

DISPUTE RESOLUTION SERVICE

D00013184

Decision of Independent Expert

Cash Converters Pty Ltd

and

Oleksiy Pylkin

1. The Parties:

Lead Complainant:

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

Second Complainant:

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

Respondent:

Oleksiy Pylkin
ap.23 Chelyuskintsev str. 36B
Sevastopol
99002
Ukraine

2. The Domain Name(s):

<cashconvertersloans.co.uk>

3. Procedural History:

3.1 The Procedural History of this matter is as follows.

13 August 2013 09:33 Dispute received
13 August 2013 10:06 Complaint validated
13 August 2013 10:30 Notification of complaint sent to parties
02 September 2013 02:30 Response reminder sent
05 September 2013 11:04 No Response Received
05 September 2013 11:04 Notification of no response sent to parties
12 September 2013 12:34 Expert decision payment received

3.2 I have confirmed to Nominet 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.

4. Factual Background

4.1 The Lead Complainant is a wholly owned subsidiary of Cash Converters International Limited (“CCI”), an Australian public company.

4.2 The core business of the CCI is the ownership and franchising of retail and financial services stores, which operate as pawn-brokers.

4.3 The Lead Complainant is the owner of various trade marks around the world that comprise or incorporate the term “Cash Converters”. They include¹:

- (i) Australian registered trade mark 510693 in respect of “pawn-broking” filed on 16 May 1989 and which takes the following form;

¹ The Complainants contend at one point in the Complaint that the listed United Kingdom and Community trade marks are owned by the Second Complainant but this appears to be a typographical error given that elsewhere in the Complaint it claims that Lead Complainant is the owner of the marks. Also exhibits to the Complaint and the online UK and Community trade mark database provided by OHIM and the Intellectual Property Office identify the Lead Complainant as the owner of these marks.



- (ii) United Kingdom trade mark registration No. 1463232 for the word mark CASH CONVERTERS in Classes 35, 36, 39, 42 filed on 2 May 1991 and proceeding to registration on 1 October 1993;
 - (iii) Community trade mark registration No. 001810498 for the word mark CASH CONVERTERS in Classes 9, 35, 36, 38, 39, 41, 42 filed on 15 August 2000 and proceeding to registration on 10 October 2003; and
 - (iv) United Kingdom trade mark registration No. 2588064 for the word mark CASH CONVERTERS in Class 36 filed on 15 July 2007 and proceeding to registration on 25 November 2011.
- 4.4 United Kingdom trade mark registration No. 1463232 is subject to a disclaimer in relation to “the exclusive use, separately, of the words ‘Cash’ and ‘Converters’”.
- 4.5 The Second Complainant is a wholly owned subsidiary of Cash Converters UK Holdings PLC, which in turn is a wholly owned subsidiary of the CCI.
- 4.6 The Second Complainant is the head UK franchisee of the Lead Complainant pursuant to an agreement with the Lead Complainant that allows it to use the Lead Complainant’s CASH CONVERTER trade marks.
- 4.7 The Second Complainant grants sub-franchises to stores operating in the UK under the name and trade mark CASH CONVERTERS. These arrangements are such that all goodwill generated by those stores in that name vests ultimately in the Lead Complainant.
- 4.8 The CASH CONVERTERS business consists of over 600 stores in 21 countries worldwide. Its UK operation began in 1991 with the opening of its first store in Gant’s Hill, Essex. There are currently over 200 stores operating in the United Kingdom.
- 4.9 The Complainants’ marks and business have been extensively promoted in the United Kingdom in various ways. During the year ending 30 June 2012 the Complainants spent in excess of approximately £1,970,000 in the UK

on advertising and promotional activities, which included TV advertising, conference advertising and other online and offline advertising.

- 4.10 In 2011 CCI reported turnover of over Australian Dollars 186 million and a net profit of Australian Dollars 27 million. Over the past five years the Complainant's UK revenue has increased from approximately £15 million to £51 million.
- 4.11 The Second Complainant is also the owner of the following domain names:
- <cashconverters.co.uk> (registered in 1997)
 - <cash-converters.co.uk> (registered in 1998)
 - <cashconverters.net> (registered in 2010)
- 4.12 The Complainants' UK activities are promoted from a website operating from the <cashconverters.co.uk> domain name.
- 4.13 The Domain Name was registered on 1 October 2012. It is registered in the name of what appears to be an individual with an address in the Ukraine.
- 4.14 Prior to the commencement of these proceedings the Domain Name was being used for a website in English which appeared to offer pay day loans in pounds sterling under the name "SpeedyPayDayLoans". That website is no longer operating at the date of this decision. Instead the Domain Name is being used to display what appears to be a page of "pay per click" advertisements.

