

**DISPUTE RESOLUTION SERVICE**

**D00011016**

**Decision of Independent Expert**

Sat-Elite Ltd / Mr. Stephen Phillimore t/a Sat-Elite

and

Mr. Jamie Davies t/a Sat-Elite.co.uk

**1. The Parties:**

Lead Complainant: Sat-Elite Ltd  
21 First Avenue  
West Molesey  
Surrey  
KT8 2QJ  
United Kingdom

Complainant: Mr Stephen Phillimore, t/a Sat-Elite  
21 First Avenue  
West Molesey  
Surrey  
KT8 2QJ  
United Kingdom

Respondent: Mr. Jamie Davies t/a Sat-Elite.co.uk  
11 Cobham Drive  
Whiteley  
Fareham  
Hampshire  
PO15 7JQ  
United Kingdom

**2. The Domain Name:**

sat-elite.co.uk

### 3. Procedural History:

14 March 2012 03:14 Dispute received  
14 March 2012 08:36 Complaint validated  
14 March 2012 08:37 Notification of complaint sent to parties  
04 April 2012 08:15 Response received  
04 April 2012 08:15 Notification of response sent to parties  
10 April 2012 07:53 Reply received  
10 April 2012 07:55 Notification of reply sent to parties  
10 April 2012 07:55 Mediator appointed  
10 April 2012 11:16 Reply received  
10 April 2012 11:16 Notification of reply sent to parties  
10 April 2012 11:19 Mediator appointed  
10 April 2012 11:49 Mediation started  
10 April 2012 11:49 Mediation failed  
10 April 2012 11:50 Close of mediation documents sent  
16 April 2012 12:07 Expert decision payment received

### 4. Factual Background

In 1987, Mr. Stephen Phillimore entered the UK satellite industry and started using the name Sat-Elite on his business cards. He incorporated the company Sat-Elite Ltd in 1996. It supplies and installs *inter alia* satellite dishes and equipment and television aerials.

On May 9, 1997 Mr. Phillimore registered UK trademark No. 2101446 in Class 35 for advertising services relating to microwave/communications equipment. The mark comprises the words SAT ELITE LTD, with a depiction of a circular dish satellite receptor between the words SAT and ELITE. The Complaint did not include a copy of the registration details, which I ascertained from my own search of the Trade Mark office database.

In 1997, Sat-Elite Ltd provided services to a customer in Whitely, Hampshire and in around 2001 to the same customer in Fareham, Hampshire.

In March, 1998 Sat-Elite Ltd registered the domain name <sat-elite.com>.

The Domain Name was registered on November 18, 2010. It resolves to a website offering digital aerial and satellite installation in Fareham, Southampton, Portsmouth and Winchester. The home page says: "Sat-Elite.co.uk are an established company specialising in the installation and repair of digital television aerials and satellite systems."

On January 27, 2011, the Complainants' trade mark attorneys sent a cease and desist letter to the Respondent alleging trademark infringement. No reply was received to this nor to subsequent correspondence.

## **5. Parties' Contentions**

The Complainants say they have traded under and acquired a reputation in the name 'Sat-Elite'; that the Respondent uses that name on its website and that the Domain Name is promoted on behalf of the Respondent by a number of marketing companies to bring business to the Respondent, directly impinging on the Complainants' business. There has been actual confusion on the part of at least one customer. Sat-Elite Ltd has lost business to the Respondent from clients who, unable to find the Sat-Elite Ltd contact details in their records, searched for that company online and found the Respondent. The Respondent's conduct amounts to trademark infringement and passing off.

The Respondent says he trades only as 'sat-elite.co.uk', not 'Sat-Elite'. The Domain Name is exactly the same as his trading name. The Domain Name was freely available for registration and at the time of registering he had no knowledge of any other similarly named companies after extensive internet research.

The Respondent denies abusive registration, saying he has built up an absolutely fantastic reputation under the brand 'Sat-Elite.co.uk', with feedback from customers rating the business 10 out of 10 on the website [www.checkatrade.com/SatEliteCoUk](http://www.checkatrade.com/SatEliteCoUk), which should be seen before deciding the outcome of this complaint. To award the Domain Name to the Complainants would be in effect to award it the Respondent's entire business and reputation. This complaint is an attempt to hijack the Respondent's business and everything for which he has worked extremely hard. Further, Mr Phillimore's registered trade mark is an image/ logo only mark, which has no bearing on his entitlement to the Domain Name.

In Reply, the Complainants say there has been clear use of the words 'Sat-Elite', and more recently 'Sat Elite', on the Respondent's website. A Wayback archive search at the time of registration would have revealed use of the Complainants' domain name <sat-elite.com> going back to 1999 and the nature of the Complainants' business.

Further, the Respondent was made fully aware of the Complainants' existence in mid-March 2011, which would have given the Respondent a maximum of two months of empire building. His claim of 'reputation' should therefore be viewed from the perspective of an eight week old company, which has since then knowingly traded on the name and reputation of another.

The Checkatrade site indicates that the Respondent has done work within eight miles of the Complainants' business.

