

**DISPUTE RESOLUTION SERVICE**

**DRS 7388**

**Decision of Independent Expert**

Top Connect Oü

Complainant

and

Paul Bridgeman

Respondent

**1 The Parties**

Complainant:	Top Connect Oü
Address:	Peterburi tee 47 Tallinn
Postcode:	11415
Country:	Estonia

Respondent:	Paul Bridgeman
Address:	124 Claymoor Flora Street Oldham Lancashire
Postcode:	OL1 2XG
Country:	United Kingdom

## **2 The Domain Name**

*travelsim.co.uk* (the "Domain Name").

## **3 Procedural History**

- 3.1 The Complaint was filed on 19 June 2009. It was validated and a copy was sent to the Respondent on the same date.
- 3.2 The Response was filed on 13 July 2009. It was validated and a copy was sent to the Complainant on the same date.
- 3.3 The Reply was filed on 23 July 2009. It was validated and a copy was sent to the Respondent on the same date.
- 3.4 The dispute then entered the mediation phase. The mediation failed on 25 August 2009. On the same date the parties were notified that the dispute would be decided by an Independent Expert (the "Expert") if the Complainant paid the requisite fees. On 3 September 2009 a conflict check was sent to the Expert, who confirmed on 4 September that he is independent of the parties and knows of no facts or circumstances that might call into question his independence in the eyes of the parties.
- 3.5 On 11 September 2009 the Expert was notified by Nominet that the Respondent's representative had filed a Further Submission pursuant to paragraph 13(b) of the Procedure. Pursuant to paragraph 13 of the Procedure, the Expert has considered that submission.

## **4 Factual Background**

- 4.1 The Complaint is made jointly in the names of Anthony Rivshin, Max Rivshin and Top Connect Oü, though the Reply identifies only Top Connect Oü as the Complainant. Top Connect Oü appears to be a company incorporated in Estonia owned equally by Anthony Rivshin and his brother Max Rivshin. For the purposes of this decision, and in accordance with the Reply, Top Connect Oü is the Complainant.
- 4.2 The Complainant claims to be the second largest telecommunications company in Estonia and to own and use the trading name "CSC Telecom". In fact, CSC Telecom is a US based corporation (see [www.csc.com](http://www.csc.com)) which appears to have entered into some kind of partnering or licensing arrangement with the Complainant for the provision of telecommunications services in Estonia under the CSC Telecom name.
- 4.3 The Complainant says that it has traded under the TRAVELSIM name since June 2005.

- 4.4 On 11 November 2005 the Complainant registered the domain name *travelsim.com*.
- 4.5 On 15 March 2006 the Complainant filed an application for a Community Trade Mark, which was registered on 10 August 2007 with number 004959334, in class 38 as a figurative mark, i.e. entitling it to protect a design incorporating the colours grey, violet and black and featuring a circular logo together with the term "travelSIM". A copy of the registered mark is at Annex A to this decision.
- 4.6 On 30 April 2008 the Domain Name was registered. According to the Whois database maintained by Nominet, the registrant of the Domain Name is Paul Bridgeman (the "Respondent"). The Respondent has opted to have his address omitted from the Whois service on the basis that he is a non-trading individual.
- 4.7 The Respondent would appear to be a telecoms engineer. Notwithstanding his assertion when he applied to register the Domain Name in April 2008 that he was a non-trading private individual, he now says that since early 2007 he has been selling travel SIM cards as a reseller for Story Telecom, initially selling direct to customers and then through eBay. In 2008 he decided to sell online via his own website.
- 4.8 The Complainant says that it too sells travel SIM cards. The Complainant and the Respondent would therefore appear to be operating in the same market, though it is not clear to what extent they operate in the same territories. The Complainant says that it has two distributors in the UK and that it has sold *"thousands of SIM cards to customers in the UK or travelling from the UK"*.
- 4.9 The Domain Name is currently being used by the Respondent in the URL of a website promoting and selling an *"international free roaming SIM card"* which is promoted as a means of avoiding *"extortionate roaming charges from your mobile operator"*. The website also makes reference to the fact that it does not use *"an expensive Estonia +372 mobile number"* and includes at the top of the home page the following statement:

*"Disclaimer: we are not Travel SIM who are based in Estonia nor do we have any connection with their pay as you go sim card service. We are a UK based supplier of pre-paid GSM Mobile Sim Cards, including free worldwide roaming for business travel."*

## **5 Parties' Contentions**

### Complaint

- 5.1 The Complainant says that it and its "affiliates" are the registrants of "11 other *travelsim domain names*" including *travelsim.com, travelsim.org, travelsim.eu, travelsim.biz, travelsim.es, travelsim.de, travelsim.cn, travelsim.net.au, travelsim.it, travelsim.tw* and *travelsim.co.nz*. It also asserts that it and its affiliates own "a

range of *travelsimshop* domain names", such as *travelsimshop.com*. However, no evidence is provided that it is the registrant of any of those domain names, with the exception of *travelsim.com* which is indeed registered to the Complainant.

