

DISPUTE RESOLUTION SERVICE

D00012940

Decision of Independent Expert

Cash Converters Pty Ltd

and

Mr Ian Hepburn

1. The Parties

Lead Complainant: Cash Converters Pty Ltd
Level 18, Chancery House
37 St Georges Terrace
Perth
WA 600
Australia

Complainant: Cash Converters (UK) Ltd
17 Gentlemens Field
Westmill Road
Ware
Hertfordshire
SG12 0EF
United Kingdom

Respondent: Mr Ian Hepburn
16 Talisman Crescent
Motherwell
ML1 3YB
United Kingdom

2. The Domain Name

<cashconverters.org.uk> ("the Disputed Domain Name")

3. Procedural History

The Complaint was filed with Nominet on 14 June 2013. Nominet validated the Complaint on the same day and notified the Respondent by post and by email, stating that the Response had to be received on or before 5 July 2013. No response was

received, despite a reminder notification sent on 3 July 2013. On 8 July 2013 Nominet sent a notification of no response to both parties and informed the Complainants' representative that mediation was not possible and that it had until 22 July 2013 to pay the fee for either a full or a summary decision of an Expert pursuant to paragraph 7 of the Nominet Dispute Resolution Service Policy ("the Policy"). On 10 July 2013 the Complainants' representative paid Nominet the fee for a full decision.

On 12 July 2013 the undersigned, Jane Seager ("the Expert"), confirmed to Nominet that she was independent of each of the parties and that, to the best of her knowledge and belief, there were no facts or circumstances, past or present (or that could arise in the foreseeable future) that needed to be disclosed as they might be of a such a nature as to call in to question her independence in the eyes of one or both of the parties.

4. Factual Background

The Lead Complainant is Cash Converters Pty Ltd, an Australian company incorporated under the provisions of the Australian Corporations Act 2001. The Complaint is also brought by Cash Converters (UK) Limited, a company registered in England and Wales with company number 3096334.

The Lead Complainant is a wholly owned subsidiary of Cash Converters International Limited, an Australian public company. The Complainant Cash Converters (UK) Limited is a wholly owned subsidiary of Cash Converters UK Holdings PLC, which is also a wholly owned subsidiary of Cash Converters International Limited ("the Complainants' Parent").

The Complainants are part of a group of companies that are responsible for creating and developing the CASH CONVERTERS international franchise system. This system dates back to 1984 when a retail store offering pawn broking services to the public was opened in Perth, Western Australia, operating under the CASH CONVERTERS name and trade mark. Since then, the business has grown to over 600 stores in 21 countries around the world. It has expanded beyond just pawn broking services into other services, including online sales of second hand goods, cash for gold, cash advances and personal and payday loans.

There are currently 208 retail stores operating in the United Kingdom under the name and trade mark CASH CONVERTERS. In 2011 the Complainants' Parent reported turnover of over AUD 186 million and a net profit of AUD 27.6 million across its businesses, which includes the Complainants.

The Respondent is Mr Ian Hepburn of Motherwell in the United Kingdom. No other details are known about the Respondent, apart from the fact that, at some point after 18 January 2013, he elected to have his address removed from Nominet's Whois database on the basis that he was a non-trading individual.

The Disputed Domain Name was registered on 25 December 2012. It was previously being used to point to a website offering loans (containing various references to Cash Converters) and then redirected to a different website offering similar loan services (www.ineedcash.co.uk).

5. Parties' Contentions

Complaint

Complainants' Rights

Registered Rights

The Lead Complainant has registered rights in a Community Trade Mark registered at the Office for the Harmonization of the Internal Market ("OHIM") for the word mark CASH CONVERTERS. This trade mark was filed on 15 August 2000 and registered on 10 October 2003.

The Lead Complainant also has registered rights in two UK trade marks registered at the United Kingdom Intellectual Property Office ("UKIPO") for the word mark CASH CONVERTERS. The first trade mark was filed on 2 May 1991 and registered on 1 October 1993. The second trade mark was filed on 15 July 2011 and registered on 25 November 2011.

The Lead Complainant is also the registered proprietor of a number of other registered trade marks in the term CASH CONVERTERS, registered in various jurisdictions around the world (these trade marks, together with the UK and Community Trade Marks referred to above, are collectively referred to as "the Cash Converters Trade Marks").

