

DISPUTE RESOLUTION SERVICE

D00010531

Decision of Independent Expert

Bickland Limited - in administration

and

Fabric Interface Ltd

1. The Parties:

Complainant: Bickland Limited - in administration
c/o Kingston Smith & Partners LLP
105 St Peters Street
St Albans
Hertfordshire
AL1 3EJ
United Kingdom

Respondent: Fabric Interface Ltd
Moshi Moshi Sushi
Liverpool Street Station
24 Upper Level, Broadgate
London
Greater London
EC2M 7QH
United Kingdom

2. The Domain Name:

moshimoshi.co.uk

3. Procedural History:

A Complaint in respect of <moshimoshi.co.uk> (the "Domain Name") under Nominet UK's Dispute Resolution Service Policy ("the Policy") was received from the Complainant on November 16, 2011 and forwarded to the Respondent by Nominet next day. A Response was received from the Respondent on November 30, 2011 and the Complainant lodged a Reply on December 6, 2011. An unsuccessful mediation was concluded on January 12, 2012.

On January 18, 2012 the undersigned Alan L. Limbury was appointed as Independent Expert to determine the dispute in accordance with Nominet's Procedure for the conduct of proceedings under the Dispute Resolution Service (the "Procedure"). I confirmed to Nominet that I am independent of the parties and know of no facts or circumstances that might call into question my independence or impartiality in the eyes of the parties.

On January 24, 2012, pursuant to paragraph 13b of the DRS Procedure, a further submission was received from Miss Caroline Bennett on behalf of the Respondent. Before deciding whether or not to take this into account, I made the following requests for further information from the parties, pursuant to paragraph 13a of the DRS Procedure:

"I would like the Respondent or Miss Bennett, within 3 days, (a) to clarify when the Domain Name was registered in the name of the Respondent company and (b) to explain the relationship between the Respondent and Miss Bennett.

I would like to give the Complainant an opportunity, within the following 5 calendar days, (a) to comment on the information provided in response to the previous paragraph and (b) to respond to the recent additional submission on the assumption that I decide to take it into account."

Nominet forwarded my requests to the parties on January 30, 2012, giving the Respondent or Miss Bennett until February 2, 2012 to comply and the Complainant until February 7, 2012 to comply.

Miss Bennett responded to my request on February 1, 2012. The Complainant replied on February 2, 2012.

4. Factual Background

In 1994 a company called Moshi Moshi Sushi Limited started trading as a Japanese

Sushi restaurant/takeaway at Liverpool Street Station in London. Miss Caroline Bennett was the founder and Managing Director of Moshi Moshi Sushi Limited.

On January 19, 1996 Miss Bennett became the registered proprietor of United Kingdom registered trademark No. 2009832, "MOSHI MOSHI with fish device" (a circle enclosing three fish). She remains the registered proprietor of that mark.

The Domain Name was registered on June 22, 1999 in the name of Intergration on behalf of Moshi Moshi Sushi Limited. In November 2004 that company went into administration and its assets (including intellectual property rights), were purchased from the Administrator by the Complainant, Bickland Limited, a company incorporated in October, 2004, which continued to trade as a Japanese Sushi restaurant/takeaway at the Liverpool Street premises under the name Moshi Moshi.

Miss Bennett was the founder and Managing Director of the Complainant and remains a major shareholder of its holding company. She holds the lease of the premises at Liverpool Street Station from Network Rail.

On January 21, 2011, the Complainant became the proprietor of United Kingdom registered trademark No. 2553835, "MOSHI MOSHI block logo" (series of two marks). On September 2, 2011, Miss Bennett arranged to have that mark assigned by the Complainant to her. One month later, on October 5, 2011, as a Qualifying Floating Charge Holder, she appointed an Administrator of the Complainant, who insisted that the mark be reassigned to the Complainant. This was done on October 24, 2011. Next day, the Administrator sold the chattel assets of the Complainant (which excluded intellectual property rights) to Miss Bennett for £19,250 (inclusive of VAT).

The Domain Name was transferred from Intergration to the Respondent on November 11, 2011. The Respondent was employed to host the Domain Name, the role previously played by Intergration. The Domain Name resolves to a website promoting the Liverpool Street Station Japanese Sushi restaurant and displaying the "MOSHI MOSHI block logo" mark. It describes Miss Bennett as Managing Director.