- 5.2 The Complainant also places considerable reliance on the fact that it is the proprietor of a figurative Community Trade Mark as described at paragraph 4.5 above.
- 5.3 Further, it asserts that "*Travelsim is a well-known and well established seller, distributor and support provider of sim card products, both extensively throughout Europe and globally*". It says that the Respondent is a direct business competitor. It says that it has 15 licensed 'travelsim' distributors worldwide and that it therefore asserts "*statutory naming rights*" throughout the European Union since 15 March 2006 at the latest (the filing date of its CTM).
- 5.4 In addition, the Complainant asserts common law rights in the TRAVELSIM name since June 2005. In support of this contention, it asserts (without any evidence in support) that as at 13 May 2009 it had more than 140,000 SIM card products in circulation branded with its registered trade mark, that it employs 22 staff and seven independent contractors working exclusively on its travel SIM products and that in each of 2007 and 2008 it has spent in excess of €5,000 on Google advertising.
- 5.5 It says that it registered the domain name *travelsim.com* on 11 November 2005 and points out (correctly) that the Domain Name was not registered by the Respondent until more than two years later on 30 April 2008.
- 5.6 It says that the Respondent is the registrant of *travelsim.asia* and *travelsim.us* but asserts that the Respondent has no right to use those domain names.
- 5.7 It says that the Respondent's website at *www.travelsim.co.uk* is using a similar 'get up' to that of the Complainant in a manner which is intended to cause consumer confusion. It also complains of the fact that the Respondent has bid for Google Adwords on the TRAVELSIM name.
- 5.8 The Complainant asserts that in the circumstances there is evidence of Abusive Registration because:
  - (a) the Respondent registered the Domain Name primarily for the purpose of unfairly disrupting the Complainant's business (Policy, 3(a)(i)(C));
  - (b) 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 (Policy, 3(a)(ii)); and

- (c) the Respondent is engaged in a pattern of registrations where the Respondent is the registrant of domain names (under *.uk* or otherwise) which correspond to well known names or trade marks in which the Respondent has no apparent rights, and the Domain Name is part of that pattern (Policy, 3(a)(iii)).

## Response

- 5.9 In a nutshell, it is the Respondent's case that the Complainant has no Rights (as defined in the Policy) in respect of the term "travel SIM" and that, even if it did, there is no evidence of Abusive Registration on the part of the Respondent. Indeed, the Respondent asserts that this is a case of reverse domain hijacking by the Complainant on the basis that the Complainant "*cannot seriously have considered that it would succeed*" in its Complaint.
- 5.10 The Respondent argues that the term "travel SIM" (consisting of "travel" and "SIM") is a generic term which is descriptive of a mobile telephone SIM card for use while travelling. He adduces in support of that contention Google search results showing many generic references to "travel SIM" and "travel sim", Google News articles showing that the term "travel SIM" was in use in 2004 and early 2005, i.e. before the Complainant claims to have started using the term, and relies on the fact that all of those articles relate to a product the same as that distributed by the Complainant and Respondent, i.e. travel SIM cards. He also adduces in evidence a number of examples of UK travel SIM providers using the term "travel SIM" in relation to travel SIM cards. He exhibits a list of many domain names apparently unconnected with the Complainant, including the character string "travelsim".
- 5.11 The Respondent points out that the Complainant's co-owner Anthony Rivshin stated in a media interview that: "*TravelSIM was the most logical and appropriate name to use. Not only does it emphasize Travel but also a GSM SIM card and Simplicity!*".
- 5.12 The Respondent asserts that for all these reasons the public has no more reason to associate the term "travel SIM" with the Complainant any more than with the common English meaning of the travel SIM card supplied by many businesses in the UK, including the Respondent, as well as overseas businesses such as the Complainant. He says that the term "travel SIM" is not capable of functioning as a badge of origin and relies on the decision in *datingagency.co.uk* (DRS 752) where the term "dating agency" was held to be both generic and descriptive and therefore, absent a secondary distinctive meaning, did not afford the Complainant any protection.
- 5.13 The Respondent also relies on the House of Lords decision in *Office Cleaning Services Limited v Westminster Window & General Cleaners Limited* (1946) 63 RPC

39, HL which highlighted the risk run by traders who used words in common usage as trade names.