All of the Cash Converters Trade Marks are registered for either the word mark CASH CONVERTERS or a mark of which the primary and most significant elements are the words CASH CONVERTERS.

The Complainant is the head UK franchisee of the Lead Complainant under the terms of a Franchise Agreement dated 18 January 1994. The Complainant is entitled to use the Cash Converters Trade Marks owned by the Lead Complainant under the terms of a Registered User Agreement, also dated 18 January 1994.

In any event, the Complainants assert that they are associated companies and thus a licence between them for the use of the Cash Converters Trade Marks should therefore be assumed, in accordance with the appeal decision in *Nominet DRS 00248* (<seiko-shop.co.uk>).

The Complainants state that they have used, continue to use and intend to use in the future the Cash Converters Trade Marks in connection with the services for which they are registered. In particular, these services include financial and financing services, including loan services.

Unregistered rights

The Complainants also assert that the Complaint is also based on unregistered rights in the form of goodwill existing at all material times within the United Kingdom and generated by the Complainants' businesses under the name CASH CONVERTERS ("the Cash Converters Name"). The Complainants then list the apparent reasons for this, as set out below.

The Lead Complainant was incorporated in Australia on or about 6 January 1988 and the Complainant was incorporated in the United Kingdom on or about 30 August 1995. The

Complainants state that the Cash Converters Name has been used, and continues to be used, by the Complainants since their respective incorporation dates in relation to the services for which the Cash Converters Trade Marks are registered.

The Complainants' Parent is the registrant of the domain name <cashconverters.com>. The Lead Complainant is the registrant of the domain names <cashconverters.com.au>, <cashconverters.net.au> and <cashconverters.pt>. The Complainant is the registrant of the domain names <cashconverters.co.uk> and <cashconverters.net>. The Complainants have also authorised various other parties to register and use additional domain names incorporating the Cash Converters Name and Trade Marks.

In addition the Lead Complainant has successfully contested the following domain name complaints:

- WIPO case number DCH2012-0021 (<cashconverters.ch>);
- WIPO case number D2012-1012 (<48hourcashconverters.com>);
- WIPO case number D2012-1013 (<cashconverterssingapore.com>);
- .eu ADR Case No. 06346 (<cashconverters.eu>); and
- auDA Domain Monetisation Policy Complaint, Ref: C1109510 (<cashconvertersloans.com.au>).

The Complainant has operated in the UK since 1991 when it opened its first store in Gants Hill in Essex. It has run the website www.cashconverters.co.uk since around November 1997. This website is used to promote the services which the Complainant and its sub-franchisees provide in the United Kingdom using the Cash Converters Name and Trade Marks. In particular, since at least 23 February 2001, the website has offered internet users:

- information about the Complainants' business activities, including the history of the business;
- information as to where CASH CONVERTERS stores are located throughout the UK; and
- employment and franchisee opportunities.

Internet users of the website currently have access to the following services:

- recent media and press coverage, charity and fund raising activities, football sponsorship, darts sponsorship and access to the Cash Converters smartphone application software;
- online loan services, including personal loans, cash advance loans, buyback loans, logbook loans and cheque cashing; and
- an online shop and online auction which sells, among other things, jewellery, video games and consoles, cameras, mobile phones, televisions, computers and guitars which have been previously pawned.

The Complainant has also developed a smartphone application called "CASH CONVERTERS UK" that smartphone users can download and use for free. This application allows users to search for and purchase second hand goods from the Complainant, and also to apply for the Complainants' personal loan services.

The Complainants assert that they have built strong reputation and goodwill in the Cash Converters Name and Trade Marks through substantial marketing and other promotional

activities. During the year ending 30 June 2012, the Complainants state that they spent in excess of £1,970,000 in the UK on advertising and promotional activities, which included TV advertising, conference advertising and other online and offline advertising.

The Complainant adds that it has promoted the Cash Converters Name and Trade Marks through various sponsorship deals. Since 2011 the Complainant has been the lead sponsor of the Championship Football League team Hull City Association Football Club and also the Scottish Premier League team Motherwell Football Club. Television and other media coverage of football matches involving these teams, and therefore display of the Cash Converters Name and Trade Marks, has been extensive. Since 2012 the Complainant has been a sponsor of the Professional Darts Corporation World Cup Of Darts. In particular, the Complainant is the title sponsor of the Cash Converters Players Championship Finals.

