

**DISPUTE RESOLUTION SERVICE**

**D00013433**

**Decision of Independent Expert**

**Cash Converters Pty Ltd**

and

**Mr Roy Lee**

**1. The Parties:**

First Complainant: Cash Converters Pty Ltd  
Level 18, Chancery House  
37 St Georges Terrace, Perth  
WA 6000  
Australia

Second Complainant: Cash Converters (UK) Ltd  
Unit 17  
Gentlemens Field, Windmill Road  
Ware  
Hertfordshire  
SG12 0EF

(together the “Complainants”)

Respondent: Mr Roy Lee  
Hebeitangshan, Yanjingxiaoqu  
Tangshan  
Hebei  
063000  
China

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

www.cashconverters.co.uk (the “Domain Name”)

### **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 such a nature as to call in to question my independence in the eyes of one or both of the parties.

16 October 2013 14:56 Dispute received  
16 October 2013 15:18 Complaint validated  
16 October 2013 15:22 Notification of complaint sent to parties  
04 November 2013 01:30 Response reminder sent  
07 November 2013 10:03 No Response Received  
07 November 2013 10:03 Notification of no response sent to parties  
19 November 2013 01:30 Summary/full fee reminder sent  
19 November 2013 14:50 Expert decision payment received

### **4. Factual Background**

- 4.1 The First Complainant is an Australian company and the owner of a number of trade marks including Community Trade Mark number 001810498 for the word mark CASH CONVERTERS, which was filed on 15 August 2000, a UK Trade Mark number 1463232 for the word mark CASH CONVERTERS, which was filed on 2 May 1999 and a UK Trade Mark number 2588064 for the word mark CASH CONVERTERS, which was filed on 15 July 2011. The First Complainant is a wholly owned subsidiary of Cash Converters International Limited, an Australian public company.
- 4.2 The Second Complainant is authorised by the First Complainant to use the above trade marks within the United Kingdom (excluding Scotland), the Channel Islands and the Isle of Man in relation to its business as the head UK franchisee for the First Complainant. The Second Complainant is a wholly owned subsidiary of Cash Converters UK Holdings PLC which in turn is a wholly owned subsidiary of Cash Converters International Limited.
- 4.3 The Second Complainant is the registrant of the domain name cashconverters.co.uk which promotes the Second Complainant's services. The domain name was registered on 13 November 1997.
- 4.4 The Respondent is an individual based in China who registered the Domain Name on 8 August 2013.
- 4.5 The Domain Name currently points to the website [www.cashlady.co.uk](http://www.cashlady.co.uk) which offers payday loans. It has previously pointed to another website, [www.ineedcash.co.uk](http://www.ineedcash.co.uk), which also offers payday loans.

### **5. Parties' Contentions**

#### **Rights**

5.1 The Complainants contend that they have rights in a name or mark which is similar or identical to the Domain Name for the following reasons:

5.1.1 The First Complainant is the owner of the following UK and Community trade mark registrations including for “financial and financing services including loan services”:

Community trade mark registration No. 001810498 for the word mark CASH CONVERTERS in Classes 9, 35, 36, 38, 39, 41, 42.

United Kingdom trade mark registration No. 1463232 for the word mark CASH CONVERTERS in Classes 35, 36, 39, 42.

United Kingdom trade mark registration No. 2588064 for the word mark CASH CONVERTERS in Class 36.

(the “Trade Marks”)

5.1.2 The Complainants contend that they have used, and continue to use the Trade Marks in connection with the services for which those marks were registered including in particular financial and financing services, including loan services.

5.1.3 The Complainants note that they have successfully contested other domain name complaints including in relation to: cashconverters.eu, cash-converters.co.uk, wwwcashconverters.com, cashconverters.org.uk and cashconvertersloans.co.uk.

### **Identical or Similar to the Domain Name**

5.2 The Complainants contend that the Domain Name incorporates the trade mark CASH CONVERTERS in its entirety and that the domain name is identical to the Trade Marks and would be perceived as services offered by, or in connection with, the Complainants.

5.3 The Complainants contend that the addition of “.co.uk” and the letters “www” do not affect the similarity between the Domain Name and the Trade Marks.

