

DISPUTE RESOLUTION SERVICE

D00013401

Decision of Independent Expert

Linguaphone Group (LG&DE Ltd)

and

EACC t/a Whois Proof LLP

1. The Parties:

Complainant: Linguaphone Group (LG&DE Ltd)
Liongate Enterprise Park
80 Morden Road
London
CR4 4PH
United Kingdom

First Respondent: EACC t/a Whois Proof LLP
PO Box 4120
Portland
OR
97208-4120
United States

Second Respondent: The Arabian Company for Development and Project
Management (EACC)
117 Ahmed Shawky Street
Mohammed Mahfouz Tram Station
Roushdy
Alexandria
Egypt

2. The Domain Name(s):

linguaphone-egypt.co.uk ("the Domain Name").

3. Procedural History:

The Complaint was submitted to Nominet on 10 October 2013. On 11 October 2013, Nominet validated the Complaint and notified it to the Respondent. The Respondent was informed in the notification that it had 15 working days, that is, until 1 November 2013 to file a response to the Complaint.

The Respondent did not file a response and the case did not proceed to the mediation stage. On 6 November 2013, the Complainant paid the fee for an expert decision. On 11 November 2013, Andrew D S Lothian, the undersigned, ("the Expert") confirmed to Nominet that he was independent of each of the parties and that to the best of his knowledge and belief there were no facts or circumstances, past or present, or that could arise in the foreseeable future, that need be disclosed as they might be of such a nature as to call into question his independence in the eyes of one or both of the parties. Nominet duly appointed the Expert with effect from 11 November 2013.

4. Outstanding Formal/Procedural Issues

The Expert notes that the Domain Name in this case is registered in the name of a proxy registrant or so-called "WHOIS privacy service". Paragraph 1 of the Policy defines the Respondent as "the person (including a legal person) in whose name or on whose behalf a Domain Name is registered". Clearly, in the present case, this definition is capable of encompassing both the privacy service and any underlying registrant on whose behalf the Domain Name was registered. As noted in the Factual Background section below, the Complainant believes that the underlying registrant is its former licensee for the territory of Egypt, The Arabian Company for Development and Project Management ("ACDPM").

On the balance of probabilities, the Expert accepts the Complainant's contention as to the identity of the underlying registrant for two reasons. First, it is clear that the Complainant was in correspondence with the ACDPM as part of the termination process of its licence wherein the Complainant refers to the registration of the Domain Name and asks that this be terminated. Secondly, it is clear to the Expert that the operator of the website to which the disputed domain name is currently pointed is associated with the ACDPM in that the website contains a copyright statement referring to

"Notting Hill College", an entity which is linked to the ACDPM via the email address to which the Complainant issued its post-termination instructions.

In light of the above, the Expert will treat the ACDPM as the person on whose behalf the Domain Name was registered and thus as the Respondent in this case. The Expert is satisfied that Nominet has notified the Complaint to the Respondent (as distinct from the WHOIS privacy service which was also notified) by email to an address provided by the Complainant, in accordance with paragraph 2(a)(iii) of the Procedure. The Respondent has failed to submit a response to Nominet in time in accordance with paragraph 5(a) of the Procedure.

Paragraph 15(b) of the Procedure provides *inter alia* that "If in the absence of exceptional circumstances, a Party does not comply with any time period laid down in the Policy or this Procedure, the Expert will proceed to a Decision on the complaint."

Paragraph 15(c) of the Procedure provides that "If in the absence of exceptional circumstances, a Party does not comply with any provision in the Policy or this Procedure or any request by us or the Expert, the Expert will draw such inferences from the Party's non compliance as he or she considers appropriate."

In the view of the Expert, if the Respondent does not submit a response, the principal inference that can be drawn is that the Respondent has simply not availed itself of the opportunity to attempt to demonstrate that the Domain Name is not an Abusive Registration. This does not affect the primary requirement upon the Complainant, on whom the burden of proof rests, to demonstrate Abusive Registration, nor does it in the Expert's view entitle an expert to accept as fact all uncontradicted assertions of the Complainant, irrespective of their merit.

5. Factual Background

The Complainant, LG & DE Limited, is a company incorporated under the laws of England and Wales which supplies language teaching materials using self study techniques. The Complainant is part of the Linguaphone Group of companies, which can trace its history and that of the "Linguaphone" brand, via predecessors in title, to 1901. The Complainant is the proprietor of European Community registered trade mark no. 1228808 for the word mark LINGUAPHONE, registered on 7 August 2000 in international classes 9, 16 and 41.

In terms of a Distribution Agreement, an extract of which was provided with the Complaint, the Complainant licensed the right to provide its language teaching materials to an exclusive distributor for the United Kingdom. The

said distributor has the exclusive right to use the <linguaphone.co.uk> domain name to market the Complainant's products.

The Domain Name was registered on 12 June 2008. As noted in the preceding section, the registrant of the Domain Name is a WHOIS privacy service however the Complainant believes that the underlying registrant is an entity named The Arabian Company for Development and Project Management ("ACDPM"). The ACDPM was the Complainant's former licensee in respect of the territory of Egypt in terms of a Master Licence Agreement dated 1 July 2006. The Master Licence Agreement was terminated by notice of termination dated 4 January 2013. On 25 January 2013, the Complainant's Head of Business Development wrote to Ahmed Zaki of the ACDPM by email outlining practical steps which the Complainant wished the ACDPM to take to ensure compliance with the post-termination provisions of the Master Licence Agreement. These steps included ceasing to use the LINGUAPHONE trade marks with immediate effect and taking down the website at the Domain Name and transferring the Domain Name to the Complainant.