The Complainant has also promoted the Cash Converters Name and Trade Marks through social media campaigns. This includes a Facebook page and a Twitter feed incorporating the Cash Converters Name and Trade Marks. As of 12 February 2013, the Cash Converters UK Facebook page had 13,990 likes from people with Facebook profiles. As of 7 February 2013, the Twitter feed had over 45,000 "tweets" and 1,457 followers.

The Complainants' revenue generated in the UK for the years ending 31 June 2008, 2009, 2010, 2011 and 2012 totalled AUD 22,710,115 (approximately £15,126,468.33), AUD 32,110,057 (approximately £21,387,463.71), AUD 39,420,231 (approximately £26,253,024.04), AUD 57,462,805 (approximately £38,268,989.38) and AUD 77,872,659 (approximately £51,859,361.17) respectively. According to the Complainants, this is demonstrative of the level of goodwill in the CASH CONVERTERS Name and Trade Marks in the UK.

The Complainants state that entering the search term "CASH CONVERTERS" into a search engine usually produces a link to the Complainant's website as the first natural (non-sponsored) result entry. Links to other websites belonging to the Complainants or their associated companies also appear on the first page of results.

In summary, as a result of the Complainants' extensive use of the Cash Converters Trade Marks, the Complainants submit that they have developed common law rights in the form of goodwill in the UK in the term CASH CONVERTERS in respect of the services for which the Cash Converters Trade Marks are registered. The Complainants assert that consumers in the UK would recognise the words CASH CONVERTERS as indicating the services of the Complainants.

Identical or Similar to the Disputed Domain Name

The Complainants argue that the Disputed Domain Name is identical or confusingly similar to the Complainants' Rights in the Cash Converters Trade Marks because the Disputed Domain Name incorporates the term CASH CONVERTERS in its entirety, and the similarity is not removed by the addition of the .CO.UK country code Top Level Domain (*Aktiebolaget Electrolux v. Priscilla Quaiotti Passos*, WIPO Case No. D2011-0388).

Abusive Registration

The Complainants assert that the Respondent has:

- registered or otherwise acquired the Disputed Domain Name for the purpose of unfairly disrupting the business of the Complainant in accordance with paragraph 3(a)(i)(C) of the Policy; and
- used and is using the Disputed Domain Name in a way which has confused or is likely to confuse people or businesses into believing that it is registered to, operated or authorised by, or otherwise connected with the Complainants in accordance with paragraph 3(a)(ii) of the Policy.

As far as abusive registration and unfair disruption under paragraph 3(a)(i)(C) of the Policy is concerned, the Complainants argue that the Respondent has deliberately registered the Disputed Domain Name to exploit the goodwill and reputation in the CASH CONVERTERS Name and Trade Marks, so as to gain an unfair advantage by initially passing the Respondent's business off as the Complainants' business and then diverting traffic to another commercial website of a competitive business.

The Complainants assert that diversion of internet users unfairly disrupts the business of the Complainant, contrary to paragraph 3(a)(i)(C) of the Policy and identified in many decisions (for example *L'Oréal, Biotherm, Lancôme Parfums et Beauté & Cie v. Unasi, Inc.*, WIPO Case No. D2005-0623; *Veuve Clicquot Ponsardin, Maison Fondée en 1772 v. The Polygenix Group Co.*, WIPO Case No. D2000-0163 and *Hoffmann-La Roche Inc. v. Samuel Teodorek*, WIPO Case No. D2007-1814).

Turning to use of the Disputed Domain Name under paragraph 3(a)(ii) of the Policy, the Respondent first used the website to which the Disputed Domain Name was pointing to promote loan services using the words "Cash converter loans" and the statement "The UK's Leading and trusted name in same day cash loans". In the Complainants' opinion, such use is demonstrative of the Respondent's use of the Domain Name in a way which has confused or is likely to confuse users into thinking that it is registered to, operated by, authorised by or otherwise associated with the Complainants.

This is also demonstrated by the use of the phrase on the website "as seen on 4", which is a reference to the Channel 4 television station. As far as the Complainants are aware, the Respondent has never advertised or promoted his services on Channel 4, but the Complainants have done so. Therefore the use of the term "as seen on 4" is clearly an attempt to confuse users into thinking that the website is associated with the Complainants.

