

DISPUTE RESOLUTION SERVICE

DRS 12372

Decision of Independent Expert

Taxpol Limited

Complainant

and

Financial & Management Accounting Services Limited

Respondent

1 The Parties

Complainant:	Taxpol Limited
Address:	Office 123 I C G House, Station Approach Oldfield Lane North Greenford London
Postcode:	UB6 0AL
Country:	United Kingdom

Respondent:	Financial & Management Accounting Services Limited
Address:	Suite 14 Central Chambers The Broadway London
Postcode:	W5 2NR
Country:	United Kingdom

2 The Domain Name

taxpol.co.uk (the "Domain Name").

3 Procedural History

23 January 2013 15:41. Dispute received
24 January 2013 10:48. Complaint validated
24 January 2013 11:08. Notification of complaint sent to parties
08 February 2013 10:41. Response received
08 February 2013 10:42. Notification of response sent to parties
13 February 2013 01:30. Reply reminder sent
14 February 2013 12:17. Reply received
14 February 2013 12:17. Notification of reply sent to parties
14 February 2013 12:18. Mediator appointed
19 February 2013 09:46. Mediation started
22 February 2013 13:51. Mediation failed
22 February 2013 13:51. Close of mediation documents sent
25 February 2013 15:22. Expert decision payment received

4 Factual Background

- 4.1 This is a dispute between two competing businesses, both of which offer accounting services to Polish émigrés currently resident in the United Kingdom. Both businesses are based in West London.
- 4.2 The Complainant, Taxpol Limited, was incorporated on 27 November 2007 and appears to have been in business since then.
- 4.3 The Respondent, Financial Management & Accounting Services Limited, which trades as PolAcc, was incorporated on 3 August 2006 and appears to have been in business since then.
- 4.4 The Domain Name was registered by the Respondent on 10 November 2010. It is currently being used in the URL for the Respondent's website.

5 Parties' Contentions

Complaint

- 5.1 The Complainant's website uses the domain name *taxpol.ltd.uk*. The Complainant asserts that it has traded since 2007 by reference to the Taxpol name and, unusually in the DRS, has taken the trouble to set out in considerable detail, and to evidence by relevant documentation, its marketing and advertising expenditure, which during the period 2008 to 2012 exceeded £28,000.
- 5.2 It says that in mid-2012 it became aware that the Domain Name "*had started to be used by another Polish accountancy firm based in London*". That was the Respondent. The Complainant explains that the Respondent trades as PolAcc and at that time the Domain Name was being used to point to the Respondent's website at *www.polacc.com*.

- 5.3 The Complainant is frank about the fact that it contacted the Respondent and offered to buy the Domain Name, but a price could not be agreed. Again, helpfully, the relevant email correspondence is exhibited.
- 5.4 The Complainant asserts that the Respondent's use of the Domain Name "*misguides our potential clients*". It contends that the Respondent is deriving benefit from its trading reputation. The Complainant concedes that it cannot put a figure on the number of such potential clients who may have been so "misguided", or what economic loss that number would represent. However, it points out that approximately one third of its revenue is derived from clients who find it online.
- 5.5 The Complainant says that if the Respondent's services are "*in any way unreliable*" that would also damage its reputation.
- 5.6 Finally, the Complainant asserts that "*the business profile of both companies is identical – both companies (Taxpol and PolAcc) provide the same category of services directed at identical target groups – bookkeeping and accountancy for small Polish businesses in the UK, tax returns filing and some immigration services. Both companies are based in West London*".

Response

- 5.7 The Respondent asserts that it has traded since 2006 "*under the name of Financial and Management Accounting Services Limited*". It says that its "*initial*" target market was large and medium sized companies that require specialist consulting and financial services. It says that in 2009 it decided to focus on the provision of accountancy services and tax advice to the Polish community in London. It says that at that time it decided that Taxpol would be a suitable company name because it "*could combine words taxation, Polish and accountancy*". In fact, it appears to combine only the first two of those words, while the Respondent's trading name, PolAcc, appears intended to combine the last two of those words.
- 5.8 It says it registered the Domain Name for an initial period of two years, i.e. expiring in November 2012, with the intention of forming a new company of the same name. However, it says that it subsequently realised that the Complainant already had a company of that name. It also identified other companies named Taxpol in other jurisdictions.
- 5.9 Accordingly, it says that it decided to trade by reference to the name PolAcc. It says that it has always marketed its services to the Polish community in London under the PolAcc name.
- 5.10 It says that in mid-2012 it saw an opportunity to use the Domain Name by forming a commercial relationship with a Polish company named Tax-Pol sp. z o.o. ("Tax-Pol Poland"), a Polish business which apparently offers accounting services to Polish nationals returning to Poland after having lived in another EU member state, who wish to claim a tax refund from the EU member state in which they have been living. No evidence is provided of this arrangement.
- 5.11 The Respondent does not dispute the Complainant's account of the abortive negotiations to purchase the Domain Name. Following the failure of those negotiations, it says it decided to "*set up a partnership with*" Tax-Pol Poland.
- 5.12 The Respondent says it does not understand why the Complainant believes that it has exclusive rights to the Taxpol name. It points out that it does not have a registered trade mark in that name.