5. Parties' Contentions

Through the Administrator, the Complainant says that since the sale of the Complainant's chattels to Miss Bennett, she has continued to trade at the Liverpool Street Station premises under the Moshi Moshi name and to use the Domain Name both for email and for the website, despite a letter from the Administrator dated October 27, 2011, notifying her of the consequences of section 216 of the Insolvency Act 1986 "*in the event that the exit route from the administration is liquidation*".

The Complainant contends that "the website of Moshi Moshi" (*scilicet* the Domain Name) is an asset of the Complainant and as such should be available for the Administrator to sell for the benefit of creditors.

The Respondent says the trade mark 2009832 “MOSHI MOSHI with fish device” is registered in the name of Caroline Bennett and as such, Miss Bennett believes she is entitled to continue trading using the Domain Name. The Complainant is challenging the use of the logo mark, No. 2553835. Offers are being made for the use of that mark, and until the highest bid has been accepted, Miss Bennett believes she is entitled to continue using the Domain Name.

The additional submission from Miss Bennett and the Complainant’s reply describe the deteriorating relationship between the Complainant’s shareholders shortly before the Administrator was appointed and reveal different views as to whether Miss Bennett is entitled to use the trading name Moshi Moshi.

Miss Bennett says that as a secured creditor she has a fixed charge over the intellectual property of the company, and therefore her consent must be sought in order to transfer or sell any IP. The Complainant says Miss Bennett seems to be under the misapprehension that the Domain Name belongs to her by virtue of her fixed charge debenture. In effect, this proves it to be a company asset.

6. Discussions and Findings

Although the Domain Name remained registered in the name Intergration until it was transferred to the Respondent on November 11, 2011, it is common ground between the parties that the Domain Name is under the effective control of, and is being used by, Miss Bennett. Accordingly it is appropriate to treat Miss Bennett as the Respondent for the purposes of this proceeding.

Under paragraph 2 of the Policy, a complainant is required to show, on the balance of probabilities, that:

- (1) it 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.

Rights

The Complainant clearly has rights in the registered “MOSHI MOSHI block logo” mark, No. 2553835. I find that the Domain Name is similar to that mark, since the words are its distinctive element.

Abusive Registration

Abusive Registration is defined in the Policy as:

“...a domain name which either;

- (i) was registered or otherwise acquired in the 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."

Paragraph 3(a) of the Policy provides a non-exhaustive list of factors that may be evidence that a domain name is an Abusive Registration. These include:

"(i) 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;

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

C. for the purpose of unfairly disrupting the business of the Complainant;

(ii) 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.

Under the Policy, paragraph 4(a)(i)(B), one factor which may be evidence that the Domain Name is not an Abusive Registration is:

"Before being aware of the Complainant's cause for complaint [...], the Respondent has been commonly known by the name or legitimately connected with a mark which is identical or similar to the Domain Name".

Miss Bennett says that when the Brighton restaurant lease was sold by the Complainant, it was on terms entitling the Complainant to remuneration for the use of that name. This indicates to me that the name Moshi Moshi belongs to the Complainant. Whether or not this is so, there is no evidence before me from which the conclusion may be drawn that either the Respondent or Miss Bennett has been commonly known by the name Moshi Moshi.

Miss Bennett has been the registered proprietor of the trade mark 2009832 "MOSHI MOSHI with fish device" since 1995. That mark is similar to the Domain Name because the words are a distinctive feature. However, the website to which the Domain Name resolves does not display that mark: it displays the Complainant's

“MOSHI MOSHI block logo” trademark, No. 2553835. This gives the false impression that the restaurant operated by Miss Bennett at the Liverpool Street premises continues to be operated by the Complainant.

I find that the use of the Domain Name to connect to a website displaying the Respondent’s “MOSHI MOSHI block logo” trademark 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.

Hence, despite Miss Bennett’s connection to the “MOSHI MOSHI with fish device” trademark, I find that, in the hands of the Respondent, the Domain Name is an Abusive Registration.

7. Decision

I find that the Complainant has proved, on the balance of probabilities, that it has rights in a trademark which is similar to the Domain Name and that the Domain Name is an Abusive Registration in the hands of the Respondent. I therefore direct that the Domain Name be transferred to the Complainant.

Signed Alan Limbury

Dated February 11, 2012