- 5.14 On the question of whether or not the Complainant would be able to rely on a secondary distinctive meaning, the Respondent's primary case is that the term is too generic and descriptive to be capable of generating secondary rights.
- 5.15 But even if he is wrong about that, his position is that in any event the Complainant has failed to demonstrate that the term "travel SIM" has acquired a distinctive secondary meaning. He points out that the Complainant's claims about its trading history and distribution network are unsupported by evidence. He points out that there is no evidence in support of the Complainant's assertion that it has had common law rights in the term since June 2005 or indeed of its assertion that there are approximately 140,000 SIM cards in circulation bearing its logo. Likewise there is no evidence of the claimed turnover.
- 5.16 So far as the Complainant's registered CTM is concerned, the Respondent points out that it does not constitute protection for the term "travel SIM" but is in fact a "figurative" mark, i.e. a device mark, which protects the visual elements of the design and not the word itself. The Respondent cites a number of UDRP decisions in support of his contentions on this point and argues that similar principles should apply under the DRS, notwithstanding that the test under the DRS is one of "similarity", rather than one of "confusing similarity" (as it is under the UDRP).
- 5.17 As regards Abusive Registration, the Response asserts that the Respondent registered the Domain Name "*for the simple reason that it was the generic name of the product which he was selling and he thought it was therefore a good name to use*". The Respondent acknowledges that he checked to see whether the .com version of the Domain Name was available and saw that it had been registered by the Complainant. He says that it did not occur to him that that should prevent him from registering the .co.uk version. He says that the Complainant was simply one of many businesses in the travel SIM card business using the name generically. He says that he has approximately 2,500 travel SIM cards in circulation and that the Domain Name is crucial to his business because the URL *www.travelsim.co.uk* is identified as the point of contact for all those customers to top up their SIM cards. The website is also listed in the Respondent's user guide for connection settings.
- 5.18 The Respondent relies on the decisions in *maestro.co.uk* (DRS 4884) and *oasis.co.uk* (DRS 6365), both of which were decisions of an Appeal Panel, and both of which held in effect that where the mark in question is an ordinary English word no inference of abusive registration will arise simply because the Respondent knew of the existence of a business trading by reference to that word.
- 5.19 So far as the get up of the Respondent's website is concerned, the Respondent has exhibited a series of emails to demonstrate that the design of the Respondent's

website was not intended to copy or otherwise take advantage of the colour scheme used in the Complainant's site and that it could not therefore constitute evidence of causing "customer confusion".

- 5.20 The Respondent admits bidding on the term "travel SIM" in Google Adwords, but asserts that there is nothing to prevent him from doing so.
- 5.21 Likewise, the Respondent asserts that the complaints of disruption of business and confusion of customers are misconceived because the Complainant owns no goodwill in the term "travel SIM" and relies in this regard on the decision in *wiseinsurance.co.uk* (DRS 4889).
- 5.22 He also says that the complaint of engaging in a pattern of registrations has not been made out because the domain names in question (*travelsim.us* and *travelsim.asia*) do not correspond to well known names or trade marks and therefore do not fall within paragraph 3(a)(iii) of the Policy.

### Reply

- 5.23 The Complainant rejects the Respondent's argument that the term "travel SIM" is descriptive of its business. The Complainant points out that it is "*in the business of the online retail sales of international telecommunications sim card products and support services*" and that therefore the term is not wholly descriptive of its business. It relies on the decisions in *game.co.uk* (DRS 2166) and *myspace.co.uk* (DRS 4962) in that regard.
- 5.24 In addition, it relies on the decision in *kitheath.co.uk* (DRS 4764) which pointed out that it was well established that the threshold as to Rights is a low one. Unhelpfully, however, the Complainant has omitted from the words quoted in that decision an important qualifier, namely that the Respondent did not in that case contest the Complainant's assertions as to his rights in the name. The use by parties to DRS proceedings of selective quotations in a way which has the object or effect of misleading the Expert is not helpful, to say the least.
- 5.25 The Complainant says it is not seeking "exclusive use" of the "travelSIM" mark. It says its exclusive right to use of that name is limited to the web-based sale of international telecommunications SIM card products and support services.
- 5.26 The Complainant says that the fact that the Respondent was unaware of whether the Complainant carried on business in the UK is immaterial, given that it is the proprietor of a registered CTM. Further, the Complainant says that it has two distributors in the UK and has sold "thousands" of SIM cards to "clients based in or travelling abroad from the UK".
- 5.27 The Complainant says that the Respondent trades as Easy Roam, which it says is a "contingency plan" in the event that he has to transfer the Domain Name to it and that therefore his business would not be "irreparably damaged" (as the

