

DISPUTE RESOLUTION SERVICE

D00010308

Decision of Independent Expert

Kiddicare.Com Limited

and

Mrs. Carol Allsopp

1. The Parties:

Lead Complainant: Kiddicare.Com Limited
Club Way
Cygnet Park
Peterborough
Cambridgeshire
PE7 8JA
United Kingdom

Respondent: Mrs. Carol Allsopp
The Spinney, 106 Green Meadows Westhoughton
Bolton
Lancashire
BL5 3AE
United Kingdom

2. The Domain Name(s):

kiddicare1.co.uk

3. Procedural History:

20 September 2011 12:26 Dispute received
20 September 2011 13:36 Complaint validated
23 September 2011 11:49 Notification of complaint sent to parties

12 October 2011 02:30 Response reminder sent
13 October 2011 09:44 Response received
13 October 2011 09:45 Notification of response sent to parties
18 October 2011 02:30 Reply reminder sent
18 October 2011 09:27 Reply received
18 October 2011 09:28 Notification of reply sent to parties
18 October 2011 09:28 Mediator appointed
26 October 2011 15:47 Mediation started
10 November 2011 09:58 Mediation failed
10 November 2011 11:54 Close of mediation documents sent
22 November 2011 01:30 Complainant full fee reminder sent
23 November 2011 12:26 Expert decision payment received
28 November 2011 13b Explanatory paragraph received from respondent
28 November 2011 Expert appointed (Margaret Briffa)
30 November 2011 Email received from Complainant regarding 13b Explanatory Paragraph
30 November 2011 Email from Nominet to Complainant explaining right to reply to a 13b non standard submission by virtue of 13a

4. Outstanding Procedural Issues

The Respondent has also sought to make a non-standard submission under paragraph 13b of the Procedure. In the opening paragraph, the Respondent gives the following reasons in order to persuade the Expert to allow such submission:

“FOR THE ATTENTION OF: MARGARET BRIFFA

In the interest of fairness I wish to make a ‘Non Standard Submission’ to Margaret Briffa, the independent expert appointed by the Dispute Resolution Service Team re: kiddicare1.co.uk, to give her the correct information & true facts regarding my domain name.

I feel that the documents submitted by Alan Boss Associates contains incorrect details & information which intends to show myself & my business in a bad light in order to attain a forced transfer of my domain name.”

As regards this request it will be noted that relevant part of Paragraph 13b of the Procedure states “Any non-standard submission must contain as a separate, first paragraph, a brief explanation of why there is an exceptional need for the non-standard submission”. It will be noted that the Complainant did not append any new documents to its Reply. Accordingly, the Respondent had ample opportunity in her Response to respond to all documentary evidence submitted. Further, the Respondent does not allege that any facts have come to light subsequent to the filing of the Response which would necessitate a non-standard submission. Accordingly, I do not see any exceptional grounds for admitting a non-standard

submission and I will come to my decision on the basis of the Complaint, the Response and the Reply. The Respondent can rest assured, however, that I would in any event attach little weight to anything said by the Complainant which was intended solely to – as she puts it – “show myself & my business in a bad light”.

5. Factual Background

The Complainant’s Kiddicare.com business has been in operation since 1976. It is engaged in the supply of nursery goods and other complimentary services.

The Complainant owns three UK registered trade marks in relation to the word mark “KIDDICARE”:

- Trade Mark 2393856 KIDDICARE registered in class 35 with a registration date of 8th August 2005;
- Trade Mark 2568777 KIDDICARE registered in classes 03, 05, 07, 09, 10, 11, 12, 16, 18, 20, 21, 24, 25, and 28 With a registration date of 20th May 2011; and
- Trade Mark 2277281 KIDDY-CARE registered in classes 24, 25. Registered as of 26th April 2002.

Together, these will be referred to as “the Trade Marks”. It is unfortunate that the Complainant has not included copies of the trade marks or print outs from the Trade Marks Registry website in order that the specification for the Trade Marks may be referred to, although the Respondent has attached to her Response images in relation to Registered Trade Mark 2393856 which shows it was registered on 21 December 2007 (although the relevant priority date is the filing date of 8 August 2005) and that the specification included retail services in relation to goods for babies and nurseries.

The Complainant also owns a plurality of domain names incorporating the word “Kiddicare”, including:

kiddicare-direct.co.uk
kiddicare-direct.com
kiddicare-nursery.co.uk
kiddicare.at
kiddicare.be
kiddicare.biz
kiddicare.ch
kiddicare.co.il
kiddicare.co.uk
kiddicare.com
kiddicare.cz
kiddicare.dk
kiddicare.es

kiddicare.eu
kiddicare.fr
kiddicare.gr
kiddicare.hu
kiddicare.ie
kiddicare.info
kiddicare.it
kiddicare.jobs
kiddicare.lu
kiddicare.me
kiddicare.mobi
kiddicare.net
kiddicare.org
kiddicare.pt
kiddicare.se
kiddicare.tv
kiddicare.uk.com
kiddicare.us
kiddicarekids.co.uk
kiddicarekids.com
kiddicarekids.eu

The Respondent commenced use of the terms "Kiddicare1" and "Kiddicare2" in relation to her eBay business in 2003.

