

## DISPUTE RESOLUTION SERVICE

D00013022

### Decision of Independent Expert

RTWExperts Ltd

and

Flight Centre (UK) Limited

#### **1. The Parties:**

Complainant: RTWExperts Ltd  
Suite 19163  
Lower Ground Floor  
145-157 St John Street  
London  
EC1V 4PW  
United Kingdom

Respondent: Flight Centre (UK) Limited  
CI Tower, St Georges Square  
6th Floor  
New Malden  
Surrey  
KT3 4TE  
United Kingdom

#### **2. The Domain Name(s):**

rtwexperts.co.uk

### **3. Procedural History:**

I can confirm that I am independent of each of the parties. To the best of my knowledge and belief, there are no facts or circumstances, past or present, or that could arise in the foreseeable future, that need be disclosed as they might be of a such a nature as to call in to question my independence in the eyes of one or both of the parties.

01 July 2013 18:36 Dispute received  
02 July 2013 11:10 Complaint validated  
02 July 2013 11:45 Notification of complaint sent to parties  
15 July 2013 14:33 Response received  
15 July 2013 14:33 Notification of response sent to parties  
16 July 2013 13:56 Reply received  
16 July 2013 13:58 Notification of reply sent to parties  
16 July 2013 13:58 Mediator appointed  
19 July 2013 09:09 Mediation started  
26 July 2013 13:40 Mediation failed  
26 July 2013 14:49 Close of mediation documents sent  
07 August 2013 02:30 Complainant full fee reminder sent  
08 August 2013 12:03 Expert decision payment received

### **4. Factual Background**

The Complainant operates a travel and holiday booking business by means of three companies registered in each of the UK, Australia and South Africa. It is the owner of a Community Trade Mark (“CTM”) number 011486958 registered on 13 June 2013. This consists of both a device, which is described by the Complainant as comprising a globe with arrows surrounding it, together with the words “RTW EXPERTS” underneath. The words are prominent and easily legible.

The Respondent also operates a travel and holiday booking business in the UK. The website to which the Domain Name resolves appears to be a functional website operated by the Respondent offering services in the arena of travel bookings and holidays. The Respondent has been using the Domain Name since 29 September 2009, its having been registered on 24 September 2009.

### **5. Parties’ Contentions**

#### ***The Complaint***

The Complainant makes the following submissions:

1. It is the licensee of Australian and EU registered trade marks composed of the words “RTW EXPERTS” appearing with a blue and white globe and light blue arrows around the globe.

2. The owner of the trade marks is a director of three companies in each of the UK, Australia and South Africa, which are the only licensed users of the trade marks.
3. There is something “unfair” with regard to the Respondent’s ownership and use of the Domain Name.
4. The Domain Name implies that the Respondent is a division of the Complainant or otherwise owned or operated by the Complainant.
5. The Respondent is taking unfair advantage of the Complainant’s name and trade mark.
6. There are also examples of customers of the Respondent who have been confused and contact the Complainant for help with their booking made with the Respondent.
7. The Complainant is also involved in the 2014 Absa Cape Epic, for which it has been selling products since 24 March 2013, but which the Complainant feels has led to many inquiries being diverted to the Respondent.
8. The Domain Name is only used to redirect traffic.

### ***The Response***

The Respondent makes the following submissions:

1. The Respondent has been operating its business known as “Round the World Experts” since 2006.
2. The Domain Name has been operated by the Respondent since 29 March 2009 and the previous domain name, [www.roundtheworldexperts.co.uk](http://www.roundtheworldexperts.co.uk), has been operating since 10 July 2007.
3. The Respondent’s business is substantial with 100 dedicated experts in 15 teams around the UK.
4. The Respondent’s business predates the Complainant’s, while the Complainant’s UK business was only registered on 6 August 2012, and its Australian business was only registered on 25 January 2012.
5. The Respondent has a CTM registered on 6 March 2013, while the Complainant’s CTM was registered on 13 June 2013, and its Australian trade mark was applied for on 30 May 2013 and is currently unregistered.
6. The Complainant’s domain name, [www.rtwexperts.com](http://www.rtwexperts.com), was only registered on 28 December 2011, some years after the Respondent’s domain names had been actively trading.
7. The Complainant’s allegations of taking unfair advantage are denied and the Complainant is trading off the Respondent’s domain name, and it should be transferred to the Respondent.
8. The Respondent’s domain name and operations make it clear that the business is run by the Respondent.
9. The Respondent cannot say whether it is receiving enquiries relating to the Complainant’s business.
10. “Round the World Experts” is an important UK brand for the Respondent.

11. Any confusion is caused by the Complainant's having adopted the Respondent's trading style.

### ***The Reply***

1. The Complainant does not contest that it owns or trades as "Round the World Experts" in the UK.
2. The Respondent's trade mark relates to "ROUND THE WORLD EXPERTS", not "RTW EXPERTS", which is owned by the Respondent.
3. The Complaint relates to the fact that the Domain Name points to "Round the World Experts", and the Respondent does not trade as "RTWExperts" anywhere in the world other than the UK.
4. The Complainant's company name is registered in three continents as "RTWExperts", which is also the trading name and trade mark.
5. By having the Domain Name pointing to the Respondent's website is an infringement of the Complainant's rights.
6. The Respondent's use of the Domain Name for the sole use of misleading customers to go to a different business is an abuse.