Respondent asserted) in those circumstances. The Complainant says that the fact that the Respondent trades as Easy Roam, coupled with the fact that he knew of the Complainant's interest in the "travel SIM" mark at the time he registered the Domain Name and his use of a similar colour scheme on his website constitutes *"an intentional attempt to pass off on the goodwill of the Complainant's business interest"*.

- 5.28 Finally, the Complainant draws attention to the fact that the Respondent's representative in this case is also on Nominet's panel of Independent Experts. He raises the question of whether this *"may introduce aspects of procedural fairness into play"*.

#### Paragraph 13(b) statement

- 5.29 The Respondent has relied on paragraph 13(b) of the DRS Procedure in filing a non-standard submission. Paragraph 13(a) of the Procedure provides that: *"The Expert will not be obliged to consider any statements or documents from the Parties which he or she has not received according to the Policy or this Procedure or which he or she has not requested."* By way of exception to that general principle, a party may file a non-standard submission accompanied by *"a brief explanation of why there is an exceptional need for the non-standard submission"*.
- 5.30 In this case, the Respondent contends that in its Reply the Complainant made new claims about its business activities in the UK and concerning another website operated by the Respondent. The Respondent says that those claims are *"highly misleading"* and that he should therefore have an opportunity to respond to them.
- 5.31 The Respondent responds to the Complainant's assertion (see paragraph 5.26 above) that it has two distributors in the UK and has sold "thousands" of SIM cards to clients based in or travelling abroad from the UK. The Respondent says that both those distributors, Oneroam and Go-Sim, distribute travel SIM cards under their own names, not by reference to the "travel SIM" mark. He points out that there is no evidence from the Complainant that those distributors ever distributed cards under the "travel SIM" name. The Respondent suggests that those cards were supplied in blank by the Complainant and that the reference to "travelSim Cards plus airtime" on the invoice dated 15 May 2006 is simply an example of the term being used in its descriptive sense.
- 5.32 The Respondent also responds to the Complainant's contention that the Respondent trades as Easy Roam (see paragraph 5.27 above). The Respondent says that his website at URL [www.easyroam.co.uk](http://www.easyroam.co.uk) was set up specifically to handle SIM cards supplied by Story Telecom Limited and that he never dealt with more than approximately 150 customers through that website. The Respondent says that his website at URL [www.travelsim.co.uk](http://www.travelsim.co.uk) handles SIM cards provided by Callkey, which covers approximately 2,500 customers, all of which use the website



incorporating the Domain Name in its URL as their point of contact for customer service and for topping up their SIM cards.

## 6 Discussions and Findings

### General

6.1 To succeed under the Policy, the Complainant must prove on the balance of probabilities, first, that he has Rights (as defined in the Policy) in respect of a name or mark that is identical or similar to the Domain Name (paragraph 2(a)(i) of the Policy), and secondly, that the Domain Name is an Abusive Registration in the hands of the Respondent (paragraph 2(a)(ii) of the Policy).

6.2 Abusive Registration is defined in paragraph 1 of the Policy in the following terms:

*"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."*

### Complainant's rights

6.3 The Complainant relies on its Community Trade Mark number 004959334 registered on 10 August 2007 (filing date 15 March 2006) in class 38 as a figurative mark. As the Respondent correctly points out, the statutory protection afforded to the Complainant by that registration is of the design element and not of the term "travel SIM" itself.

6.4 It might reasonably be thought that where a registrant has no registered word mark, or even a word and device mark, it would face an uphill struggle in seeking to demonstrate that it has enforceable legal rights in relation to the word alone which, for the purposes of a dispute concerning a domain name, is necessarily the relevant element, particularly where, as here, the word in question is generic and/or descriptive.

