

## DISPUTE RESOLUTION SERVICE

D00016121

### Decision of Independent Expert

Look Fabulous Forever Ltd

and

MLSM Ltd

#### 1. The Parties:

Lead Complainant: Look Fabulous Forever Ltd  
113-115 Oyster Lane  
Byfleet  
Surrey KT14 7J2  
United Kingdom

Respondent: MLSM  
98 Harvist Road  
London NW6 6HL  
United Kingdom

#### 2. The Domain Name:

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

19 June 2015 17:29 Dispute received  
23 June 2015 11:59 Complaint validated

23 June 2015 12:18 Notification of complaint sent to parties  
10 July 2015 02:30 Response reminder sent  
14 July 2015 09:34 Response received  
14 July 2015 09:34 Notification of response sent to parties  
17 July 2015 02:30 Reply reminder sent  
20 July 2015 12:44 Reply received  
20 July 2015 12:45 Notification of reply sent to parties  
20 July 2015 12:45 Mediator appointed  
23 July 2015 10:37 Mediation started  
07 August 2015 15:03 Mediation failed  
07 August 2015 15:03 Close of mediation documents sent  
11 August 2015 12:52 Expert decision payment received

#### 4. Factual Background

The Lead Complainant, Look Fabulous Forever Limited is a company selling cosmetics and related services, founded by Tricia Cusden, who is its managing director.

The Respondent (MLSM Consultancy Ltd) is a limited company offering consultancy services. Maya Lyttleton is a director of the company.

Between February and June 2014, a contract was in place for the provision of consultancy services by the Respondent to the Complainant. The invoice for these services was disputed, with a revised invoice being settled on 19 June 2014.

4. The Respondent registered the Domain Name on 20 June 2014. At the time of writing it resolves to a holding page.**Parties' Contentions**

#### Introduction

The Parties' submissions were written in the first person by Ms Cusden and Ms Lyttleton, who clearly represent their respective companies. As will become clear, Ms Cusden is concerned in this dispute in a personal role (because of her name) and as founder and managing director of the Complainant company. Ms Lyttleton too appears as both a director of the Respondent company and the de facto provider of the consulting services which play some part in this dispute. I have referred to the Parties throughout as the Complainant and the Respondent; in the following summary of their submissions these terms will apply to the corporate entities concerned and to the individuals named above as the context dictates.

In addition to the Domain Name, a second registration <triciacusden.com> is referred to in the Complaint. This decision can only concern itself with the Domain Name, but at various points it is hard to avoid mention of "the domain names" in the plural. It should therefore be born in mind that nothing in this summary of the Parties' positions, or the expert's discussion of them which follows, should be interpreted as a view by the expert on the registration of <triciacusden.com>.

#### Complainant

## **Rights**

The Complainant claims rights in the Domain Name based upon the fact that it is her personal name and that she uses this name for business purposes. By way of illustration, the Complainant cites her You Tube channel, on which she offers makeup tutorials to promote the cosmetics business, Look Fabulous Forever, of which she is Managing Director. The Complainant provides evidence of a Community trademark TRICIA CUSDEN registered on 26 December 2014. And refers to a US trademark application for the same name.

## **Abusive Registration**

The Complainant states that in Feb 2014 Ms Cusden sought legal advice about registering her name as a trademark. One week later the Respondent was hired to provide consulting services to the Complainant. Ms Cusden maintains that she told Ms Lyttleton that she had consulted a lawyer about changing the name of the business to Tricia Cusden, but insists that Ms Lyttleton was not asked to carry out work connected to this fact.

The Complainant describes a payment dispute with the Respondent following completion of the contracted work. The Respondent submitted an invoice for 12 days consultancy instead of the 10 days previously agreed. The Complainant disputed the invoice and the Respondent submitted a revised invoice on 19th June. The Respondent registered the Domain Name and its .com equivalent the following day.

The Complainant believes that the Respondent registered these domain names as a vindictive act arising from the disputed invoice. The Complainant learned of the registrations in August 2014 and asked the Respondent to transfer the domain names to her. The Respondent quoted a charge of £2500, explaining that her company had purchased the domain names as part of a 'naming project' and therefore part of the consultancy service that she had provided to the Complainant. The Complainant's solicitor wrote to the Respondent pointing out that the decision to trademark the name was made prior to her involvement with the Complainant's company, so she could not claim that it had been her idea to use the Complainant's name as a trademark. The Complainant felt that the Respondent's reply was very vague and decided not to pursue the matter, hoping that the registrations would lapse after a year so that she could obtain them. The Complainant is now aware that the Respondent renewed the registrations on 12th May 2015.