## **6. Discussions and Findings**

### ***Rights***

In the DRS Policy, Rights are defined as, "rights enforceable by the Complainant, whether under English law or otherwise, and may include rights in descriptive terms which have acquired a secondary meaning". By paragraph 2 of the DRS Policy, the Complainant must show on the balance of probabilities that it has Rights in respect of a name or mark which is identical with or similar to the Domain Name and that the Domain Name in the Respondent's hands is an Abusive Registration.

"Rights" is a relatively low threshold according the decisions under the DRS Policy. In this case, the Complainant points primarily to its CTM.

This CTM is not in fact owned by the Complainant, but by Michael Carter, who makes the Complaint on the Complainant's behalf. He states, and I accept, that the rights under the CTM are exclusively licensed to the three companies of which he is a director, including the Complainant.

Rights under the DRS Policy do not have to be formal or registered rights, but can be derived by contract such as, in this case, a licence.

Turning to the scope of the rights themselves, taking the words from the CTM, they are identical with the Domain Name, leaving out the suffix, and allowing for the fact that the Domain Name is spelt, as it must be, without spaces between the words. These are immaterial distinctions.

The Respondent states, and I accept, that the Complainant has applied for a trade mark in Australia, but it has not been granted yet. I therefore discount this.

The Complainant has not provided any substantial evidence of actual trading, such as to create unregistered Rights. The Complainant has stated that it is the official international travel partner for the 2014 Absa Cape Epic, one of the Africa's largest mountain bike events. It states that it has had products on sale for UK and European riders since the 24th of March 2013. The Complainant has not provided evidence to show the significance of being such an "official international travel partner", and has not provided any evidence of what products exactly have been on sale. I therefore discount this.

On the basis of the CTM and the Complainant's licence to use it, I find that the Complainant has demonstrated that it has Rights identical with or similar to the Domain Name.

### ***Abusive Registration***

Paragraph 3 of the DRS Policy sets out a number of non-exhaustive factors which may indicate that the Domain Name is an Abusive Registration.

The DRS Policy defines an Abusive Registration as "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 has taken unfair advantage of or has been unfairly detrimental to the Complainant's Rights".

The Complainant has not specified which paragraphs it believes to be relevant, but the paragraphs which appear to be most relevant from reading the Complaint are paragraphs 3(i)(B), 3(i)(C) and 3(ii).

For the purpose of limb (i) of the definition of Abusive Registration, it is necessary to show that, when the Respondent registered the Domain Name, it took unfair advantage of or was unfairly detrimental to the Complainant's Rights.

The Domain Name itself resolves to a different URL, namely, "www.roundtheworldexperts.co.uk". I accept the Respondent's evidence that it has been operating under the latter URL since 10 July 2007. I further accept the Respondent's evidence that it has been using the Domain Name since 29 September 2009. This should be compared with the earliest date for the Complainant's Rights, namely, the Complainant's CTM which only dates from 13 June 2013.

I also accept the Respondent's evidence that the Complainant's website using www.rtwexperts.com was only registered on 28 December 2011. Even if (and the Complainant has provided no evidence of this) the Complainant has acquired unregistered Rights since 28 December 2011 by trading through its

website, then the Respondent did not register the Domain Name at a time when the Complainant had any Rights. A similar point relates to any Rights the Complainant may have acquired by becoming official international partner for the Absa Cape Epic event and the sale of “products” since March 2013.

This in turn means that there can be no possibility of an Abusive Registration under paragraphs 3(i)(B) or 3(i)(C).

This leaves paragraph 3(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”.

The Complainant has included one alleged instance of confusion, though it states that there are more. Looking at that one instance, it is not clear to me that it is in fact evidence of confusion: it seems to be information about a new offering rather than confusion about an existing one.

In any case, the source of any confusion does not derive from the Respondent, or its use of the Domain Name, but rather from the fact that the Complainant has subsequently come into the same business area and has adopted an identical trading name to the Domain Name, which had been legitimately used by the Respondent for some time previously.

Paragraph 4 of the DRS Policy provides a number of reasons for showing that the Domain Name is not an Abusive Registration. Paragraph 4(a)(i) provides that one such reason is that before “being aware of the Complainant's cause for complaint (not necessarily the 'complaint' under the DRS), the Respondent has:

- A. used or made demonstrable preparations to use the Domain Name or a domain name which is similar to the Domain Name in connection with a genuine offering of goods or services;
- B. been commonly known by the name or legitimately connected with a mark which is identical or similar to the Domain Name; ...”

From the limited evidence provided by the parties, it seems to me that the Respondent's activities fall squarely within this paragraph. Having looked at [www.rtwexperts.co.uk](http://www.rtwexperts.co.uk), and the domain name to which it resolves, [www.roundtheworldexperts.co.uk](http://www.roundtheworldexperts.co.uk), it appears to me clear that this is a genuine offering of travel related services. I also accept that Respondent's evidence that it has been trading in this style using these domain names for some time previously to the Complainant's use of its CTM.

For the Respondent's information, I have no power to transfer any domain name owned by the Complainant to the Respondent.

## **7. Decision**

As I have not upheld the Complaint I order that no action be taken in respect of the Domain Name.

**Signed Richard Stephens**

**Dated 29 August 2013**