6.5 In *Loans.co.uk* (DRS 1399) the Expert held that:

*"A registered trade mark for a word and device mark rather than the word alone may only be of limited value in a domain name dispute which necessarily relates only to words in which Rights might have been acquired"*

6.6 However, that approach has not been followed in later DRS cases. In *Record-power.co.uk* (DRS 4849) the Complainant's reliance on a device only mark did not

preclude the Complainant from relying on that registered trade mark as evidence of its Rights.

- 6.7 In *Dragoncarp.co.uk* (DRS 1082), which again concerned a device only registered trade mark, including the words DRAGON and CARP, the Expert held that the trade mark registration gave rise to Rights in the name DRAGONCARP on the basis that *"the words are an essential feature of the overall mark"* and that *"the combination of the words "Dragon" and "Carp" are sufficiently unusual in everyday usage to provide protection whether the words are set out in plain or stylised form"*.
- 6.8 Decisions under the UDRP suggest that rights which are restricted to a registered device mark will be weak for the purposes of a domain name dispute (see, for example, *Sweeps.com* (WIPO Case No. D2001-0031) and *minibarsystems.com* (WIPO Case No. D2005-0035)). Indeed, a number of decisions under the UDRP have found that a device mark does not of itself give a Complainant rights under the UDRP (see *brisbanecity.com* (WIPO Case No. D2001-0047), *cream.com* (WIPO Case No. D2001-0964), *britishmeat.com* (WIPO Case No. D2003-0645), *aberdeenairport.com* (WIPO Case No. D2004-0717) and *gatwick.com* (WIPO Case No. D2004-0555)).
- 6.9 The Respondent contends that the same principle must apply under Nominet's DRS because otherwise *"Complainants could establish trade mark rights in generic terms which are not registrable per se as word marks, simply by including the generic term as part of a heavily stylised logo or device mark"*. On a common sense basis, that submission has some force. However, it does not accord with the current state of English trade mark law. As Jacob LJ observed in *Phones4U Limited & Anor v Phone4U.co.uk Internet Limited & Ors* [2006] EWCA Civ 244:

*"Can one say, because the mark is a logo, moreover, in colour, that the mere words "phone4u.co.uk" cannot infringe? One can heighten the point by asking whether the words "Phones 4u" simpliciter would infringe?*

*If one were starting trade mark law all over again there would be something to be said for this. If you need to put words in a device to get them registered you ought not to be allowed later (unless there is later acquired distinctiveness) to say the words alone infringe. Putting it another way if you needed a device to get registered only the same or a confusingly similar device should infringe. Here, for instance, when the device was registered the Office clearly regarded the mere words as insufficiently distinctive - even the words in the black and white logo were so regarded. Yet now the mark is registered it is said it covers just that which the Office would not register.*

*But one is not starting trade mark law now. One has to go by the existing legislation. Once a mark has got on the register, the rights given are those conferred by Art.5 as enacted in s.10 of the UK Act. The only question here*

*is that posed by Art.5(1)(b) - confusing similarity. That involves an overall ("global") comparison of the registered mark with the alleged infringement. If one undertakes that here, a clear, prominent and memorable part of the registered mark is the words as such. It seems inevitable that taking those words as such (or a trivial variant such as phone4u) will cause confusion. So those words would have infringed but for the limitation."*

- 6.10 Paragraph 2(a)(i) of the Policy requires the Complainant to prove that it *"has Rights in respect of a name or mark which is identical or similar to the Domain Name"*. 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"*.
- 6.11 On the basis of the decision of the Court of Appeal in the *Phones4U* case, the Complainant has enforceable rights in its registered device mark. The term "TravelSIM" is a clear, prominent and memorable part of the device mark (see Annex A). Accordingly, the device mark is similar to the Domain Name and the Complainant therefore satisfies paragraph 2(a)(i) of the Policy.
- 6.12 Even if it had not, there is also the question of whether the Complainant has nonetheless acquired common law rights in the term "travel SIM".
- 6.13 The term "travel SIM" is plainly a conjunction of two generic words. Both "travel" and "SIM" are to be found in the dictionary. Each word has its own meaning. Moreover, the Respondent has adduced quite a lot of evidence to demonstrate that the term "travel SIM" is both generically used and is descriptive of a SIM card which can be used while travelling. There is nothing distinctive or unique, therefore, about the term "travel SIM" nor about its two constituent elements.
- 6.14 The Complainant may nonetheless have acquired common law rights (which is sufficient for paragraph 2(a)(i)) in the term "travel SIM" if it can demonstrate that it has the benefit of any trading goodwill attached to that name, i.e. that it has, in the hands of the Complainant, acquired a distinctive secondary meaning which serves as a badge of origin for the Complainant's services. The Complainant relies in this regard on its registration of other travel SIM domain names and on its business activities generally.
- 6.15 While the Complainant says that it and its "affiliates" are the registrants of 11 other travel SIM domain names, it would appear that in fact only two of them (*travelsim.com* and *travelsim.org*) are registered to the Complainant. No evidence or explanation is provided as to the capacity in which the registrants of the other nine are affiliates of the Complainant.
- 6.16 So far as the Complainant's trading activities are concerned, the evidence before the Expert is very thin. There is a photocopy of what appears to be marketing