It is common ground that the Complainant's representatives first wrote to a limited company with which the Respondent was concerned (Beautiful Beginnings Ltd) in May 2007 requiring that the Respondent cease use of the term "Kiddicare". Although the letter did not mention the registration numbers of the Trade Marks registered at the time the letter was sent, the letter did refer to the Complainant as owners of the KIDDICARE trade mark and to goodwill the Complainant may have owned for the purposes of a passing off action. By a letter dated 30 May 2007, the Respondent, whilst making no admission on the legal case set out in the letter of the Complainant's representative, agreed as a goodwill gesture to cease use of the mark "KIDDICARE" in relation to the eBay business.

There was no further correspondence between the parties until February 2011, where the Complainant noticed that the term Kiddicare1 was visible on eBay in relation to the Respondent's business. The Complainant wrote to the Respondent in respect of such visibility on 17 February 2011 and appears to have enclosed with that letter details of the Trade Marks then in force. The Respondent replied on 21 February 2011 stating that the appearance of the term "Kiddicare1" in relation to the Respondent's business was a result of an old webpage being cached on Google.

On 18 February 2011, however, the Domain Name was registered to the Respondent via Fasthosts Internet Ltd. Correspondence was entered into regarding the transfer of the domain, but the Respondent refused such transfer. By an email dated 30

August 2011, the Respondent offered to transfer the domain name in exchange for financial consideration.

6. Parties' Contentions

Complaint

The Complainant asserts in the Complaint that it owns Rights in the Domain Name by reference to its trading history, the goodwill generated through what it claims are its state of the art systems, through it being consistently the first result on Google searches for certain nursery goods. its ownership of the Trade Marks and its ownership of the other domain names as listed above.

The Complainant asserts that the Domain Name is, in the hands of the Respondent, an Abusive Registration as the Respondent was aware of the Complainant's Rights on 18 February 2011 (the date upon which the Domain Name was registered to the Respondent) and that the registration of the Domain Name by the Respondent amounts to trade mark infringement and passing off; and that the Respondent has sought to sell the Domain Name to the Complainant.

Response

The Respondent has, in her Response, stated that the initial use of Kiddicare1 and Kiddicare2 on eBay was a result of the name "Beautiful Beginnings" not being available; that eBay has not told her that the use of Kiddicare1 and Kiddicare2 was against their rules (even when asked by her); that Fasthosts has offered her the opportunity to purchase other domain names including the term "Kiddicare1"; and that, when she inquired as to the legality of her registration directly with Nominet, they told her that there was no breach of any rules when she registered the Domain Name. She has also claimed that the Domain Name is not being used in relation to any business.

The Respondent has said that the Domain Name has been registered by the Respondent (along with another domain name) and renewed through "Fasthosts", although an earlier date than 18 February 2011 has not been given in relation to the first registration of the Domain Name. The Respondent has also stated that she has worked for 25 years in the nursery industry and made representations in relation applications to strike out a limited company which is not party to these proceedings.

Reply

In its Reply, the Complainant has stated that the period of trading by the Respondent is not relevant except insofar as she would have had knowledge of the Complainant and its business. The Complainant has also stated that issues relating the solvency or otherwise of the limited company are not relevant to these proceedings.

The Complainant agreed in the Reply that the re-appearance of the term kiddicare1 on Google was a result of a cached page and did not amount to a breach of any agreement by the Respondent to cease use of the term Kiddicare1 on eBay.

The Complainant states in the Reply that the offer by Fasthosts does not generate a right in law for the Respondent to use such domain names; that eBay, in stating that the Respondent was not in breach of their rules in using Kiddicare1 and Kiddicare2 was not offering legal advice; that the Respondent did not seek legal advice when urged to do so by the Respondent's representatives; that the Respondent registered the Domain Name after she became aware of the Trade Marks and the Rights asserted by the Respondent through correspondence (if indeed she was not already aware of them) and that the non-use of the Domain Name by the Respondent is evidence of bad faith. In light of such factors, the Complainant argues that a finding should be made that the Domain Name should be transferred.

The Complainant has also asked that an award of costs is made in its favour.

7. Discussions and Findings

Paragraphs 2a and 2b of the Policy set out the matters which a Complainant is required to prove in order for an Expert to reach a decision that a Domain Name should be transferred under the Policy. These Paragraphs states:

a. A Respondent must submit to proceedings under the DRS if a Complainant asserts to us, according to the Procedure, 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.*

b. The Complainant is required to prove to the Expert that both elements are present on the balance of probabilities.

Accordingly, the Complainant needs to show that it has Rights in respect of a name or mark similar or identical to the name "Kiddicare1" and that the Domain Name in the hands of the Respondent is an Abusive Registration.

