

DISPUTE RESOLUTION SERVICE

D00009340

Decision of Independent Expert

QVC Inc.

and

Glitzy n Glamorous

1. The Parties:

Lead Complainant: QVC Inc.
Studio Park
1200 Wilson Drive
West Chester
Pennsylvania
19380
United States

Respondent: Glitzy n Glamorous
PO Box 933
Stockton-on-Tees
Cleveland
TS19 1NW
United Kingdom

2. The Domain Name(s):

q-v-c.co.uk

3. Procedural History:

- 3.1 The complaint was received by Nominet on 26 November 2010 (the 'Complaint'). On 1 December 2010, Nominet validated the Complaint and took appropriate steps to notify the Respondent of the Complaint. A response was received by the Respondent on the same day. The Complainant replied to the response on the 9 December 2010.
- 3.2 On 30 December 2010, the Complainant paid the fee to obtain the full expert decision pursuant to paragraph 21 of Nominet's Dispute Resolution Service ('DRS') Procedure (the 'Procedure').

- 3.3 On 5 January 2011, Dr Russell Richardson was appointed as the expert (the 'Expert') who confirmed to Nominet that he knew of no reason why he could not properly accept the invitation to act as the 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.

4. Factual Background

- 4.1 The Complainant is QVC, Inc. ('QVC'), a large retailer and broadcaster. It has its headquarters in the United States, and has an affiliated company in the United Kingdom ('QVC UK').
- 4.2 The Complainant runs an at-home shopping service via television channels and various web sites (for example, www.qvcuk.com), which sell such goods as jewellery, beauty products, linens and bedding.
- 4.3 By 1993, the Complainant's broadcast channel was available in over 80 % of all U.S. cable homes and 3 million satellite dishes. The Complainant launched its presence in the United Kingdom in that year.
- 4.4 The Respondent is a UK-based company, established in 2008, and sells such goods as jewellery, wedding shoes and handbags.
- 4.5 The Domain Name was registered by the Respondent on June 25 2010.

5. Parties' Contentions

Complainant:

- 5.1 In summary, the Complainant argues that the Domain Name should be transferred to it because:
- It owns rights in the QVC trade mark and other trademarks that incorporate the QVC mark (collectively, the "Marks") in numerous countries and jurisdictions, including the United Kingdom (e.g. Registration Number 1584688, 2 February 1996) and the European Union (Registration Number 000176917, 25 June 1999).
 - It and its affiliated companies have used the Marks continuously and extensively since registration, and as a result of long and continuous use of the Marks and substantial investment of time, money and effort in advertising and promotion, the Marks (and the name associated with the Marks (the 'Name')) have developed substantial public recognition and goodwill all over the world, including in the United Kingdom (various newspapers articles provided in support).
 - QVC's shopping network went online in 1996, when the company's interactive division, iQVC, launched on www.QVC.com. QVC has also registered the domain name www.IQVC.com and owns various other

domain names including: www.QVC.co.uk, www.QVCUK.com; www.QVC.it, www.QVC.de and www.QVC.jp.

- (The Complainant also refers to a prior Nominet decision which recognized the Complainant's rights in the Marks; namely, *QVC, Inc. and QVC v. M. Davis*, DRS 02039 (December 23, 2004).)
- The Domain Name is identical to, or at least similar to, the Marks, incorporating the Complainant's Marks in its entirety; as the addition of the hyphens between the letters Q, V and C do not alter the overall impression of the Domain Name. Moreover, the suffix .CO.UK does not add anything to the Domain Name.
- Therefore, the Complainant asserts that it has Rights in respect of a Name and Mark that are in effect identical (or at least similar) to the Domain Name.
- The Domain Name, in the hands of the Respondent, is an Abusive Registration as defined in the Nominet DRS Policy (the 'Policy'): the Respondent registered the Domain Name for the sole purpose of taking unfair advantage of the Complainant's Marks to divert Internet users to its own web site and thereby disrupt the Complainant's business (under paragraph 3(a)(i)(C) of the Policy).
- The Domain Name was registered by the Respondent on June 25 2010; long after the Complainant had established its rights in the Marks. The Complainant and Respondent have no connection with each other and the Complainant did not authorise the Respondent to register the Domain Name.
- The website attached to the Domain Name (the 'Website') resolved to the Respondent's website at www.glitzy-n-glamorous.co.uk on the date of the Complaint (evidence submitted), where the Respondent sells products that compete with some of Complainant's best selling products, including jewellery, footwear, bags and apparel.
- Given the Complainant's substantial and continuous use of the Marks in the United Kingdom and Europe, and in the absence of any conceivable reason why the Respondent chose the Domain Name, there can only be one conclusion; namely, that the Respondent registered the Domain Name for no other purpose but to unfairly disrupt the Complainant's business by diverting Internet users to its web site.
- The Respondent's registration of the Domain Name is also an "Abusive Registration" under paragraph 3(a)(ii) of the Policy because the Respondent's use of the Domain Name confuses or is likely to confuse consumers into believing that the Domain Name is registered to, operated or authorised by, or otherwise connected with the Complainant.
- Finally, none of the exonerating factors under paragraph 4 of the Policy apply.