material for CSC Telecom, which contains a reference to the URL [www.travelsim.com](http://www.travelsim.com) and the Complainant's device mark together with the slogan: "One world, one sim, no limits. The GSM global roaming solution for travelers".

- 6.17 There is also what appears to be a copy of a card incorporating a SIM card, again bearing the registered device mark and the words "product of CSC Telecom". CSC Telecom is not the Complainant.
- 6.18 There is an Excel spreadsheet headed "Google Ireland Limited" containing various amounts of Euros which total €5,457.71.
- 6.19 There is a screen grab from the website at [www.travelsim.com](http://www.travelsim.com) which includes the device mark and usage of the term "travelSIM" (e.g. "Welcome to TravelSIM website!" and "TravelSIM news").
- 6.20 The Complainant has exhibited to its Reply an invoice dated 15 May 2006 to Media Meeting Limited for €10,500 which appears to be for airtime.
- 6.21 None of that evidence, whether considered individually or collectively, speaks of even a modestly successful business, let alone of *"a well-known and well established seller, distributor and support provider of sim card products, both extensively throughout Europe and globally"*. On the evidence before the Expert, the Complainant's common law rights in the term "travel SIM" are weak and the Respondent's submissions in this regard have some force.
- 6.22 Nonetheless, the Complainant probably owns some trading goodwill in the term "Travel SIM". Indeed, even the Respondent acknowledges as much, at least impliedly, when he states on his website that: *"We are not Travel SIM who are based in Estonia nor do we have any connection with their pay as you go sim card service"*. The Respondent is using the term "Travel SIM" to identify the Complainant.
- 6.23 The term "travel SIM" is plainly identical or similar to the Domain Name. Even leaving aside its registered (device only) trade mark, the Complainant would therefore just about limp home under paragraph 2(a)(i) of the Policy on the basis of its common law rights as well.

#### Evidence of abusive registration

- 6.24 As set out in paragraph 5.8 above, the Complainant relies on three provisions of the Policy in relation to the question of whether there is evidence of Abusive Registration.
- 6.25 Firstly, the Complainant relies on paragraph 3(a)(i)(C) which provides that circumstances indicating that the Respondent has registered or otherwise acquired the Domain Name primarily for the purpose of unfairly disrupting the business of the Complainant may constitute evidence of Abusive Registration. In support of

that contention, the Complainant appears (though it is not clear) to rely on its submissions that (a) the Respondent is a direct business competitor of the Complainant, (b) the Respondent has registered the domain names *travelsim.asia* and *travelsim.us*, (c) the Respondent's website is confusingly similar to that of the Complainant, (d) the Respondent is bidding on the term TRAVELSIM for the purpose of buying Google Adwords and (e) the Respondent has a "contingency plan in place", i.e. by reference to his Easy Roam website.

