

DISPUTE RESOLUTION SERVICE

D00015525

Decision of Independent Expert

Cash Converters Pty Ltd

and

kmcashconverters

1. The Parties

Complainants:

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

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

Respondent:

kmcashconverters
3 awolowo street off ikeja
17 azikiwe avenue off ikeja
ikeja
Lagos
023401
Nigeria

2. The Domain Name

<kmcashconverters.co.uk>

3. Procedural History

19 February 2015 16:12 Dispute received
19 February 2015 16:18 Complaint validated
24 February 2015 12:15 Notification of complaint sent to parties
13 March 2015 01:30 Response reminder sent
18 March 2015 11:11 No Response Received
18 March 2015 11:12 Notification of no response sent to parties
26 March 2015 10:12 Expert decision payment received

The Expert has confirmed that he is independent of each of the parties. To the best of the Expert's 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 into question his independence in the eyes of one or both of the parties.

4. Factual Background

The First Complainant is a company registered in Australia which operates and franchises "retail and financial services stores" under the name "Cash Converters". The Second Complainant is the principal UK franchisee of the First Complainant and is responsible for granting sub-franchises of the "Cash Converters" business to other stores operating in the UK.

The First Complainant is the owner of various registrations for the trade mark CASH CONVERTERS including the following:

- Community Trade mark number 001810498 for CASH CONVERTERS, filed on 15 August 2000 in Classes 09, 35, 36, 38, 39, 41 and 42
- UK trade mark number 1463232 for CASH CONVERTERS, filed on 2 May 1991 in Classes 35, 36, 39 and 42

The Second Complainant is authorised to use the First Complainant's trade marks within the UK.

The Domain Name was registered on 4 January 2015.

The Complainant has submitted evidence that, on 19 January 2015, the Domain Name resolved to a website at www.kmcashconverters.co.uk. The website referred to retail and financial services and included a photograph of an individual named as Kelvin Meyers who was stated to be President. The website included numerous references to the term "Cash Converters" (without the prefix "km") in addition to the following footer:

“© 2014 Kmcashconverters (UK) Limited, 312 Walworth Road, Walworth, London SE17 2NA, United Kingdom Tel: + 44 7466638472

A Subsidiary of Cash Converters Reg.No 3096334 Consumer Credit Interim No 626673 BCCA No. 5924”

5. Parties’ Contentions

Complainants

The Complainants provide evidence of numerous registrations for the trade mark CASH CONVERTERS in various territories throughout the world, including the registrations referred to above. The Complainants state that their group business consists of over 700 stores in 21 countries of which 220 operate in the UK, the first UK store having opened in 1991. Their group turnover in 2013 was reported as AUD 272.7 million with UK turnover in excess of £50 million in that year.

The Complainants submit that the Second Complainant is the registrant of the domain name <cashconverters.co.uk> and has operated a website linked to that domain since 1997. The Complainants also provide evidence of substantial advertising, promotional and sponsorship activities within the UK and elsewhere, their UK advertising spend being in excess of £3.5 million in 2014. As a result of these and other matters, the Complainants say that they have established a thriving business and substantial reputation and goodwill in the CASH CONVERTERS name and mark.

The Complainants contend that the Domain Name is confusingly similar to their CASH CONVERTERS trade mark, in that it incorporates the mark in its entirety and that the prefix “km” fails to distinguish it from the Complainants’ mark. The Complainants say that the term “cash converters” is not generic or descriptive and has no meaning in commerce other than to refer to the Complainants and their business.

The Complainants contend that the Domain Name in the hands of the Respondent is an Abusive Registration and has, in particular, been registered and used in a manner that takes unfair advantage of the Complainants’ rights. The Complainants point to the Respondent’s website referred to above and the fact that the Respondent repeatedly refers to itself within that website as “Cash Converters” without the “km” prefix. The Complainants also say that the Respondent has “lifted” significant quantities of text from the Second Complainants’ own website, including the Second Complainant’s “What We Do” and “Corporate Social Responsibility” sections. The Complainants further allege that the website footer referred to above represents a fraudulent misrepresentation: in particular, the Respondent has given the address of one of the Second Complainant’s stores at 312 Walworth Road, London SE17, but with a false mobile phone number. The Respondent also gives the Second Complainant’s UK company registration number, consumer credit number and BCCA number, and falsely claims that it is a subsidiary of the Second Complainant.

