

DISPUTE RESOLUTION SERVICE

D00015869

Decision of Independent Expert

Cash Converters Pty Ltd

and

Sonexo B.V.

1. The Parties:

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

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

Respondent: Sonexo B.V.
Postbus 178
IJsselstein
Utrecht
3400AD
Netherlands

2. The Domain Name(s):

cash-converters.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.

11 May 2015 10:47 Dispute received
11 May 2015 12:35 Complaint validated
11 May 2015 12:46 Notification of complaint sent to parties
29 May 2015 02:30 Response reminder sent
02 June 2015 14:13 Response received
02 June 2015 14:13 Notification of response sent to parties
05 June 2015 02:30 Reply reminder sent
09 June 2015 13:59 Reply received
09 June 2015 14:01 Notification of reply sent to parties
09 June 2015 14:01 Mediator appointed
12 June 2015 14:40 Mediation started
12 June 2015 15:29 Mediation failed
12 June 2015 15:32 Close of mediation documents sent
24 June 2015 02:30 Complainant full fee reminder sent
26 June 2015 12:14 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 for the mark, CASH CONVERTERS, registered in various jurisdictions around the world. The First Complainant is the owner of a number of top-level and second-level domains, all of which contain the words “cashconverters”.
- 4.2 The Second Complainant is a company registered in England and Wales. It is the owner of a number of UK and Community Trade Mark registrations for the word mark CASH CONVERTERS. The Second Complainant is the owner of a number of second-level domain names, including the domain name cashconverters.co.uk.
- 4.3 Both the First and Second Complainants’ parent company is an Australian public listed company called, Cash Converters International Limited which reported a turnover of over 186 million Australian dollars and a net profit of 27.6 million Australian dollars across its businesses (which included the businesses run by the First and Second Complainants) in 2011.
- 4.4 The core business of both Complainants is the retail of second hand goods and the supply of financial products including loans which is done under the name Cash Converters.
- 4.5 The Second Complainant is the head UK franchisee of the First Complainant and as such the Second Complainant is entitled to use the

Cash Converters brand in the UK and to grant sub-franchises across the UK.

- 4.6 Cash Converters stores have operated in the UK since 1991 and subsequently the name Cash Converters has been extensively advertised and promoted through online and off line advertising which has included the sponsorship of Premiership and Scottish Premier League football teams as well as a number of other well known sporting events.
- 4.7 The Respondent is a Dutch based online publishing company¹.
- 4.8 The Respondent registered the Domain Name on 11 October 2014. It is currently pointed towards a parking page which also contains a number of sponsored links for payday and other forms of loans.

5. Parties' Contentions

Complainants' submissions

Rights

- 5.1 The Complainants contend that they have rights in a name or mark which is similar or identical to the Domain Name, based upon the following submissions:
 - 5.1.1 The Complainants are between them the owners of a large number of trade mark registrations around the world for the mark CASH CONVERTERS. These registrations include UK and Community Trade Mark registrations for the word mark CASH CONVERTERS.
 - 5.1.2 The Complainants have used, and continue to use, the mark CASH CONVERTERS in connection with loan and related services and have been for a considerable period of time in a substantial way of business under the mark CASH CONVERTERS.
 - 5.1.3 The Complainants own and use a large number of domain names which contain the words "cashconverters".
 - 5.1.4 The Complainants have successfully contested other domain name complaints in relation to other domain names which consist of or include the words, "Cash Converters". Examples include, "cashconverters.org.uk", "cashconverters.org", "cashconverters.eu" and "www.cashconverters.co.uk" to name but a few.

¹ Note that in the Response the Respondent identifies itself as being called Nettalk and not Sonexo BV as identified in the Complaint. It is however likely that Nettalk is a trading name for Sonexo BV.

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 with the addition of a hyphen which it is submitted is an insignificant addition that should be disregarded. Alternatively, the Complainants submit that the Domain Name is highly similar to the mark CASH CONVERTERS and would inevitably be perceived as being used in relation to services offered by, or in connection with, the Complainants. This similarity is not removed by the addition of the non-distinctive hyphen which is in any event commonly used in domain names.

Abusive Registration

- 5.3 The Complainants contend that the Domain Name is an Abusive Registration, based upon the following submissions:

5.3.1 The Domain Name has been registered and is being used in a manner which took (and continues to take) unfair advantage of or was (and continues to be) unfairly detrimental to the Complainants' Rights.

5.3.2 The Domain Name is being used in a way which 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.

5.3.3 The Domain Name was registered for the purpose of unfairly disrupting the business of the Complainants.

5.3.4 The Domain Name resolves to a parking page incorporating advertising links and related links. When internet users arrive at the page they may click on the advertising links which divert them to competitors of the Complainants, as a result of which the Respondent will earn pay-per-click revenue.

