

DISPUTE RESOLUTION SERVICE

D00010987

Decision of Independent Expert

Urban Outfitters, Inc.

and

Lim Chu Ltd

1. The Parties

Complainant: Urban Outfitters, Inc
5000 South Broad St
Philadelphia
PA 19112 -1495
United States

Respondent: Lim Chu Ltd
2 Ang Mo Kio St 75
Bukit
Merah
569141
Singapore

2. The Domain Names

uranoutfitters.co.uk
urbannoutfitters.co.uk
urbanotfitters.co.uk
urbanoutfitters.co.uk
urbanoutfittes.co.uk
urbanoutfittrs.co.uk
urbanoutfittters.co.uk
urbanutfitters.co.uk
urbinoutfitters.co.uk
urbnoutfitters.co.uk

urbanoutfitters.co.uk
www.urbanoutfitters.co.uk ("the Disputed Domain Names")

3. Procedural History

The Complaint was filed with Nominet on 29 February 2012. Nominet validated the Complaint the same day and notified the Respondent by post and by email, stating that the Response had to be received on or before 22 March 2012. The Respondent did not submit a Response. Accordingly, Nominet notified the Respondent's default on 22 March 2012. The Complainant paid the requisite fee to obtain an Expert Decision pursuant to paragraph 7 of the Nominet Dispute Resolution Service Policy ("the Policy").

On 29 March 2012 the undersigned, David Taylor ("the Expert"), confirmed to Nominet that he knew of no reason why he could not properly accept the invitation to act as an Expert in this case and further confirmed 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

The Complainant is a publicly traded American company founded in 1970. It owns and operates five retail brands of the Urban Outfitters group and has active websites.

On 17 August 1993, the Complainant filed a UK trade mark in the term URBAN OUTFITTERS (number 1545078); on 23 April 1999, the Complainant filed a Community Trade Mark in the term URBAN OUTFITTERS (number 001150465); and on 8 August 2011, the Complainant filed another Community Trade Mark in the term URBAN OUTFITTERS (number 010182061). The three trade marks have since then been registered (on 27 March 1998, 6 March 2003 and 10 January 2012 respectively). UK trade mark number 1545078 was thus registered ten years before the Disputed Domain Names were registered by the Respondent in 2008.

The Complainant has also registered the following domain names:

urbanoutfitters.com (registered on 1 May 1996)
urbanoutfitters.co.uk (registered on 22 December 2003)
urbanoutfitters.fr (registered 3 April 2008)

These domain names are all pointing to active content.

The Respondent is an individual residing in Singapore. He registered the Disputed Domain Names on 17 September 2008.

The Disputed Domain Names are currently not pointing to any active content.

5. Parties' Contentions

Complaint

Complainant's Rights

The Complainant explains that it has been known as Urban Outfitters ever since a name change in 1975.

The Complainant asserts that it owns a UK trade mark in the term URBAN OUTFITTERS, filed in 1993 as well as two Community trade marks URBAN OUTFITTERS filed respectively in 1999 and 2011. The three trade marks were registered on 27 March 1998, 6 March 2003 and 10 January 2012 respectively.

The Complainant further asserts that it is the registered owner of the domain names <urbanoutfitters.com>, <urbanoutfitters.co.uk> and <urbanoutfitters.fr>.

Abusive Registration

The Complainant argues that the registration of the Disputed Domain Names is abusive for three reasons, as set down in the Policy as follows:

- *The Respondent has registered or otherwise acquired the Domain Name primarily for the purpose of unfairly disrupting the business of the Complainant (paragraph 3(a)(i)(C)).*

The Disputed Domain Names, while omitting and incorporating letters, still remain both visually and phonetically similar to the Complainant's trade marks and do nothing to distinguish or change the meaning of the trademarked term URBAN OUTFITTERS.

The Complainant therefore argues that this practice in essence had a disruptive effect on the Complainant's business.

- *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 (paragraph 3(a)(ii))*

The Respondent has engaged in the deliberate misspelling of the Complainant's well-known trade mark with the intention of attracting web users away from the Complainant's website.

On making typographical errors, internet users are redirected to pages stating: "This web page is not available" which may mislead some consumers into believing that the Complainant's official websites are no longer in operation.

Although the Complainant asserted that it was unable to provide affirmative evidence that such confusion has indeed occurred, it stated that it is quite clear that the Respondent's intention, when registering domain names including the typical misspellings of the Complainant's trade mark, was to confuse.

- *The Respondent is engaged in a pattern of registrations where the Respondent is the registrant of domain names which correspond to well-known names or trademarks to which the Respondent has no apparent rights and the Disputed Domain Name is part of that pattern (paragraph 3(a)(iii))*

The Respondent is the registered owner of about 170 domain names which incorporate the names and trade marks of companies operating in the same field of activity as the Complainant and only uses them to resolve to parking pages.