The Complainants submit that the Respondent registered the Domain Name, in the knowledge of the Complainant's trademark and business, with the deliberate intention of trading off the Complainant's name and goodwill. In particular, the Complainants submit that it is clear from the Respondent's website that the Respondent has used 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. Alternatively, the Complainants contend that the Respondent registered the Domain Name primarily for the purpose of unfairly disrupting the business of the Complainants by misrepresenting its website as that of the Complainants.

The Complainants seek a transfer of the Domain Name.

Respondent

No Response has been filed by the Respondent in this case.

6. Discussions and Findings

The Complaint falls to be determined according to the Nominet DRS Policy ("the Policy") and the Nominet DRS Procedure. Under paragraph 2 of the Policy:

- "(a) A Respondent must submit to proceedings under the Dispute Resolution Service if a Complainant asserts to [Nominet], according to the Procedure, 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.*
- (b) The Complainant is required to prove to the Expert that both elements are present on the balance of probabilities."*

Under paragraph 1 of the Policy the term "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."

Also under paragraph 1 of the Policy, the term "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."*

Paragraph 3 of the Policy sets out a non-exhaustive list of factors that may be evidence that a domain name is an Abusive Registration. Paragraph 4 of the Policy sets out a non-exhaustive list of factors that may be evidence that it is not an Abusive Registration. However, all such matters are subsidiary to the overriding test for an Abusive Registration as set out as in paragraph 1 of the Policy.

Rights

The Complainants have established that the First Complainant is the proprietor of trade mark registrations for the mark CASH CONVERTERS in numerous territories throughout the world and that the Second Complainant is licensed to use the trade mark CASH CONVERTERS within the UK.

The Complainants have also established to the satisfaction of the Expert that, by virtue of extensive use of the name and mark CASH CONVERTERS in the course of business in the UK for many years, and significant advertising and promotion of the Complainant's business under that name and mark, the Complainants are the owners of substantial reputation and goodwill attaching to the CASH CONVERTERS name and mark. The Expert finds that, while the individual terms "cash" and "converters" may be generic or descriptive on their own, their use in combination as the name "Cash Converters" has clearly become distinctive of the Complainants and their business over a significant period of trading.

The Domain Name comprises the two letters "km", the whole of the term "cashconverters", which is effectively identical to the Complainant's trade mark, and the formal suffix ".co.uk" which is typically to be disregarded for the purposes of paragraph 2(a)(i) of the Policy. In the view of the Expert, the term "cashconverters" represents the dominant part of Domain Name and the letters "km" do not serve to distinguish the Domain Name from the Complainants' trade mark. Accordingly, the Expert finds that the Complainants have Rights in respect of a name or mark which is similar to the Domain Name and the first limb of the test under paragraph 2(a) of the Policy is satisfied.

Abusive Registration

The Expert has considered the Complainants' evidence concerning the Respondent's website and notes that the Respondent has filed no Response in this claim and has made no attempt to refute the Complainants' allegations. It is clear to the Expert that the Respondent's website constitutes an attempt to impersonate the Complainants and to misrepresent to the public, for commercial gain, that the Respondent's website is in fact operated by the Complainants or is in some way authorised by or connected with the Complainants. Apart from the Respondent's references to the term "Cash Converters" (without the prefix "km") and the reproduction of material taken from the Complainants' own website, it appears to the Expert that the information contained in the Respondent's website footer can only be intended fraudulently to represent the Respondent as, or as a company connected with, the Second Complainant. The Expert readily infers from this that the Respondent registered and has used the Domain Name in the full

knowledge of the Complainants' trade mark CASH CONVERTERS, and of the Complainants' rights in that name and mark, with the intention of dishonestly profiting from the Complainant's goodwill.

In the circumstances, the Expert finds that the Respondent has used 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 Complainants (paragraph 3(a)(ii)) of the Policy and that the Domain Name in the hands of the Respondent is an Abusive Registration. The second limb of the test under paragraph 2(a) of the Policy is therefore satisfied.

7. Decision

The Complainants have established that they have Rights in respect of a name or mark which is similar to the Domain Name and that the Domain Name in the hands of the Respondent is an Abusive Registration. Accordingly the Complaint succeeds and the Expert directs that the Domain Name, <kmcashconverters.co.uk>, be transferred to the Complainants.

Signed: Steven A. Maier

Dated: 14 April 2015