Respondent's response:

5.2 The Respondent responded that, in summary:

- The Domain Name was initially registered for personal use, and has never been used. Further, that the Complainant could have the Domain Name as it is not needed.

Complainant's Reply:

5.3 The Complainant replied that, in summary:

- The Respondent states that the Domain Name was initially registered for personal use. It is also stated that the Domain Name has never been used. Given that the Respondent is an artificial legal entity; it is unclear what 'personal use' means. Also, the Domain Name resolves to the Respondent's website; therefore, the Respondent has used the Domain Name to redirect it to its web site on which it sells goods that compete with the Complainant's goods.

Non-standard submission

5.4 In accordance with paragraph 13(b) of the Procedure, the Expert was forwarded an e-mail Nominet had received from the Respondent, dated 10 December 2010, which asked for further comments by it to be considered as part of the dispute. The Expert decided to consider that non-standard submission as part of the process, and the Complainant was given the opportunity to reply to it.

- The Respondent explained that they are a very small UK partnership, and they have not profited from the Domain Name, nor used it in any promotional/marketing material. Indeed, they have received zero traffic through the Website (they provided evidence of their traffic flow) as it has not been submitted to search engines.

Further, they said that their main customers are looking for bridal/prom products, which do not seem to be the Complainant's market; and that the amount of jewellery they display is insignificant in comparison to the Complainant.

They registered the Domain Name privately to use in conjunction with a wedding blog, and the letters in the Domain Name (QVC) have a different meaning to them than they do for the Complainant. In hindsight, it was bad misjudgement for them to have registered the Domain Name, and they apologised for any trademark infringement.

Finally, the Respondent stated that they are not going to renew the Domain Name, and do not need nor want the Domain Name any longer. The Respondent asked for information as to how to transfer the Domain Name to the Complainant.

5.5 The Complainant did not reply to the Respondent's 13(b) Procedure submission.

6. Discussions and Findings

General

6.1 To succeed in the Complaint, the Complainant has to prove pursuant to paragraph 2 of the DRS policy (the 'Policy') that, on the balance of probabilities (that is, the Complainant's case is more likely than not to be the true version¹):

“(i) The Complainant has Rights in respect of a name or mark identical or similar to the Domain Name; and,

(ii) The Domain Name, in the hands of the Respondent, is an Abusive Registration.”

6.2 Addressing each of these limbs in turn:

i) Complainant's Rights

6.3 Paragraph 1 of the Policy defines 'Rights' as:

“[...] rights enforceable by the Complainant, whether under English law or otherwise, and may include rights in descriptive terms which have acquired a secondary meaning;”

6.4 The Complainant must have the Rights at the time of the complaint.

6.5 The Expert notes that, as referred to at paragraph 5.1 above, the Complainant is the proprietor of a number of Marks in respect of the name 'QVC', and through various advertising campaigns and sales placements has developed considerable goodwill and reputation in the Marks (and also in the Name).

6.6 Further, and in agreement with the Complainant, the hyphens in the Domain Name are “essentially irrelevant” in determining the similarity between the Domain Name and the Marks.² And thus, they should be discluded from the consideration of whether the Domain Name is identical to the Complainant's Marks/Name.

6.7 Given those factors, as well as the fact that the requirement to demonstrate 'Rights' is not a particularly high threshold (Nominet appeal panel decision, *Seiko-shop* DRS 00248), the Expert considers that at the time of the Complaint, the Complainant had Rights in the Marks/Name, which is identical to the Domain Name. In concluding the above, the Expert has also disregarded the domain suffix 'co.uk'.

¹ <http://www.nominet.org.uk/disputes/drs/legalissues/>.