The Complainant therefore asserts that the Respondent is the registrant of domain names which correspond to well known names or trade marks in which the Respondent has no apparent rights.

Finally, the Complainant asserts that the Respondent will be unable to demonstrate that the registration of the Disputed Domain Names is not in fact an Abusive Registration. Indeed, according to the Complainant, (i) there is no evidence to suggest that the Respondent has used or made demonstrable preparations to use the Disputed Domain Names or a domain name which is similar to the Disputed Domain Names in connection with a genuine offering of goods or services and will not be able to do so in the future; (ii) the Respondent has not made a legitimate non-commercial fair use of the Disputed Domain Names; (iii) the Disputed Domain Names are not generic or descriptive; and (iv) the Respondent has not been commonly known by the Complainant's name or legitimately connected with the Complainant's trade marks.

Response

The Respondent did not reply to the Complainant's contentions.

6. Discussions and Findings

General

Under paragraph 2(a) of the Policy, for the Expert to order a transfer of the Disputed Domain Names, the Complainant is required to demonstrate, on the balance of probabilities, both of the following elements:

"(i) The Complainant has Rights in respect of a name or mark which is identical or similar to the Domain Names; and

(ii) The Domain Names, in the hands of the Respondent, are an Abusive Registration."

Complainant's rights

The Policy defines Rights as "*rights enforceable by the Complainant, whether under English law or otherwise*".

In this case, the Complainant has provided evidence that it owns registered trade marks as well as domain name rights in the term URBAN OUTFITTERS (see the Factual Background at Section 4 above), and so has proved that it has Rights as defined by the Policy.

The Policy also stipulates that the name or mark in which the Complainant has rights (URBAN OUTFITTERS) must be identical or similar to the Disputed Domain Names (uranoutfitters.co.uk,

urbannoutfitters.co.uk, urbanofitters.co.uk, urbanoutfitters.co.uk, urbanoutfittes.co.uk, urbanoutfitts.co.uk, urbanoutfittters.co.uk, urbanutfitters.co.uk, urbinoutfitters.co.uk, urbnoutfitters.co.uk, urbonoutfitters.co.uk and wwwurbanoutfitters.co.uk). It is accepted practice under the Policy to discount the .CO.UK suffix, and so the only difference between the Disputed Domain Names and the Complainant's registered trade marks is the fact that certain letters of the trade mark URBAN OUTFITTERS are missing or have been added to it. However the Expert does not feel that this is a significant difference, especially because the Disputed Domain Names are phonetically and visually very close to the name URBAN OUTFITTERS. The Complainant's trade marks in URBAN OUTFITTERS and the Disputed Domain Names are thus similar to one another.

As a result the Expert finds that paragraph 2(a)(i) of the Policy is satisfied and that the Complainant has Rights in respect of a name which is similar to the Disputed Domain Names.

Abusive Registration

Moving on to paragraph 2(a)(ii) of the Policy, Abusive Registration is defined in paragraph 1 of the Policy to mean a domain name which:

- (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.*

Paragraph 3(a) of the Policy sets out a list of five factors which may be evidence of Abusive Registration. The Complainant based its case on the factors set out in paragraphs 3(a)(i)(C), 3(a)(ii) and 3(a)(iii) which read as follows:

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

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

iii. 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 trademarks in which the Respondent has no apparent rights, and the Domain Name is part of that pattern;

(...)"

As far as paragraph 3(a)(i)(C) is concerned, the fact that the Respondent registered twelve domain names including misspellings of the Complainant's URBAN OUTFITTERS trade marks the same day shows that the Respondent was obviously aware of the Complainant when he registered the Disputed Domain Names. It is therefore difficult to think of a plausible explanation

as to why the Respondent would have chosen to register domain names so similar to the Complainant's trade marks if it was not in order to take unfair advantage of the Complainant's goodwill and reputation, and the Expert is satisfied that this is indeed the case. In addition, the Respondent has failed to come forward with an explanation for having selected the Disputed Domain Names. Under such circumstances, it will ordinarily be reasonable for an expert to infer that a respondent registered a domain name for a purpose that was abusive, see *Chivas Brothers Limited v David William Plenderleith* (DRS 292). The Expert therefore finds that the Disputed Domain Names have been registered in a manner which took unfair advantage of the Complainant's Rights, in accordance with limb (i) of the definition of Abusive Registration.

Regarding paragraph 3(a)(ii), it is helpful to refer to the "Expert Overview" document published on Nominet's website.

The Overview states as follows:

"3.3 Paragraph 3(a)(ii) concerns confusing use of the domain name. What is meant by confusing use?"

The 'confusion' referred to in this paragraph of the Policy is confusion as to the identity of the person/entity behind the domain name. Will an Internet user seeing the domain name or the site to which it is connected believe or be likely to believe that "the domain name is registered to, operated or authorised by, or otherwise connected with the Complainant"?

...