### **Abusive Registration**

5.4 The Complainants contend that the Domain Name is an Abusive Registration for the following reasons:

5.4.1 The Domain Name has been registered and used in a manner which has taken unfair advantage of or is detrimental to the Trade Marks and the Complainants’ common law rights;

5.4.2 the Domain Name is being used in a way which is likely to confuse people into believing that the Domain Name is registered to,

operated or authorised by, or otherwise connected with or endorsed by the Complainants;

- 5.4.3 the Domain Name has been registered for the purpose of unfairly disrupting the business of the Complainants;
- 5.4.4 The Domain Name was registered by the Respondent on 8 August 2013 and was used to redirect to another website offering payday loans under the brand “I NEED CASH” hosted at the address [www.ineedcash.co.uk](http://www.ineedcash.co.uk). The “I NEED CASH” website offers end users payday loans. The “I NEED CASH” domain name is registered to a third party “D&D Marketing Inc.”.
- 5.4.5 The Respondent has deliberately registered the Domain Name to exploit the goodwill and reputation in the CASH CONVERTERS name and Trade Marks. The Respondent has gained an unfair advantage for D&D Marketing Inc (and presumably received compensation from D&D Marketing Inc for doing so) by using the Domain Name to divert traffic from the Complainants business to a commercial website of a competitive business.
- 5.4.6 The Complainants refer to a number of cases relating to unfair disruption of business by diversion of internet users.
- 5.4.7 The Trade Marks have been extensively used and advertised and thus the Respondent would have been aware of the Trade Marks before registering and using the Domain Name and as the Domain Name is confusingly similar to the Trade Marks such use in relation to a competing business cannot be bona fide.
- 5.4.8 The Respondent would have been aware of the Complainants rights if he had carried out a search of the relevant trade mark registries or a search with a search engine using the term “cash converters”.
- 5.4.9 The Respondent’s registration and use of the Domain Name is likely to result in confusion (including initial interest confusion) as to the identity of the entity behind the Domain Name and/or otherwise takes unfair advantage of the Complainants rights/unfairly disrupts the Complainant’s business because:
  - 5.4.9.1 The Domain Name is identical or similar to the Trade Marks.
  - 5.4.9.2 The Respondent’s use of the Domain Name has been in association with the provision of services which are identical or similar to those offered by the Complainants including in relation to pay day loan services and the Trade Marks are registered for, among other things, financial and financing services including loan services and financing services; fund and money transfers; and loans. The

Respondent is leveraging off the Complainants goodwill and reputation.

5.4.10 The Respondent has intentionally attempted to attract for commercial gain internet users to its website by creating a likelihood of confusion with the Complainants Trade Marks; otherwise why would it use the identical/near identical trade mark which has been so heavily marketed in the UK.

5.4.11 It is common for internet users to find websites by way of a search engine or by guessing the relevant url. Internet users are likely to believe that the Domain Name could not sensibly refer to anyone but the Complainants' "cash converters" business. Internet users may visit the website hosted at the Domain Name in the expectation that such website is operated or authored by or otherwise connected with the Complainants and it may not be apparent on arriving at such website that it is not connected with the Complainants.

5.4.12 On drawing the internet user to such a website which advertises services which compete with or are identical or very similar to the Complainants' services the Respondent has taken unfair advantage of the Complainants' rights and the Complainants may also be deprived of a business opportunity by this diversion of traffic.

5.4.13 When the Domain Name was registered it was done with the intention of disrupting the Complainants' businesses by riding on the coat tails of the well known reputation and goodwill of the CASH CONVERTERS Trade Marks for the Respondent's commercial gain.

5.4.14 The Domain Name is not generic or descriptive and the words "cash converters" do not constitute a common phrase and the words have no dictionary meaning. The words have developed their own meaning as a result of the Complainants use of the words as a name for their business. In the alternative, the words "cash converters" have overwhelmingly acquired a secondary meaning referring only to the Complainants business.

5.5 The Respondent has not submitted a response.

## 6. **Discussions and Findings**

6.1 Paragraph 2(a) of Nominet's Dispute Resolution Policy ("the Policy") requires that the Complainants must prove, on the balance of probabilities, 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.*
- 6.2 As a first step I must therefore decide whether the Complainants have Rights in respect of a name or mark which is identical or similar to the Domain Name.
- 6.3 The definition of Rights in the Policy is as follows:
- 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 This has always been treated in decisions under Nominet's DRS as a test with a low threshold to overcome and I think that must be the correct approach.
- 6.5 There can be no doubt that the First Complainant has Rights in the words or mark CASH CONVERTERS in relation to financial and financing services including loan services. The Second Complainant appears, on the balance of probabilities, to have Rights in the same words or mark by virtue of a franchise arrangement with the First Complainant.
- 6.6 The Domain Name also includes the words in which the Complainants have Rights, i.e. the name or mark CASH CONVERTERS in its entirety. Further, it seems to me that the name or mark CASH CONVERTERS is also the dominant or distinctive part of the Domain Name with letters "www" being largely irrelevant in this context. I therefore conclude that on the balance of probabilities the Complainants have Rights in a name or mark which is identical or similar to the Domain Name.

### **Abusive Registration**

- 6.7 Abusive Registration is defined in Paragraph 1 of the Policy 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.*
- 6.8 This definition allows me to consider whether the Domain Name is an Abusive Registration either at the time of registration/acquisition or subsequently through the use that was made of it.
- 6.9 Paragraph 3 of the Policy provides a non-exhaustive list of the factors which may constitute evidence that a Domain Name is an Abusive Registration and Paragraph 4 of the Policy provides a non-exhaustive list of

the factors which may constitute evidence that the Domain Name is not an Abusive Registration.