In the Complainants' opinion, such use of the Disputed Domain Name is likely to result in confusion as to the identity of the entity behind it because the Disputed Domain Name is identical or similar to the Cash Converters Trade Marks and the Respondent's use of the Disputed Domain Name is in connection with services which are identical to those offered by the Complainants.

In particular, the Complainants provide payday loan services and the Cash Converters Trade Marks are registered for, among other things, financial and financing services including loan services and financing services, fund and money transfers, and loans. There is therefore a clear overlap between the services offered by the Respondent while using the Disputed Domain Name and the services provided by the Complainants for which the Cash Converters Trade Marks are registered.

The Complainants therefore state that those who came across the Disputed Domain Name and the website to which it was pointing would have done so in the likely belief that the services being offered by the Respondent were being offered by the Complainants, or were in some way connected with the Complainants.

At some time between 25 January 2013 and 6 February 2013, the Respondent changed the pointing of the Disputed Domain Name to direct internet users to another website offering internet users payday loans on completion of an online application form, namely www.ineedcash.co.uk. The domain name <ineedcash.co.uk> is registered to D and D Marketing Inc, an unknown third party.

The Complainants argue that such use of the Disputed Domain Name may result in "initial interest confusion". The Complainants point out that it is common for internet users to find or visit websites by way of a search engine or by guessing the relevant address. The Disputed Domain Name incorporates the Complainants' Cash Converters Name and Trade Marks. As a result, the Complainants assert that internet users are likely to believe that the address could not sensibly refer to anyone else but the Complainants. There is therefore a severe risk that an internet user guessing the address for the Complainants' UK website may believe that the Complainants' website is hosted at the Disputed Domain Name, or may at least visit the website in the hope and expectation that the website is a website operated or authored by, or otherwise connected with the Complainants.

According to the Complainants, it may or may not be apparent on arriving at the Respondent's website as displayed on 6 February 2013 that such website is not connected with the Complainants. Nevertheless, the Complainants submit that the internet user will still have been deceived. Having drawn the internet user to the website, he or she is then faced with a commercial website which advertises services which compete with the Complainants' services and is able to choose to obtain a loan from "I Need Cash". Thus, the Complainants assert that they may be deprived of a business opportunity by this diversion of traffic.

In summary, the Complainants' argue that the Respondent is using the Disputed Domain Name in order to misdirect potential customers away from the Complainants' website to another website offering competing pay day loan services to those offered by the Complainants. The Respondent is thus misusing the Disputed Domain Name to intentionally attempt to attract internet users to a rival website.

Due to the existing reputation of the well-known Cash Converters Name and Trade Marks in the UK, the Complainants argue that the Respondent must be aware of the Complainants' Rights and must be aware that what he is doing is deceptive and misleading. In any event, he would have been aware of the Complainants' Rights had he carried out a simple search of the relevant trade mark registers, or alternatively carried out an internet search engine search using the search term "CASH CONVERTERS", in which case the Complainants' Rights would have been apparent to the Respondent immediately.

The Complainants state that the Disputed Domain Name is not generic or descriptive. The words "cash converters" together do not constitute a common phrase, and the words "cash converters" have no dictionary meaning. For example, neither the online Oxford Dictionary nor the online Cambridge Dictionary return any meaningful result for the words "cash converters". In fact, according to the Complainants, the words have developed

their own meaning as a consequence of the Complainants' substantial use of them as the name of the Complainants' business - the words have come to mean and refer to the Complainants and the Complainants' business. Even if "cash converters" did have a dictionary meaning (which is denied) or the words were descriptive in some other way, as a result of the extensive use and promotion of the Cash Converters Name and Trade Marks by the Complainants, the words "cash converters" have overwhelmingly acquired a secondary meaning, referring only to the Complainants' business.

The Complainants also contend that the Respondent is unable to demonstrate that the Disputed Domain Name is not an Abusive Registration pursuant to paragraphs 4(a)(i)(A) and 4(a)(i)(C) of the Policy. This is because the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name. Indeed the Respondent has no trade mark rights in or license to use the Complainants' trade marks. In addition the Complainants argue that because the Respondent is not commonly known by the name "CASH CONVERTERS", the Respondent cannot claim any rights established by common usage.