Commonly, Internet users will visit web sites either by way of search engines or by guessing the relevant URL. If the domain name in dispute is identical to the name of the Complainant and that name cannot sensibly refer to anyone else, there is bound to be a severe risk that a search engine, which is being asked for the Complainant, will produce high up on its list the URL for the web site connected to the domain name in issue. Similarly, there is bound to be a severe risk that an Internet user guessing the URL for the Complainant's web site will use the domain name for that purpose.

In such cases, the speculative visitor to the registrant's web site will be visiting it in the hope and expectation that the web site is a web site "operated or authorised by, or otherwise connected with the Complainant." This is what is known as 'initial interest confusion' and the overwhelming majority of Experts view it as a possible basis for a finding of Abusive Registration, the vice being that even if it is immediately apparent to the visitor to the web site that the site is not in any way connected with the Complainant, the visitor has been deceived. Having drawn the visitor to the site, the visitor may well be faced with an unauthorised tribute or criticism site (usually the latter) devoted to the Complainant; or a commercial web site, which may or may not advertise goods or services similar to those produced by the Complainant. Either way, the visitor will have been sucked in/deceived by the domain name.

Findings of Abusive Registration in this context are most likely to be made where the domain name in issue is identical to the name or mark of the Complainant and without any adornment (other than the generic domain suffix). See for example DRS 00658 (chivasbrothers.co.uk).

The further away the domain name is from the Complainant's name or mark, the less likely a finding of Abusive Registration. However, the activities of typosquatters are generally condemned - see for example DRS 03806 (privalege.co.uk) - as are those

people who attach as appendages to the Complainant's name or mark a word appropriate to the Complainant's field of activity. See for example the Appeal decision in DRS 00248 (seiko-shop.co.uk)."

In this case, as far as actual confusion is concerned, the Expert feels that it is not possible to make a finding on this based on the evidence presented. The Complainant itself states: "*Complainant is unable to provide affirmative evidence that such confusion has occurred and can only present to the Expert an argument which suggests that the practice is highly common, predictable and on the balance of probabilities is likely to occur*". A finding of actual confusion has therefore not been made out, given the lack of concrete evidence on this point.

Turning to the likelihood of confusion, the Complainant notes that the websites at the Disputed Domain Names are inactive. The Complainant argues that the ordinary visitor to the websites at the Disputed Domain Names will consider that the Complainant's official webpage is no longer in operation.

In the Expert's opinion, the question is whether the use of the Disputed Domain Names by the Respondent causes initial interest confusion. As stated in the case of <joiedevivreholidays.co.uk> (DRS 05122), initial interest confusion is the "*phenomenon whereby visitors to the Domain Name, in the moment before they actually reach the website, believe that the Domain Name is in some way connected to the Complainant*". In other words, this initial confusion causes some advantage to the domain owner, and it is the gaining of that advantage, that is unfair. The advantage referred to does not need to be monetary and could simply be disadvantage to a third party, for example, disruption to a business.

The Expert believes that any reasonable Internet user who was looking to find an official Urban Outfitters UK website in order to buy a genuine Urban Outfitters product would actually type the address www.urbanoutfitters.co.uk but the term "urbanoutfitters" being quite long and containing twelve different letters, it is likely that an Internet user may misspell this term or the address www.urbanoutfitters.co.uk. In the Expert's view, when being redirected to any of the websites at the Disputed Domain Names certain customers may have been astute enough to realise that they misspelled the Complainant's trade mark or web address, and thus tried to search for the Complainant's genuine website, but others may well have been misled by the Respondent's inactive use of the Disputed Domain Name into thinking that the Complainant's official UK website was no longer in operation. The fact that the Disputed Domain Names are either the exact reproduction or misspellings of the URBAN OUTFITTERS trade mark without any adornment (other than the generic domain suffix or the letters "www") and the fact that the websites at the Disputed Domain Names are inactive may lead a reasonable person to conclude that the Complainant has no UK active website.

In the Expert's view, it is not permissible for an entity to use a domain name which consists solely of the trade mark of that other party, even misspelled, without that third party's permission and this case is no exception.

Factor 3(a)(iii), relied upon by the Complainant, requires the Complainant to demonstrate that the Respondent is engaged in a pattern of registrations which correspond to well-known names or trade marks and the Disputed Domain Names are part of that pattern. In this regard the Complainant has highlighted the registration as domain names, by the Respondent, of the following brands: SEARS, SAKS, KURTGEIGER, EDDIEBAUER, FOOTLOCKER, BENCH, BARRATS, TJ HUGHES and VELVET AFFAIR. Thus factor 3(a)(iii) is found.

In conclusion, the Expert has considered the admissibility, relevance, materiality and weight of the evidence as a whole and is satisfied that the Complainant has succeeded in proving, on balance of probabilities, that the Disputed Domain Names are an Abusive Registration in accordance with paragraph 2(a)(ii) of the Policy.

7. Decision

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

Signed

Dated

4 May 2012