- 5.13 The Respondent denies misleading potential clients of the Complainant. It says that it is simply seeking to "*profit from our partnership with Tax-Pol sp. z o.o. and this is and will be our only motive*". It says that there is nothing on its website to suggest that it is masquerading as, or connected with, the Complainant.
- 5.14 The Respondent points out that the Complainant did not, when it started its business, have the reputation to which it now lays claim and that it had made no previous approach to it about the Domain Name. It says it only received an approach when it was preparing to launch its new website using the Domain Name.
- 5.15 The Respondent accuses the Complainant of reverse domain name hijacking, asserting that it has brought this administrative proceeding only because it was unable to purchase the Domain Name at a price acceptable to it. It accuses the Complainant of "*trying to use his tactic to strong-arm innocent domain name registrant into giving up domain name that he in fact might not be entitled to*".
- 5.16 The Respondent adduces no evidence whatsoever in support of any of its assertions.

Reply

- 5.17 In its Reply, the Complainant responds to a number of the assertions in the Response. It is sceptical of the Respondent's version of events in light of its advertising campaign in the period 2009-10 which meant that its name was prominent in all the main Polish media in London. It considers it unlikely that the Respondent was unaware of its existence.
- 5.18 It points out that all the other companies trading by reference to the Taxpol name are based in other countries. It contends that it is highly unlikely that there could be any confusion between customers or potential customers of the various companies of that name in different jurisdictions, given that tax advice is jurisdiction specific. It does, however, concede that there is some overlap in the services provided by it and those provided by Tax-Pol Poland.
- 5.19 The Complainant explains that it has a competitor operating within the UK named Poltax, but both companies have enjoyed peaceful coexistence and have taken care to ensure that there could be no confusion as to their respective identities, nor have there been any disputes between them.
- 5.20 The Complainant is sceptical of the Respondent's justification for its renewed use of the Domain Name because it says no such announcement of the purported partnership with Tax-Pol Poland was made until 28 or 29 January 2013, i.e. a few days after it had filed the Complaint herein. It points out that, until then, no mention had ever been made by the Respondent of any such cooperation with the Polish company. Until then, it says that the Respondent had been using the Domain Name to point to its website at *www.polacc.com* (as evidenced by an exhibited screenshot).
- 5.21 The Complainant says that it was only when it first made an offer to buy the Domain Name in December 2012 that the Respondent started to use the Domain Name as its "*main web address*", i.e. in the URL for the home page of the Respondent's website and all its other pages. The Complainant says that it therefore suspects that: "*The alleged cooperation between the companies Financial and Management Accounting Services Limited and Tax-pol sp. z o.o. is fictional*".
- 5.22 The Complainant says that the Respondent's criticism of its failing to register the Taxpol name as a trade mark is misplaced because it has never "*deemed such an action necessary*".

- 5.23 It reiterates that the Respondent "*has been misguiding potential clients both through using taxpol.co.uk domain as his company's main web address, but also, prior to that, by redirecting them to the polacc.com website*". It says it believes that the Respondent will have benefitted financially thereby.
- 5.24 The Complainant points out that the service provided by Tax-Pol Poland, currently being advertised by the Respondent, competes with identical services offered by it. It says that there is therefore "*a considerable risk*" that a potential client will land on the Respondent's home page and then click through the link on the Respondent's home page to the website of Tax-Pol Poland. It asserts that such a state of affairs is "*definitely detrimental to our company and they may bring financial profits both to the Respondent himself and to the Polish company*".
- 5.25 The Complainant rejects the Respondent's assertion that it delayed in asserting its rights to the Domain Name. It reiterates that it only became aware of the Respondent's use of the Domain Name in 2012 and that, as soon as it did become so aware, it made an offer to buy it. It also rejects the Respondent's assertion that it was only approached when it started to publicise its "*partnership arrangement*". The Complainant points out that, on the contrary, that partnership arrangement was only publicised by the Respondent after its Complaint had been filed.
- 5.26 The Complainant also rejects the Respondent's assertion that the Complaint herein has been made purely as a cheap means of obtaining the Domain Name. It says that it simply wishes to reclaim a domain name which the Respondent is using unlawfully and to its detriment. It says that at the time it made an offer to purchase the Domain Name, it was not aware of the DRS and if it had been, it would have filed a Complaint under the DRS immediately, rather than making an offer to buy the Domain Name.
- 5.27 Finally, the Complainant asserts that on 26 January 2013 the Respondent registered another domain name similar to the Domain Name, *tax-pol.co.uk*.