The Complainants thus contend that they have established the required elements under the Policy and request the transfer of the Disputed Domain Name to the Complainant Cash Converters (UK) Ltd.

Response

No Response was received.

6. Discussion and Findings

General

Under paragraph 2(a) of the Policy, for the Expert to order a transfer of the Disputed Domain Name the Complainants are 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 Name; and*
- (ii) *The Domain Name, in the hands of the Respondent, is an Abusive Registration."*

Complainant's Rights

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

The Expert is satisfied, based on the evidence presented, that the Complainants have the necessary Rights in the term CASH CONVERTERS, notably as a result of the trade marks referred to in the Complainants' submission (as summarised above).

Furthermore, the Policy stipulates that the name or mark in which the Complainants have Rights (CASH CONVERTERS) must be identical or similar to the Disputed Domain Name (<cashconverters.org.uk>).

It is accepted practice under the Policy to discount the ".ORG.UK" suffix, and so as a result the Expert finds that paragraph 2(a)(i) of the Policy is satisfied and that the Complainants have Rights in respect of a name which is identical to the Disputed Domain Name.

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."*

Having considered the Complainants' submissions in detail, the Expert is satisfied that this is a clear-cut case of cybersquatting.

Given the evidence presented regarding the Complainants' substantial trading history and extensive use of the CASH CONVERTERS brand in the United Kingdom, it is clear that the Respondent would have been aware of the Complainants at the time that the Disputed Domain Name was registered. Indeed, in the light of the subsequent use of the Disputed Domain Name, the Expert is convinced that the Respondent registered the Disputed Domain Name with the Complainants in mind specifically to take unfair advantage of the Complainants' Rights, as required by (i) above. The words CASH CONVERTERS when placed together are not simply descriptive, especially when used in relation to financial services and, in particular, payday loans, and the Respondent's motivation upon registration of the Disputed Domain Name must almost certainly have been to profit from the existing reputation and goodwill previously built up by the Complainants.

Furthermore, the Respondent's subsequent use of the Disputed Domain Name can only have been to take unfair advantage of the Complainants' Rights, as required by (ii) above. As can be seen from the Complainants' submissions, the Respondent first used the Disputed Domain Name to point to a website offering payday loans that made various references to Cash Converters. It was then used to point to a differently branded website, also offering payday loans. In both instances the Respondent was clearly using the Disputed Domain Name, which is undeniably associated with the Complainants, to draw internet users to these websites in order to enter into contact with them and ultimately to make some form of financial gain (although the Respondent does not appear to be offering loan services directly, but simply passing potential enquiries to a third party). It may well become clear to internet users that the Complainants have nothing to do with the services on offer (in particular once the Disputed Domain Name was being used to point to a differently branded website), but this is of no importance because, as the Complainants point out, internet users have been diverted and the Complainants may have lost a business opportunity, thus resulting in unfair detriment.

For the sake of completeness, paragraph 3(a) of the Policy sets out a non-exhaustive list of factors which may be evidence of abuse. The Complainants have argued that paragraphs 3(a)(i)(C) and 3(a)(ii) are satisfied. The Expert is not certain that paragraph

3(a)(i)(C) is applicable in this case because the Policy states that the Respondent's *primary* motivation for registration of the Disputed Domain name must be unfair disruption of the Complainants' business. Whilst the Respondent's actions could indeed have resulted in such disruption, in the Expert's opinion this was not the main reason why the Respondent registered the Disputed Domain Name. It seems more likely that the Respondent's primary motivation upon registration of the Disputed Domain Name was simply his own financial gain.

However, the Expert finds that paragraph 3(a)(ii) perfectly describes the Respondent's behaviour in that he has used the Disputed Domain Name in a way which has confused or is likely to confuse people or businesses into believing that it was registered to, operated or authorised by, or otherwise connected with the Complainants.

Finally, paragraph 4(a) of the Policy sets out a non-exhaustive list of factors which may be evidence of non-abuse, but none of these factors are of any assistance to the Respondent in the present case.

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

7. Decision

The Expert finds that the Complainants have Rights in a name which is identical to the Disputed Domain Name, and that the Disputed Domain Name, in the hands of the Respondent, is an Abusive Registration. The Disputed Domain Name should therefore be transferred to the Complainant Cash Converters (UK) Ltd.

Jane Seager
18 July 2013