Rights

Given that the Respondent claims to have "renewed" the Domain Name, I am concerned that the date given for the registration of the Domain Name may not be accurate. The only date apparent from the materials before me is 18 February 2011, which would be the day after correspondence between the Complainant and the Respondent resumed following the Complainant's discovery of the cached page. However, given that the Respondent has not challenged this date as the date for registration of the Domain Name in her Response, I will proceed on the basis that the Domain Name was registered on 18 February 2011.

In order to succeed in these proceedings, the Complainant needs to show that it owned, on the date of registration of the Domain Name, Rights in the in a name or mark identical or similar to the Domain Name. The Complainant's evidence in this regard amounts to an assertion that it has traded for some 35 years and references to the Trade Marks (all of which it claims are registered) two of which – UK Registered Trade Marks 2393856 and 2277281 – appear to have priority dates preceding the date for registration of the Domain Name.

The Respondent has not chosen to dispute such evidence and has included a print out relating to Registered Trade Mark 2393856 with its submissions. Whilst it is unfortunate that the Complainant has not sought to provide documentary evidence in support of the subsistence of its goodwill in the mark "Kiddicare", in light of the submissions and the registered rights of the Complainant, I find that the Complainant is the owner of Rights for the purposes of the Policy.

Abusive Registration

The next question is whether the Domain Name is, in the hands of the Respondent, an Abusive Registration. In this regard, the Complainant has claimed that the Domain Name amounts to trade mark infringement and passing off, and that the Respondent has offered to sell the Domain Name to it.

In relation to the offer to sell the Domain Name, I have noted that this offer came on 30 August 2011, following correspondence relating to the current dispute. Paragraph 3.a. of the Policy sets out circumstances indicating that a Domain Name is an Abusive Registration. Paragraph 3.a.i.A relates to such circumstances where the Respondent offers to sell the Domain Name to the Respondent. The paragraph sets out those circumstances as follows:

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

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

Given that the offer to sell the Domain Name to the Complainant only came following correspondence between the parties in which the Respondent refused requests for the transfer of the Domain name, I am not convinced that the primary motivation of the Respondent when acquiring the Domain Name was to transfer it to the Complainant in exchange for financial consideration. Had that been the case, I would have expected (given the amount of correspondence) such an offer to have been made earlier in the exchanges between the Respondent and the Complainant. Instead, I take the view that the offer was a bona fide attempt to resolve this dispute. Accordingly, I do not find that the Domain Name is an Abusive Registration on this ground.

The Complainant, in alleging trade mark infringement and passing off, appears to be that the Domain Name is an Abusive Registration in the hands of the Respondent on the basis of Paragraph 3.a.ii of the Policy: Paragraph 3.a.ii states 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”

Given that the Respondent was aware of the Complainant prior to the registration date given in respect of the Domain Name, and the Respondent’s statement in her letter of 30 May 2007 that it would change its name on eBay to avoid any confusion, it is clear that the Respondent was of the view that her trading by reference to the name Kiddicare1 was likely to create confusion if she provided goods relating to nurseries by reference to such mark.

While the Respondent was not using the website, it is clear from her activities on eBay where she was in the business of providing goods relating to nurseries, that whilst she would be registrant of the Domain Name there would be a threat that it would be used in relation to such services. Accordingly, the circumstances referred to in Paragraph 3.a.ii as indications as to an Abusive Registration clearly arise in the present case.

Having regard to the circumstances set out in Paragraph 4 of the Policy which may stand as indications that the Domain Name is not an abusive registration, it will be noted that, at the time of the registration of the Domain Name, the Respondent was not using the domain or a similar domain name in relation to a bona fide offering of goods and services. Further, whilst the Respondent had previously used the name Kiddicare1 and Kiddicare2 in relation to her eBay account, there is no evidence that she was commonly known by reference to such marks. Indeed, the evidence shows that she traded by reference to the mark “Beautiful Beginnings” and that she had made efforts to cease any use of the marks Kiddicare1 and Kiddicare2.

In summary, I have found that the Complainant does own Rights, having established use of the mark “KIDDICARE” And ownership of registered trade marks incorporating the word “KIDDICARE”. Whilst I have not found that the Domain Name is an Abusive Registration in the hands of the Respondent on the grounds set out in Paragraph 3.a.i.A of the Policy (i.e. that the Domain Name was acquired primarily for the purposes of selling, renting or otherwise transferring Domain Name to the Complainant or its competitor for valuable consideration), I have found that the Domain Name is an Abusive Registration in the hands of the Respondent on the grounds of Paragraph 3.a.ii of the Policy insofar as the Respondent is 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 light of the above, I find that the registration of the Domain Name by the Respondent is an Abusive Registration and that the Domain Name should be transferred to the Complainant.

As regards the claim for costs, the Complainant and its representatives will note that there is no provision for costs recovery under the Nominet DRS and the Expert has no jurisdiction to make any award in this regard.

8. Decision

In light of the above findings, namely that the Complainant has Rights in a mark which is similar to the Disputed Domain Name, and that the Disputed Domain Name, in the hands of the Respondent, is an Abusive Registration, the Expert directs that the Disputed Domain Name be transferred to the Complainant.

Signed: Margaret Briffa

Date: 20 December 2011