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 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*".
- 6.4 While, as the Respondent points out, the Complainant does not own a registered mark in the Taxpol name, it is nonetheless, entitled to rely on any common law rights it might have in that name.
- 6.5 Given that it has since 2007 traded by reference to the Taxpol name, and provided cogent evidence of expenditure on marketing and advertising in support of that name, the Complainant has such common law rights, and accordingly Rights as defined in the Policy, in the Taxpol name.
- 6.6 The Taxpol name is plainly identical or similar to the Domain Name.
- 6.7 Accordingly, the Complainant has Rights in respect of a name or mark that is identical or similar to the Domain Name for the purposes of paragraph 2(a)(i) of the Policy.

Evidence of abusive registration

- 6.8 The Complainant does not identify which of the factors set out in paragraph 3 of the Policy it relies on in its assertion that the Domain Name is an Abusive Registration.
- 6.9 However, the Complainant's case is essentially that the Respondent's use of the Domain Name falls within paragraph 3(a)(i)(C) and/or paragraph 3(a)(ii) of the Policy, i.e. 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 and/or 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 Claimant.
- 6.10 In light of the Complainant's marketing and advertising in 2009-10 directed at the Polish community in London, which is the same target market as that of the Respondent, it is on balance unlikely that, at the time of registration of the Domain Name, the Respondent was unaware of the Complainant's existence. The Respondent explains that in 2009 it carried out "*extensive research on possible company names and one of the first choices was Taxpol*". It seems implausible that the Respondent's extensive research did not include checking whether there was already a company of that name providing the very services which the Respondent provided.
- 6.11 It appears to be common ground between the parties (in that it is not denied by the Respondent) that at least for the initial two years or so, the Respondent was using the Domain Name to direct internet users to its website. Given the Complainant's rights in the Taxpol name, such use was abusive.
- 6.12 The Respondent now asserts that its use of the Domain Name is legitimate because it has established a commercial relationship with Tax-Pol Poland. That is not, however, a complete answer to the Complaint.
- 6.13 In the first place, it does not excuse its conduct when it first registered the Domain Name, as set out at 6.11 above.

- 6.14 Secondly, it is the Complainant's case that this development was simply a reaction to the filing of the Complaint. The Respondent does not deal in its Response with the question of timing (which is raised by the Complainant only in the Reply). Whether that omission is deliberate or inadvertent it is impossible to say. The Respondent says that it found a different potential use of the Domain Name "*in the middle of 2012*" but no date is put on the establishment of its partnership with Tax-Pol Poland.
- 6.15 Thirdly, and in any event, even if the arrangements with Tax-Pol Poland are genuine, and even if those arrangements were made before the Respondent was on notice of the Complaint in these proceedings, it has been and is currently using the Domain Name in a way which seeks to benefit from the Complainant's trading goodwill in the Taxpol name to the commercial advantage of itself and its Polish partner. There is no reason why the Respondent could not have continued to use its *polacc.com* domain name for its website and provided a click-through to its Polish partner's *tax-pol.pl* website.
- 6.16 Accordingly, on the balance of probabilities, the Expert is satisfied that the Domain Name was registered and/or has been used in a manner which took and takes unfair advantage of the Complainant's Rights in the Mark and/or was and is unfairly detrimental to those rights.
- 6.17 For the avoidance of doubt, it therefore follows that the Respondent's complaint of reverse domain name hijacking fails.

7 Decision

- 7.1 The Expert finds that the Complainant has Rights in a name or mark which is identical or similar to the Domain Name and that the Domain Name, in the hands of the Respondent, is an Abusive Registration.
- 7.2 It is therefore determined that the Domain Name be transferred to the Complainant.

David Engel

Signed

Dated 25 March 2013