5.3.5 The Complainants rely on the doctrine of initial interest confusion on the basis that internet users will visit the site to which the Domain Name points either by way of using search engines or by guessing the relevant URL. In such cases, the speculative visitor to the Registrant's website will be visiting it in the hope and expectation that the website is a website operated or authorised by, or otherwise connected with, the Complainants. In this instance the advertising links on the parking page are in the field of the Complainants' activities and for services under the mark for which it has acquired both registered and common law rights. There is a severe risk that internet users will be deceived into believing the site is operated or authorised by, or otherwise connected with the Complainants, after which they may be diverted to a third party site offering competitive services to the Complainants. This will unfairly disrupt the Complainants'

business and the Respondent will gain an unfair commercial advantage by means of the revenue related to the pay-per-click advertising.

- 5.3.6 The likelihood of confusion is exacerbated by the fact that the webpage to which the Domain Name links also shows related links which include “Cash Converters”. Clicking on this link simply redirects back to the Domain Name with new advertising links, again for services which conflict and are in competition with those of the Complainants.
- 5.3.7 Because of the extensive advertisement and use of the Complainants’ marks the Respondent would have been well aware of the Cash Converters name before registering and using the Domain Name. It should be inferred, say the Complainants, that the Respondent possessed the requisite knowledge and intention and that it has acted, and continues to act, in a manner which takes unfair advantage of and/or which is detrimental to the Complainants’ Rights.

Lack of legitimate use

- 5.4 The Complainants contend that there is no legitimate reason for the Respondent to have registered or used the Domain Name. The Respondent has no trade mark rights or licence to use the Cash Converters mark and is not commonly known by the name Cash Converters. Further, the Domain Name is not generic or descriptive and even if “Cash Converters” did have an ordinary or dictionary meaning (which the Complainants deny) or the words were descriptive in some other way, the extensive use and promotion of the Cash Converters name and trade mark by the Complainants means that the words “Cash Converters” have overwhelmingly acquired a secondary meaning which refers only to the Complainants’ business. The Respondent’s motivation for registering the Domain Name and using it in such a way was to profit from the extensive reputation and goodwill established by the Complainants in the name Cash Converters.

Respondent’s submissions

- 5.5 In its Response the Respondent makes the following submissions:
 - 5.5.1 It contends that the Domain Name was registered for future use as the Respondent is developing a website on the subject of foreign currency exchange.
 - 5.5.2 The Respondent submits that the Complainants are not known to it and that the Respondent did not know about the Complainants prior to the start of this DRS procedure.
 - 5.5.3 At the time of registration the Domain Name was free and could therefore be registered by anyone.

- 5.5.4 The Domain Name consists of two generic names, namely “Cash” and “Converters”. These two words together are not a unique combination and the combination of the two words has a meaning namely the conversion of cash. This meaning is relevant to the Respondent’s plans of developing a website on the subject of foreign currency exchange which is also about the conversion of cash money from one currency to another.
- 5.5.5 The Respondent therefore submits that in its submission the registration of the Domain Name does not constitute an Abusive Registration.

Reply

- 5.6 In Reply to the Response the Complainants submit as follows:
- 5.6.1 The Respondent makes the barest of assertions that it is developing a website on the subject of foreign currency exchange. It has failed to produce any evidence to support this claim.
- 5.6.2 The Response has been contrived to seek to defeat the Complaint and should be viewed with scepticism. In particular, the Complainants question why there is a notice on the web page offering the Domain Name for sale, if there are legitimate preparations to use the Domain Name. In its submission the Respondent has failed to demonstrate preparations for use in connection with a genuine offering of goods or services as required by the Policy.
- 5.6.3 The mark CASH CONVERTERS is neither descriptive nor generic. It has been registered as a trade mark around the world. In particular the Complainants have both UK and Community Trade Mark registrations which are valid and are to be treated as such.
- 5.6.4 The Complainants have also acquired common law rights through the long-standing and extensive use and marketing of the name, CASH CONVERTERS, and trade marks in which significant reputation and goodwill has been established.
- 5.6.5 Even if the mark CASH CONVERTERS was generic or descriptive (which is denied), the Respondent’s use of the Domain Name has not been fair and it is incumbent on the Respondent to ensure that the Domain Name is not used in a way that takes unfair advantage of or causes unfair detriment to a third party’s rights. The Respondent has failed in this regard by inter alia, the inclusion of third party links on the parking page to which the Domain Name points.