- 6.26 Whether taken individually or collectively, those factors do not of themselves indicate that the Respondent registered the Domain Name primarily for the purpose of unfairly disrupting the Complainant's business. Given the generic and descriptive nature of the term "travel SIM", and given that the Respondent is in the same line of business as the Complainant, it is not surprising that the Respondent has registered two other TRAVELSIM domain names or that it bids on TRAVELSIM for the purpose of buying Google Adwords. Needless to say, the fact that the Respondent is a competitor of the Complainant is not of itself evidence of ill intent. The Respondent's website is quite similar to that of the Complainant, but not confusingly so. To some extent, the Complainant is the author of its own misfortune in choosing such a generic and descriptive term under which to trade. The fact that the Respondent also trades as Easy Roam on a separate website does not necessarily raise an inference, as the Complainant contends, that this represents some kind of "contingency plan" in the event that he is deprived of the Domain Name.
- 6.27 Plainly the Domain Name was registered after the Complainant's CTM was registered and the Respondent has in any event conceded that he was aware that the Complainant had registered the .com version of the Domain Name. While the Complainant does not positively advance a case that the registration of the Domain Name by the Respondent two years after the Complainant set up its business and knowing of the Complainant's registration of the .com version of the Domain Name raises an inference of abusive registration, any such case is answered by the Respondent in reliance on the decisions in *maestro.co.uk* (DRS 4884) and *oasis.co.uk* (DRS 6365), both of which were decisions of an Appeal Panel. Both of those decisions held, in effect, that where the mark in question is an ordinary English word an inference of abusive registration will not arise simply because the Respondent knew of the existence of a business trading by reference to that word. While the term "travel SIM" is perhaps not quite so clearly an ordinary English word, in the same way as oasis or maestro is, the same principle must hold good where the term in question is generic and/or descriptive.
- 6.28 Given the generic and descriptive characteristics of the "travel SIM" name, the Complainant has not therefore demonstrated on the balance of probabilities that the Domain Name was registered primarily for the purpose of unfairly disrupting the Complainant's business.

- 6.29 Secondly, the Complainant relies on paragraph 3(a)(ii) of the Policy which provides that 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 may be evidence of Abusive Registration.
- 6.30 Again, it is not entirely clear from the Complaint and the Reply what evidence is adduced by the Complainant in support of this contention. While it is true that the two websites are quite similar in appearance, the Respondent has explained the provenance of the design of his website. Further, the Respondent's website expressly disclaims any connection with the Complainant. There is no evidence that the Respondent has copied the Complainant's registered trade mark.
- 6.31 This is a case which falls squarely within the principle of *Office Cleaning Services Limited v Westminster Window & General Cleaners Limited* (1946) 63 RPC 39, HL. That principle has been applied in DRS proceedings. In *Wiseinsurance.co.uk* (DRS 4889) an Appeal Panel held that:
- "... the limitations of the goodwill associated with the Complainant's use of its name, makes the likelihood of such confusion very low indeed, and given that the Complainant has adopted a descriptive name for its business it cannot, without more extensive rights, complain about the use of the same descriptive name by a third party."*
- 6.32 Where a Complainant uses a generic or descriptive term, it is going to be that much harder for it to demonstrate that the Domain Name is being used by the Respondent in a way which is confusing people into believing that it is connected with the Complainant. The Complainant has failed to discharge that burden in this case.
- 6.33 Finally, the Complainant relies on paragraph 3(a)(iii) of the Policy which provides that there may be Abusive Registration if the Complainant can demonstrate that the Respondent is engaged in a pattern of registrations where the Respondent is the Registrant of domain names (under .uk or otherwise) which correspond to well known names or trade marks in which the Respondent has no apparent rights, and the Domain Name is part of that pattern. The Complainant relies in this regard on the Respondent's registration of the domain name *travelsim.us* and *travelsim.asia*.
- 6.34 For the reasons set out in paragraphs 6.13 to 6.21 above, the "travel SIM" name does not fall into the category of "*well known names or trade marks*". There is no evidence before the Expert that the Respondent is a serial cybersquatter of the type envisaged by paragraph 3(a)(iii) of the Policy. Accordingly, the Complaint fails under this head.

- 6.35 The Policy provides not only a list of factors which may be evidence of Abusive Registration, some of which have been considered above, but also (in section 4 of the Policy) a list of factors which may be evidence that the Domain Name is not an Abusive Registration. The Respondent has not expressly advanced a case that he falls within any of the categories set out in section 4. Nonetheless, his business activities strongly suggest that he has satisfied paragraph 4(a)(i)(A) of the Policy, namely that before being aware of the Complainant's cause for complaint, he has used the Domain Name in connection with a genuine offering of goods or services. That weighs in the Respondent's favour.
- 6.36 On balance, therefore, the Complainant has failed to demonstrate that the Domain Name is an Abusive Registration in the hands of the Respondent.

#### Reverse domain name hijacking

- 6.37 The Respondent asserts that this is a case of reverse domain name hijacking because the Complainant "*cannot seriously have considered that it would succeed with this case*" because it "*must know that the term 'travel sim' is a generic term in widespread use*". The Expert does not accept that matters are so clear cut.
- 6.38 Moreover, it is to be noted that the Respondent holds himself out to Nominet as a "non-trading individual" and on that basis opted to have his address omitted from the Whois service. It is difficult to see how that assertion accords with the submissions made by the Respondent in these DRS proceedings.
- 6.39 In all the circumstances, it would not be just and equitable to make a finding of reverse domain name hijacking in favour of the Respondent.

