name be assigned to the Complainant. The Respondent offered to assign ownership of the Domain Name if a sum of £7,500 or £10,000 in holiday vouchers was paid to him. The Complainant claims that the Domain Name is abusive because it was registered for the purpose of selling or transferring it to the Complainant, or one of their competitors, for a price greater than the Respondent's costs, and registered to stop the Complainant registering it, despite the Complainant's common law and trademark rights in the name.

Respondent

The Respondent has not filed a response.

7. Discussion and Findings:

General

In terms of paragraph 2(b) of the Policy the primary onus is on the Complainant to prove to the Expert on balance of probabilities each of the two elements set out in paragraph 2(a) of the Policy, namely that:

- (i) The Complainant has Rights in respect of a name or mark which is identical or similar to the Domain Name; and
- (ii) The Domain Name, in the hands of the Respondent, is an Abusive Registration.

Complainant's Rights

Paragraph 1 of the Policy provides that Rights "includes, but is not limited to, rights enforceable under English law. However, a Complainant will be unable to rely on rights in a name or term which is wholly descriptive of the Complainant's business". Accordingly there are three questions to consider - (1) whether the Complainant has Rights; (2) if the Complainant does have Rights, whether the name or term in which the Complainant has these is wholly descriptive of its business; (3) if not wholly descriptive, whether the name or mark is identical or similar to the Domain Name.

Complainant's Rights in the mark 'THOMAS COOK'

The requirement to demonstrate Rights under the Policy is not a particularly high threshold test. Under English Law, rights in a name or mark can be protected by registered trade marks, or unregistered rights such as the entitlement to bring a claim for passing off to protect goodwill inherent in any such name or mark.

The Complainant has cited one Community Trade Mark in respect of 'THOMASCOOK.COM', and another two in respect of 'Thomas Cook'. Accordingly the Expert finds that the Complainant has rights in the name or mark THOMAS COOK.

The second question for the Expert is whether this name or mark is wholly descriptive of the Complainant's business. The Complainant's business is the provision of travel services. The name or mark THOMAS COOK is not in any way descriptive of such services.

The remaining question therefore is whether the name or mark is identical or similar to the Domain Name. The first (.uk) and second (.co) levels of the Domain Name can be disregarded as being wholly generic. The Expert is then left with a comparison between the name or mark 'THOMAS COOK' and the third level part of the Domain Name 'thomascookgroup'. Clearly, the name or mark in which the Complainant has rights is not identical to the Domain Name but is it similar?

It is immediately apparent to the Expert that the Domain Name reproduces the Complainant's trade mark together with the generic or descriptive word 'group'. Previous cases under the DRS such as, for example, Deutsche Telekom v ADO1 (DRS 456), and Pickfords Limited v Black Cat (DRS 898), have dealt with similar domain names incorporating a trade mark and the addition of a generic or non-distinctive word, usually descriptive of the complainant's business or products. In these cases the experts held that the domains in question were sufficiently similar to a name or mark in which the complainant had rights in terms of the Policy.

In the present case, the Expert is satisfied that the dominant element of the Domain Name is the Complainant's well-known and distinctive trade mark. The addition of the word 'group' does nothing to distinguish the Domain Name from that mark. In these circumstances, the Expert finds that the Domain Name is similar to a name or mark in which the Complainant has Rights.

Abusive Registration

Is the Domain Name, in the hands of the Respondent, an 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. has been used in a manner, which took unfair advantage of or was unfairly detrimental to the Complainant's Rights."

A non-exhaustive list of factors which may constitute evidence of Abusive Registration is set out in paragraph 3 of the Policy.

In addition to its general submission that the Domain Name is an Abusive Registration, the Complainant makes a specific submission that the Respondent registered the Domain Name for the purpose of selling or transferring it to the Complainant, or one of its competitors, for a price greater than the Respondent's costs. This submission falls within paragraph 3(a)(i)(A) of the Policy.

It is clear to the Expert from the Complainant's evidence that the Respondent intentionally registered the Domain Name with the Complainant in mind. This is demonstrated by the fact that the registration was made on the same day as the Complainant's announcement that it would be merging with MyTravel and that the merged entity would be known as 'Thomas Cook Group'. Furthermore, the Respondent's motivation and primary purpose in registering the Domain Name are also entirely clear from the terms of the Respondent's letter to the Complainant of 26 March 2007 in which he offered to transfer the Domain Name in return for the sum of £7,500 in cash or £10,000 in holiday vouchers, an amount clearly in excess of the Respondent's out of pocket costs for the registration.

The Expert considers that the Complainant has made out a clear case of the circumstances contemplated by paragraph 3(a)(i)(A) of the Policy. Accordingly, the Expert is satisfied that the Complainant has proved on balance of probabilities that the Domain Name constitutes an Abusive Registration in the hands of the Respondent.

8. Decision

The Expert finds that the Complainant has proved that it has Rights in a name or mark 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.

Andrew D S Lothian

18 June 2007