- 5.6.6 The Complainants do not accept that the Respondent did not know of their existence prior to the Complaint. The Complainants refer to the fact that there is a dedicated Netherlands website at the URL www.cashconverters.nl and that there are ten branches of Cash Converters in the Netherlands, including one in Utrecht which is within a nine minute drive of the Respondent's business address. It is therefore highly doubtful that in choosing to register the Domain Name they did not come across one of the Complainants' domain names.
- 5.6.7 The Complainants consider that they have shown on the balance of probabilities that they own Rights in respect of a name or mark which is identical or similar to the Domain Name and that the Domain Name in the hands of the Respondent is an Abusive Registration. The Respondent has failed to show otherwise.

6. Discussions and Findings

6.1 Paragraph 2(a) of Nominet's Dispute Resolution Policy ("the Policy") requires that the Complainant must prove, on the balance of probabilities, that:

6.1.1 *The Complainant has Rights in respect of a name or mark which is identical or similar to the Domain Name; and*

6.1.2 *The Domain Name, in the hands of the Respondent, is an Abusive Registration.*

Rights

6.2 As a first step I must therefore decide whether the Complainant has 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 As noted above the Respondent submits that "The Domain Name consists of two generic names, namely "Cash" and "Converters". These two words together are not a unique combination and the combination of the two words has a meaning namely the conversion of cash". I do not agree with this submission from the Respondent. I do not think that the term "Cash Converters" is necessarily a descriptive term. While I appreciate that it is

made up of the combination of two ordinary English words together they are a fairly unusual combination which does not really have a meaning certainly in the sense that it does not obviously describe a particular service as the Respondent contends. If I am wrong about this, and the name is a descriptive term as the Respondent contends, then it is clear that given the very substantial use that the Complainants have made of this name that its business is now commonly known by the name, "Cash Converters" and that this name has therefore acquired a secondary meaning.

- 6.6 Therefore, on the balance of probabilities, the Complainants have Rights in the words or mark CASH CONVERTERS in relation to financial and financing services including loan services.
- 6.7 The Domain Name includes the words in which the Complainants have Rights, i.e. the name or mark CASH CONVERTERS in its entirety but with the addition of a hyphen between the two words. It is therefore clear that the name or mark CASH CONVERTERS is the dominant or distinctive part of the Domain Name with the hyphen 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

- 6.8 Abusive Registration is defined in Paragraph 1 of the Policy as 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.*
- 6.9 This definition requires 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.
- 6.10 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.
- 6.11 The Policy requires the Complainant to prove, on the balance of probabilities, that the Domain Name is an Abusive Registration. The burden of proof is therefore firmly on the Complainant.

6.12 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.

6.13 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:

6.13.1 *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.*

6.13.2 *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.*

6.13.3 *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.*

6.13.4 *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.*

6.13.5 *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.

- 6.14 In this Complaint the Complainants essentially say that their use of the name or mark CASH CONVERTERS is so widespread and so well known that it is inconceivable that the Respondent did not know about them at the time when it registered or used the Domain Name. I do not think there can be any sensible dispute that the Complainants have made a great deal of use of the name or mark CASH CONVERTERS going back some years. That use has been international and in particular there has been a considerable amount of use in the UK, in Australia and also in Holland, where the Respondent is based.
- 6.15 The nature of the name or mark in which the Complainants have Rights is also a relevant consideration. If that name or mark was very descriptive then it would be more likely that the Respondent had simply happened upon the Domain Name as a good domain name without having any knowledge of the Respondent. Here I do not think it can be said that CASH CONVERTERS is a descriptive phrase and given the Complainants' use of it, I have no difficulty in concluding that the Complainants have on the balance of probabilities made out a prima facie case that the Respondent knew about their Rights at the time at which it registered or used the Domain Name (given that the Domain Name was only registered a few months ago, I think that in this case there is no practical distinction between registration and use).
- 6.16 I would add that this is a case in which the Respondent has filed a Response and I will consider what the Respondent says by way of Response separately. At this stage in this Decision I am therefore making only a prima facie finding that on the balance of probabilities that the Complainants have satisfied me that the Respondent would, at the time at which it registered or used the Domain Name, have been aware of the Complainants Rights.
- 6.17 The Complainant's case on Abusive Registration is put in a number of different ways. These include that the Respondent is using the Domain Name in a way that is likely to confuse people into believing that the Domain Name is registered to, operated or authorised by, or otherwise connected with the Complainants.
- 6.18 Evidence of Abusive Registration may include the following under Paragraph 3(a)ii of the Policy:

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;

- 6.19 The Experts' Overview states in relation to confusion under Paragraph 3(a)ii of the Policy:

...Commonly, Internet users will visit web sites either by way of search engines or by guessing the relevant URL. If the domain name in dispute is identical to the name of the Complainant and that name cannot sensibly refer to anyone else, there is bound to be a severe risk that a search engine, which is being asked for the Complainant, will produce high up on its list the URL for the web site connected to the domain name in issue. Similarly, there is bound to be a severe risk that an Internet user guessing the URL for the Complainant's web site will use the domain name for that purpose.