- 6.10 The Policy provides for the Complainants to prove, on the balance of probabilities, that the Domain Name is an Abusive Registration. The burden of proof is therefore firmly on the Complainants.
- 6.11 In order to make a finding of Abusive Registration it is reasonably common ground amongst Nominet Experts that, in all but a minority of cases, there must be an element of knowledge on the part of the Respondent in the sense that the Respondent must, on some level, be aware of the Complainant's Rights. In some cases where the name in which the Complainant has rights is particularly well known this will be fairly obvious and straightforward while in other cases where the name in which the Complainant has Rights is less well known and/or where there are other meanings or uses which can be made of the name this will require substantial evidence from the Complainant.
- 6.12 The position on knowledge has been summarised by Nominet's Appeal Panel in the earlier case of Verbatim Limited -v- Michael Toth DRS04331 and it is convenient to reproduce the following paragraphs from the Appeal Panel's decision here:

*In this Panel's view the following should be the approach to the issues of knowledge and intent in relation to the factors listed under paragraph 3 of the Policy:*

- a. *First, some knowledge of the Complainant and/or its brands/rights is a pre-requisite for a successful complaint under all heads of the DRS Policy other than paragraph 3(a)(iv) (giving false contact details). The DNS is a first-come-first-served system. The Panel cannot at present conceive of any circumstances under which a domain name registrant, wholly unaware of the Complainant and its Rights, can be said to be taking unfair advantage of or causing unfair detriment to the Complainant's Rights.*
- b. *Secondly, "knowledge" and "intention" are pre-requisites for a successful complaint under all heads of paragraph 3(a)(i) of the Policy. The wording of that paragraph expressly calls for the relevant intent, which cannot exist without the relevant knowledge.*
- c. *Thirdly, "intention" is not a necessary ingredient for a complaint under paragraph 3(a)(ii) of the DRS Policy). The test is more objective than that. However, some knowledge of the Complainant or its name/brand is a pre-requisite.*
- d. *Fourthly, while some knowledge of the Complainant or its name/brand is a pre-requisite for a successful complaint under the DRS Policy (save for a complaint under paragraph 3(a)(iv), knowledge is not of itself conclusive in favour of the Complainant. The Expert/Appeal Panel will still need to be satisfied that the registration/use takes unfair advantage of or is causing unfair detriment to the Complainant's Rights.*
- e. *Fifthly, when a Respondent denies all knowledge of the Complainant and/or its Rights at the relevant time, that denial is not necessarily*

*the end of the matter. The credibility of that denial will be scrutinised carefully in order to discern whether, on the balance of probabilities, the relevant degree of knowledge or awareness was present.*

*Accordingly, in the view of this Panel, for this complaint to succeed, the Complainant must satisfy the Panel, as an opener, that the Respondent was aware of the existence of the Complainant or its brand at the date of registration of the Domain Name.*

- 6.13 The Complainants' case is that the Respondent has used the Domain Name to redirect internet users to websites that compete with the Complainants in relation to payday loan services. This evidence is not challenged by the Respondent who has not filed a Response.
- 6.14 Given that the Respondent has registered a domain name which is similar or identical to the name or mark in which the Complainants have Rights and has used the Domain Name to point to and therefore direct traffic to sites which compete directly with the Complainants' business it seems to me to be very likely indeed that the Respondent was well aware of the Complainants and registered the Domain Name because of that. This is not a case where the name or mark in which the Complainants have Rights is so descriptive that other people may obviously want to adopt it for a particular type of goods and services. Indeed, it is very difficult to think of a plausible explanation as to why the Respondent has legitimately registered the Domain Name and used it in this way.
- 6.15 I am therefore satisfied that on the balance of probabilities the Respondent is acting in a manner which takes unfair advantage of and/or which is unfairly detrimental to the Complainants Rights.
- 6.16 It follows that the Complainants have established, on the balance of probabilities, that the Domain Name is an Abusive Registration. That of course is not the end of the story and I would now normally look at what the Respondent has said in its Response and decide whether the Respondent has rebutted the preliminary finding that the Domain Name is an Abusive Registration. However, in this case, no Response has been submitted and there is nothing further for me to consider.

## **7. Decision**

- 7.1 I find that, on the balance of probabilities, the Complainants have Rights in a name or mark which is identical or similar to the Domain Name and that the Domain Name is in the hands of the Respondent an Abusive Registration. I therefore direct that the Domain Name be transferred to the Second Complainant (given that this is what the Complainants have requested).

**Signed: Nick Phillips**

**Dated 20<sup>th</sup> December 2013**