#### Conflict of interest

- 6.40 In its Reply, the Complainant raises the question of "procedural fairness" in light of the fact that the Respondent's representative is "*an expert working for Nominet*". The Complainant's concerns in this regard are unfounded. In the first place, as the Complainant acknowledges, Experts are required to be impartial and independent.
- 6.41 Secondly, since Nominet is not party to the dispute, there can be no conflict of interest. A conflict would plainly arise where an Expert was required to adjudicate on a dispute in which he or she was also advising one of the parties, but that is not the position here. Adam Taylor is acting as the Respondent's representative, not as the Expert, in this case. By the same token, the Expert in this case is unconnected with both the Respondent and the Complainant.
- 6.42 Indeed, it is far from unusual for those members of Nominet's panel of Experts who are practising lawyers to advise and represent parties involved in DRS proceedings in which they are not acting as Experts.

## **7 Decision**

- 7.1 Accordingly, the Expert finds that the Complainant has Rights in a name or mark which is identical or similar to the Domain Name but that, on the balance of probabilities, the Domain Name, in the hands of the Respondent is not an Abusive Registration, and therefore paragraph 2(a)(ii) of the Policy has not been satisfied.
- 7.2 It is therefore determined that no action be taken in respect of the Domain Name.

**David Engel**

Dated: 21 September 2009



## Overview

Trade mark  
Graphic representation  
List of goods and services  
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Link to CTM Bulletin On-line

## CTM-ONLINE - Detailed trade mark information



**Trade mark name :** TravelSIM  
**Trade mark No :** 004959334  
**Trade mark basis:** CTM  
**Number of results:** 1 of 1



### Trade mark



**Filing date:** 15/03/2006  
**Date of registration:** 10/08/2007  
**Expiry Date:** 15/03/2016  
**Nice Classification:** 38 ([↔ Nice classification](#))  
**Trade mark:** Individual  
**Type of mark:** Figurative  
**Vienna Classification:** 1.5.2, 1.5.6 ([↔ Vienna Classification](#))  
**Acquired distinctiveness:** No  
**Applicant's reference:** E1372/CTM  
**Status of trade mark:** [CTM registered](#) ([↔ Glossary](#))  
[CTM registration published \(B1\)](#)   
[↔ History of statuses](#)

**Filing language:** Estonian  
**Second language:** English

### Graphic representation



### List of goods and services



**Nice Classification:** 38  
**List of goods and services** Telecommunications.

**Description**

**Description of the mark:** Description is not available in this language  
**Indication of colour :** Grey, violet, black..

**Owner**

**Name:** OÜ TOP CONNECT  
**ID No:** 252703  
**Natural or legal person:** Legal entity  
**Address:** Peterburi tee 47  
**Post code:** 11415  
**Town:** Tallinn  
**Country:** ESTONIA  
**Correspondence address:** OÜ TOP CONNECT Peterburi tee 47 EE-11415 Tallinn ESTONIA  
**Telephone:** 00 372-6062500  
**Fax:** 00 372-6062501

**Representative**

**Name:** LASVET OÜ  
**ID No:** 28154  
**Address:** Suurtüki 4a  
**Post code:** 10133  
**Town:** Tallinn  
**Country:** ESTONIA  
**Correspondence address:** LASVET OÜ Box 3136 EE-10505 Tallinn ESTONIA  
**Telephone:** 00 372-6406600  
**Fax:** 00 372-6406604  
**E-mail:** [+ lasvet@lasvet.ee](mailto:lasvet@lasvet.ee)

**Seniority**

No entry for application number: 004959334.

**Exhibition priority**

No entry for application number: 004959334

**Priority**

No entry for application number: 004959334.

**Publication**

**Bulletin no.:** [+ 2007/004](#)  
**Date of publication:** 29/01/2007  
**Part:** A.1

**Bulletin no.:** [+ 2007/044](#)  
**Date of publication:** 20/08/2007  
**Part:** B.1

**Opposition**

No entry for application number: 004959334.

**Cancellation**

No entry for application number: 004959334

**Appeals**

No entry for application number: 004959334.

**Recordals**



No entry for application number: 004959334

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**Renewals**



No entry for application number: 004959334.

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