In such cases, the speculative visitor to the registrant's web site will be visiting it in the hope and expectation that the web site is a web site "operated or authorised by, or otherwise connected with the Complainant." This is what is known as 'initial interest confusion' and the overwhelming majority of Experts view it as a possible basis for a finding of Abusive Registration,...

...In DRS 07991 (toshiba-laptop-battery.co.uk) an aspect which the appeal panel regarded as being indicative of abusive use was the fact that the Respondent was using the domain name featuring the Complainant's trade mark to sell in addition to the Complainant's goods, goods competing with the Complainant's goods.

Findings of Abusive Registration in this context are most likely to be made where the domain name in issue is identical to the name or mark of the Complainant and without any adornment (other than the generic domain suffix)...

- 6.20 In this case the Domain Name contains the name or mark in which the Complainant has Rights with only the addition of a single hyphen. It therefore seems to me that there will be a good chance that potential customers of the Complainant will arrive at the Respondent's site by using the Domain Name (or a url containing the Domain Name). Having done this they will simply leave or go elsewhere having realised that it is not the Complainant's site or they may follow any one of the sponsored links on the page most of which are to sites offering loans or pay day loans. In both scenarios so called "initial interest confusion" would have occurred. In either scenario (absent any defence that the Respondent may have) the Respondent's actions amount to an Abusive Registration.

- 6.21 Given all of the above, the Complainant has established a prima facie case that, on the balance of probabilities, the Respondent is acting in manner which takes unfair advantage of and/or which is unfairly detrimental to the Complainant's Rights. It follows that the

Complainants have prima facie established, on the balance of probabilities, that the Domain Name is an Abusive Registration.

6.22 That is however not by any means the end of the story and I will now go on to look at the arguments put forward by the Respondent to see whether it has successfully answered the prima facie case of an Abusive Registration which the Complainants have established.

6.23 In its Response the Respondent essentially makes the following points:

- It registered the Domain Name for future use in connection with a website on the subject of foreign currency exchange;
- the Respondent did not know anything about the Complainants prior to the start of this DRS procedure;
- the Domain Name is simply a combination of two generic words which has a natural, ordinary meaning, i.e. the conversion of cash. This meaning is relevant to the Respondent's plans of developing a website on the subject of foreign currency exchange which is also about the conversion of cash money from one currency to another.

6.24 As I have said above, paragraph 4 of the Policy sets out a non-exhaustive list of factors which may be evidence that the Domain Name is not an Abusive Registration. The most relevant from this list, for the current purposes, are as follows:

(i) *Before being aware of the Complainants' 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;

(ii) *The Domain Name is generic or descriptive and the Respondent is making fair use of it.*

(e) *Sale of traffic (i.e. connecting domain names to parking pages and earning click-per-view revenue is not of itself objectionable under the Policy). However, the Expert will take into account:*

(i) the nature of the Domain Name;

(ii) the nature of the advertising links on any parking page associated with the Domain Name; and

(iii) that the use of the Domain Name is ultimately the Respondent's responsibility.

- 6.25 At the heart of the Respondent's submissions is its denial of any knowledge of the Complainant or its Rights. For the reasons set out above, the Complainants had made extensive use of the mark in which they have Rights both in terms of the amount of that use and the geographical spread of that use. This casts significant doubt on the credibility of the Respondent's denial.
- 6.26 The situation might have been different if the Complainants were in a much smaller way of business, such that it was conceivable that the Respondent chose the Domain Name because it was a good name to use for a foreign currency exchange business, i.e. a business which was literally concerned with the conversion of cash. However, on the balance of probabilities I have concluded that the significant nature of the Complainants' use, added to the fact that this use clearly extends to the Netherlands where the Respondent is based, makes it almost inconceivable that the Respondent would not have known about the Complainants at the time at which it registered the Domain Name.
- 6.27 For completeness, I should also add that I find it difficult to accept the Respondent's submission that it registered the Domain Name for use in connection with a currency exchange website. The principal reason why I do not accept this is because there is simply no evidence to substantiate what is simply a bare assertion. For the Respondent to make good this submission, I would have expected to see some evidence of its preparations to launch this website/business. No evidence of this nature has been adduced.
- 6.28 It also follows from what I have said previously in this Decision that I do not find that the Domain Name is generic or descriptive, nor do I find that the Respondent is making fair use of it.
- 6.29 On balance I consider that the indications that the Domain Name is an Abusive Registration significantly outweigh those pointing in the other direction. In the circumstances I am satisfied that the Domain Name is, in the hands of the Respondent, an Abusive Registration.

7. Decision

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 is transferred to the Second Complainant (which is what the Complainants have requested in the Complaint).

Signed Nick Phillips

Dated 23 July 2015