## **6. Discussions and Findings**

Under paragraph 2 of the Dispute Resolution Service Policy ("the Policy") a complainant is required to show, on the balance of probabilities, that;

- (1) it has rights in respect of a name or mark which is identical or similar to the Domain Name; and
- (2) the Domain Name in the hands of the Respondent is an Abusive Registration.

“Rights” are defined in the Policy as “rights enforceable by the Complainant, whether under English law or otherwise, and may include rights in descriptive terms which have acquired a secondary meaning”.

### Rights

Although the words ‘sat’ and ‘elite’ are common dictionary words, when used by a trader in connection with the installation of satellite television equipment they are capable of being distinctive, either as a mis-spelling of the word ‘satellite’ or as a combination of an abbreviation of the word ‘satellite’ with the word ‘elite’, being a combination having no clear meaning but perhaps conveying excellence in the field.

Sat-Elite Ltd clearly has rights in its registered company name, which may be enforced in an action for passing off.

The Complaint includes evidence of an order in August, 2010 from a customer addressed to ‘Sat Elite’ and of company letterhead, including invoices dating from 2001, headed ‘SAT-ELITE™ LTD’. I am satisfied that the Complainant Sat-Elite Ltd has, through use, acquired common law rights in the mark SAT ELITE in relation to the supply and installation of satellite dishes and equipment and television aerials.

The Domain Name comprises the words SAT ELITE, a hyphen and the suffix ‘co.uk’. In considering identity or similarity, the hyphen and the suffix may be ignored as inconsequential, as may the word LTD in the company name for the same reason.

Accordingly, I am satisfied that the Domain Name is identical or similar to the common law mark SAT ELITE and to the corporate name Sat-Elite Ltd, in both of which Sat-Elite Ltd has rights.

In light of this finding, it is unnecessary to determine whether the Domain Name is identical or similar to UK registered trademark No. 2101446, in which Mr. Phillimore has rights.

### Abusive Registration

Abusive Registration is defined in the Policy as:

“...a domain name which either;

- (i) was registered or otherwise acquired in the 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(a) of the Policy provides a non-exhaustive list of factors that may be evidence that a domain name is an Abusive Registration. The Complainants rely on factor 3(a)(ii):

"Circumstances indicating that the Respondent is using the Domain Name in a way which has confused people or businesses into believing that the Domain Name is registered to, operated or authorised by, or otherwise connected with the Complainant"

Paragraph 4(a) of the Policy sets out a similar list of factors that may be evidence that a domain name is not an Abusive Registration. The Response calls for consideration of factor 4(a)(i)(A):

"Before being aware of the Complainant's cause for complaint (not necessarily the 'complaint' under the DRS), the Respondent has 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."

The Appeal Panel in DRS 04331 held that '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. Further, that 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.

The Respondent asserts that, at the time of registering the Domain Name he had no knowledge of any other similarly named companies after extensive internet research. On the balance of probabilities, this claim cannot be accepted. Even the most basic internet research would have revealed the domain name <sat-elite.com> and the existence of a company in the UK named Sat-Elite Ltd operating in the very same field the Respondent was about to enter. It is highly improbable that anyone entering a market and choosing a domain name would do so unaware of the names of likely competitors, especially given the ease with which any names similar to the contemplated domain name can be ascertained via the internet. Accordingly, I find that it is more likely than not that the Respondent knew of the existence of the Complainant company when he registered the Domain Name.

The website to which the Domain Name resolves has, at times, prominently displayed the words SAT ELITE, followed by the Domain Name. There is evidence that one customer of the Complainant company, finding the Respondent's website, wondered whether the Complainant company had moved to Fareham

and was thus confused into believing that the Domain Name was registered to, operated or authorised by, or otherwise connected with the Complainant company. Apart from that customer, the Respondent's use of the Domain Name in the very same field of activity and in the same geographic area in which the Complainant company operates is likely to confuse people or businesses into that belief. As mentioned, under paragraph 3(a)(ii) of the Policy, such circumstances may be evidence that the registrations are Abusive Registrations. For such a conclusion to be drawn it is not necessary to find that the Respondent intended this result so long as he had, as I have found, some knowledge of the Complainant company.

Accordingly, I find that the Domain Name has been used in a manner which took unfair advantage of or was unfairly detrimental to the Complainant company's rights. It follows that the Domain Name in the hands of the Respondent is an Abusive Registration.

I have examined the checktrade site mentioned by the Respondent. It is clear that he has provided very satisfactory service to numerous customers and has an established business, founded upon the Domain Name and its promotion. However, that business is likely to have benefited from the similarity of the Domain Name to the Complainant company's corporate name and common law trademark. Under these circumstances the unfairness to the Complainant company must be rectified by the transfer to it of the Domain Name.

## **7. Decision**

I find that the Complainants have proved, on the balance of probabilities, that the Complainant Sat-Elite Ltd has rights in both a company name and a common law trademark which are identical or similar to the Domain Name and that the Domain Name is an Abusive Registration in the hands of the Respondent. I therefore direct that the Domain Name be transferred to Sat-Elite Ltd.

**Signed Alan Limbury**

**Dated May 11, 2012**