5. Parties' Contentions

- 5.1 The Complainants refer to the various registered trade marks incorporating or comprising the term "Cash Converters" that are described in the Factual Background section of this decision. They also claim unregistered trade mark rights under the common law in that term in the United Kingdom.
- 5.2 The Complainants claim that since the Domain Name incorporates the trade mark CASH CONVERTERS in its entirety in combination with the descriptive term "loans", the Domain Name is identical, alternatively similar, to that mark.
- 5.3 The Complainants contend that the Respondent would have been well aware of the CASH CONVERTERS marks prior to registration given their extensive promotion. They also claim that the Respondent would have been aware of the Complainants' rights had he conducted a search of the relevant trade mark registers or by conducting an internet search in respect of the term "cash converters".
- 5.4 The Complainants submit that when the Domain Name was registered it was done with the intention of diverting internet users to the Respondent's competing business (either via a search engine or because those users would guess the relevant URL). They contend that it may or may not be apparent on arriving at the web page operating from the Domain Name

that the “SpeedyPayDayLoans” website is not associated with the Complainants, but that nevertheless “the Internet user will still have been deceived”.

- 5.5 Given this the Complainants contend that the Respondent is riding on the coat tails of the well-known reputation and goodwill of the CASH CONVERTERS trade marks for the Respondent’s commercial gain. Such activity is claimed to be disruptive of the Complainants’ business.
- 5.6 The Complainants further put forward evidence and argument to the effect that the Domain Name is not generic or descriptive. They also contend that the Respondent has no rights or legitimate interests in the Domain Name.
- 5.7 The Respondent did not file any submission in response.

6. Discussions and Findings

- 6.1 To succeed under Nominet’s Dispute Resolution Policy (the “Policy”), the Complainants must prove on the balance of probabilities: first, that they have Rights in respect of a “name or mark” that is identical or similar to the Domain Name (paragraphs 2(a)(i) of the Policy); and, second, 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.”*
- 6.3 Given that no Response was filed in this case the Complainants could have elected to have this matter decided by means of a summary decision. However, they are entitled to call for a full decision and have done so. This is notwithstanding that the issues in this case are straight forward and can be relatively rapidly disposed of.
- 6.4 I accept that the Complainant has a number of trade marks that incorporate and comprise the terms “Cash Converters”. There are at least three trade marks that comprise the words “Cash Converters” alone.
- 6.5 The Domain Name can only be sensibly read as the term “Cash Converters” in combination with the word “loans” and “.co.uk”. Accordingly, the Domain Name reproduces in their entirety each of these three marks. One of these

marks is subject to a disclaimer, but this makes no difference given that disclaimer obviously does not extend to the reproduction of the mark as a whole.

- 6.6 As the Domain Name also contains the word “loans” and “.co.uk”, I do not accept the Complainants’ claim that the Domain Name is identical to any of these trade marks. However, these additions do not detract from the fact that “Cash Converters” remains a significant, and possibly the most significant, part of the Domain Name. Given this, each of the three CASH CONVERTERS trade marks is “similar” to the Domain Name. The Complainants have, therefore, satisfied the requirements of paragraph 2(a)(i) of the Policy.
- 6.7 In light of that finding, it is not necessary to consider the Complainants’ claims by reference to common law rights.
- 6.8 The Complainants have provided a comprehensive description together with supporting evidence of the Complainants’ extensive activities in the United Kingdom by the time that the Domain Name was registered. There is also the fact that the website that operated from the Domain Name offered services in direct competition to those of the Complainants and those competing services are directly referenced by the use of the words “loans” in the Domain Name itself.
- 6.9 When these facts are considered together, the only sensible conclusion is that the Domain Name was chosen both with the knowledge of the Complainants’ business and with the intention of taking advantage of a similarity between the Domain Name and the Complainants’ CASH CONVERTERS mark in order to divert internet traffic to the Respondent’s website.
- 6.10 I also accept that it does not matter if it is clear to those internet users when they reach the website operating from the Domain Name that the website is not one that is associated with the Complainants. This is a case where the Domain Name of itself suggests a connection with the Complainant that does not exist. The Respondent is relying upon that suggestion to draw persons to his website. By the time they reach the website the damage is already done.
- 6.11 The Complainants contend that such activity unfairly disrupts the business of the Complainants. It seems to me this is more likely to constitute circumstances “indicating 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 Complainant” within the meaning of paragraph 3(a)(ii) of the Policy. However, regardless of how it is classified, the registration and use of the Domain Name in this case took unfair advantage of the Complainants’ Rights. Accordingly the Complainants have made out the requirements of paragraph 2(a)(ii) of the Policy.

6.13 This is sufficient for the Complainants to succeed. The Complainants also claim that the Respondent has no rights or legitimate interests in the Domain Name. However, that is language that comes from and form part of the test that applies in the case of domain name disputes under the UDRP. It does not form part of the Policy.

7. Decision

7.1 I find that the Complainants have Rights in the CASH CONVERTERS mark, which is identical or similar to the Domain Name, and that the Domain Name, in the hands of the Respondent of the Domain Name, is an Abusive Registration.

7.2 The Complainants appear to seek the transfer of the Domain Name to the Second Complainant. I, therefore, determine that the Domain Name should be transferred to Cash Converters (UK) Ltd.

Signed
Matthew Harris

Dated 9 October 2013