² *Parasols Direct v. Cushions Direct Limited*, DRS 00008850 (September 30, 2010).

ii) Abusive Registration

6.8 The Expert has considered whether the Domain Name, in the hands of the Respondent, is an Abusive Registration as understood by Paragraph 2 a. ii. of the Policy.

6.9 Paragraph 1 of the Policy defines “Abusive Registration” as a domain name which either:

“i. was registered or otherwise acquired in a manner which, at the time when the registration or acquisition took place, took unfair advantage of or was unfairly detrimental to the Complainant’s Rights; or

ii. has been used in a manner, which has taken unfair advantage of or has been unfairly detrimental to the Complainant’s Rights;”

6.10 In relation to (i) above – the Expert considers there was an Abusive Registration at the time the Domain Name was registered.

6.11 The Policy at Paragraph 3, sets out a non-exhaustive list of factors which may be evidence that the Domain Name is an Abusive Registration. The Policy sets out at Paragraph 3 a. C. that a factor which may be evidence that the Domain Name is an Abusive Registration is circumstances indicating that the Respondent has registered the Domain Name primarily: *“for the purpose of unfairly disrupting the business of the Complainant.”*

6.12 Given the goodwill and reputation in the Marks/Name, as described for example at paragraph 6.5 above, the Expert agrees with the Complainant that the Respondent would have been aware of the Complainant and its Marks/Name at the time of registration of the Domain Name in 2010.

6.13 While the Expert notes the Respondent’s stated intentions at the time of the registration of the Domain Name (para. 5.4 above), the Expert is satisfied on the balance of probabilities that the Respondent deliberately chose the Domain Name to utilise the goodwill and reputation of the Marks/Name in order to sell goods which those accessing the Website would consider initially as being sold by the Complainant, or at least authorized by the Complainant.

6.14 Thus, the Expert considers that, in this way, such action took unfair advantage of, and was unfairly detrimental to, the Complainant’s Rights.

6.15 In relation to (ii) above – the Expert considers there was an Abusive Registration through the use by the Respondent of the Domain Name.

6.16 The Policy sets out at Paragraph 3 (a) (ii) that:

“[there may be evidence of an Abusive Registration if there are] Circumstances indicating that the Respondent is using [...] the Domain Name in a way which has confused or is likely to confuse

people or businesses into believing that the Domain Name is registered to, operated or authorised by, or otherwise connected with the Complainant.”

- 6.17 As evidenced by the Website print-outs provided to the Expert, the Respondent has used the Website to link to its website, where it offers for sale certain goods that are in competition with the Complainant (e.g. jewellery). (That the Respondent provided evidence that they received zero traffic through the Website is not relevant to this consideration; what is relevant is that there was an opportunity for those accessing the Website to access the Respondent’s website through the link provided.)
- 6.18 On the balance of probabilities, such representations by the Respondent would have confused and are likely to confuse those accessing the Website into believing that the Domain Name (and the goods offered for sale on the Website) is that of the Complainant or are at least authorised by the Complainant: which is not the case.
- 6.19 In this way, the Respondent has taken unfair advantage of the Complainant’s Rights by seeking to rely on the Complainant’s goodwill and reputation in the Marks/Name in order to generate the web traffic to the Website, and looking to generate traffic to its website on the back of that.
- 6.20 Such use of the Domain Name is also unfairly detrimental to the Complainant as the use of the Website in the way described above has diverted Internet traffic away from the Complainant’s website, and thus the Complainant has lost possible sales income.
- 6.21 The Expert has considered whether there is evidence before him to suggest that any of the factors listed at Paragraph 4 of the Policy demonstrate that the Domain Name is not Abusive Registrations but does not consider any are relevant.
- 6.22 Finally, the Expert notes the Respondent’s comments in its non-standard submission that it was bad misjudgment for them to have registered the Domain Name, asking for information to transfer the Domain Name to the Complainant. The Expert would have thought that this dispute could have been resolved at the mediation stage of Nominet proceedings given the above; thus saving time and resource in this matter.

7. Decision

- 7.1 Accordingly, the Expert finds, on the balance of probabilities, that the Complainant has Rights in a Name and Marks that are identical to the Domain Name; and that the Domain Name, in the hands of the Respondent, is an Abusive Registration. Therefore, the Expert directs that the Domain Name be transferred to the Complainant.

Signed Dr Russell Richardson

Dated 1 February 2011