As at the date of this Decision, the Domain Name pointed to a website entitled "Think English" which offered English language training courses. The said site appeared to be operated by an entity named Notting Hill College. For the reasons outlined in the preceding section, Notting Hill College appears to the Expert to be associated with the ACDPM.

6. Parties' Contentions

Complainant

The Complainant contends that it has Rights in its LINGUAPHONE registered trade mark and that the Domain Name in the hands of the Respondent is an Abusive Registration because it continues to take unfair advantage of and to be unfairly detrimental to the Complainant's Rights.

The Complainant submits that the Domain Name uses the popularity of the Linguaphone brand to promote directly competitive services and to falsely create the impression that the Respondent is the Complainant's legitimate representative in Egypt.

The Complainant states that the Respondent was at one time the Complainant's legitimate representative in Egypt and narrates the circumstances by which the corresponding licence was terminated. The Complainant adds that it has licensed a third party to exploit its rights in the territory of Egypt and has made the Respondent aware of this. The Complainant provides evidence showing that its new licensee has contacted the Complainant stating among other concerns that the Respondent is continuing to use the Linguaphone name within the Domain Name and adding

that "...this is a completely destroying factor to the Linguaphone operation in Egypt."

The Complainant also produces evidence in the form of a letter dated 26 September 2013 from its licensee for the United Kingdom territory raising its concerns about the existence of the Domain Name in the context of the licensee's exclusive rights to use the <linguaphone.co.uk> domain name. The licensee states "I believe that the existence of this other domain will cause confusion in the marketplace, may be damaging to our business and is certainly not in keeping with the terms of our contract that guarantee exclusivity." The Complainant asserts that this letter demonstrates that the Domain Name is causing disruption to its United Kingdom licensee.

Respondent

The Respondent did not file a Response and has not replied to the Complainant's contentions.

7. Discussions and Findings

General

In terms of paragraph 2(b) of the Policy the onus is on the Complainant to prove to the Expert on the balance of probabilities each of the two elements set out in paragraph 2(a) of the Policy, namely that:

- (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

Paragraph 1 of the Policy provides that 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". In the present case, the Complainant has produced evidence that it is the proprietor of European Community registered trade mark no. 1228808 for the word mark LINGUAPHONE. The Expert is satisfied that the Complainant has Rights in this trade mark within the meaning of the Policy.

In comparing the Complainant's mark to the Domain Name, it should be noted that domain names are not case sensitive. As is customary in such comparisons, the first (.uk) and second (.co) levels of the Domain Name are disregarded as being wholly generic. This leaves the Expert on the one hand

with the LINGUAPHONE mark and on the other with "linguaphone-egypt". The Expert notes that the Complainant's LINGUAPHONE mark is incorporated in its entirety in the Domain Name along with a hyphen and the word "Egypt". The Expert is satisfied that the latter is merely a geographic descriptor which is generic in nature. The hyphen acts as a separator between the two elements and is of no particular consequence. Accordingly, the Expert finds that the LINGUAPHONE mark is the primary and dominant element of the Domain Name.

In these circumstances, the Expert finds that the Complainant has proved to the satisfaction of the Expert that it has Rights in a name or mark which is similar to the Domain Name.

Abusive Registration

Paragraph 1 of the Policy defines "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;*

This general definition is supplemented by paragraph 3 of the Policy which provides a non-exhaustive list of factors which may be evidence that the Domain Name is an Abusive Registration. Paragraph 4 of the Policy provides a similar non-exhaustive list of factors which may be evidence that the Domain Name is not an Abusive Registration.

In the present case, the Complainant asserts that the Domain Name is being used by the Respondent in a manner which takes unfair advantage of and is unfairly detrimental to the Complainant's Rights.

The Complainant's contentions focus on the fact that the Respondent has pointed the Domain Name to a website featuring competitive products to those of the Complainant and that this use is likely to confuse people or businesses into believing that the Domain Name is authorised by the Complainant, effectively a submission in terms of paragraph 3(a)(ii) of the Policy. The Complainant's position is supported by the concerns which have been expressed to it in correspondence by its licensees for the United Kingdom and Egypt territories, both of whom believe that the Domain Name interferes with their respective exclusive rights.

Paragraph 3.3 of the Expert Overview provides a helpful discussion on the meaning of paragraph 3(a)(ii) of the Policy. It states in part:-

"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"?"

The Expert considers that in the present case, the answer to that question is undoubtedly "yes". The Expert notes that the Domain Name contains the Complainant's distinctive LINGUAPHONE mark with a geographic descriptor, such that Internet users would reasonably expect the website to which the Domain Name points to be either that of the Complainant or a suitably authorised entity for Egypt such as one of the Complainant's licensees. In consequence, the Expert considers that the Domain Name itself is inherently likely to lead to confusion. Such confusion is exacerbated by the associated website, given that if Internet users are drawn there by the attractive force of the LINGUAPHONE mark, they will find language training courses on offer which are similar yet competitive to those of the Complainant.

The Respondent has chosen not to respond to the Complaint and thus has neither answered the Complainant's contentions nor provided any explanation for its use of the Domain Name. The Expert is satisfied that none of the circumstances disclosed in paragraph 4 of the Policy apply to the facts of this case and cannot conceive of any other factors which might be evidence that the Domain Name is not an Abusive Registration.

Accordingly, the Expert finds that the Complainant succeeds in its argument that the Domain Name is an Abusive Registration based upon its submissions and uncontested evidence relating to paragraph 3(a)(ii) of the Policy.

8. Decision

The Expert finds that the Complainant has proved that it has Rights in a name or mark which is identical to the Domain Name and that the Domain Name, in the hands of the Respondent, is an Abusive Registration. The Expert therefore directs that the Domain Name be transferred to the Complainant.

Signed

Dated 28 November, 2013

Andrew D S Lothian