The Complainant argues that the Respondent bought the domain names in order to gain from knowledge she acquired during the consultancy process that she was likely to change the business name from Look Fabulous Forever as soon as "Tricia Cusden" had been registered as a trademark in Europe and the USA.

## **Respondent**

### **Rights**

The Respondent argues that the Complainant cannot claim rights in her personal name as it is generic and does not give rise to an entitlement to the Domain Name.

The Respondent challenges the Complainant's claim that she uses her name for business purposes. The Complainant does not and did not at the time of registration use the name Tricia Cusden in any capacity other than as her personal name. The business name under which the Complainant trades and the brand which her website and products use is Look Fabulous Forever. All of the Complainant's communication and branding since inception are clearly labelled Look Fabulous Forever. This is also the name clearly displayed on all of her products.

The Respondent points out that the Complainant owns the domain name <www.patriciacusden.co.uk> which is her given name and which she could easily use.

The Respondent argues that the Complainant's trademark TRICIA CUSDEN was applied for two months after the Domain Name registration and in the full knowledge that it had been registered by the Respondent and so does not confer Rights. Nor is the registration of the Domain Name a trademark infringement since it predates the trademark application.

### **Abusive registration**

The Respondent claims to be making fair use of the Domain Name and that the registration was not abusive. The Respondent maintains that the Complainant has not supplied any factual evidence in support of abusive registration.

The Respondent argues that her purchase of the Domain Name does not violate any non-disclosure or like agreement with the Complainant, who has stated that the Respondent bought the Domain Name after the contracted work was completed.

The Respondent states that the Complainant has never owned, used or paid for the Domain Name and had no stated intention of doing so at the time of purchase.

The Respondent denies that her ownership of the Domain Name has interrupted, impinged on or unfairly disrupted the claimant's business.

The Respondent explains that she purchased the Domain Name with the intention of using it fairly, seeing an opportunity for a branded business or as a blog site.

The Respondent denies that the Domain Name was bought for the purpose of selling it. The Respondent states that she has never approached the Complainant to this end and that the Complainant tried to hold her to ransom over the

contracted work, threatening non-payment unless the domain names were transferred.

The Respondent describes how she was approached by Ben Stern, a Director of Look Fabulous Forever Ltd, who tried to engage her in a discussion about the domain names prior to paying a previous and unrelated invoice. The Respondent made clear that she would not enter into this discussion until the work for which she had been contracted was paid for. After giving an assurance that the invoice would be paid, Ben Stern asked what the Respondent would charge for transferring the domain names and was quoted £2500, which the Respondent considered fair, based on her experience of carrying out successful naming projects for other clients.

The Respondent argues that the Complainant has not negotiated purchase of the Domain Name but instead has used bullying tactics to demand its transfer, including threatening legal letters to which she has responded in a timely and reasonable manner.

The Respondent states that she has never claimed to “come up with the idea” as the Complainant alleges, of using her name as a trademark, but argues that consulting on brand naming strategy would constitute chargeable work, as would be the case for any client.

The Respondent responded to the claimant’s solicitor a year ago asking for clarification of the allegation of Abusive Registration but heard nothing from the Complainant or her representatives until receipt of the present complaint.

### **Complainant’s Reply to the Response**

The Complainant exercised its right to submit a Reply to the Response. I refrain from summarising its content as, for the most part, it simply denies the accuracy or truthfulness of each of the Respondent’s points. The main point emphasised in the Reply is that the Respondent must have known of the Complainant’s intention to change its trading name from Look Fabulous Forever to Tricia Cusden and the registration of the domain names was a calculated attempt to take advantage of this knowledge.

## **5. Discussions and Findings**

### **DRS Policy**

Paragraph 2 of the DRS Policy requires that the Complainant must make its case that:

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

*2.a.ii. The Domain Name, in the hands of the Respondent, is an Abusive Registration.*

*Under Paragraph 2.b of the Policy, the Complainant is required to prove to the Expert that both elements are present on the balance of probabilities.*

Paragraph 1 of the DRS Policy defines Rights 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;”*

Elsewhere in Paragraph 1 of the Policy, “Abusive Registration” is defined 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;*

### **Complainant's Rights**

The test for whether a complainant has such rights under paragraph 2.a.i of the DRS Policy is, by general agreement, not intended to be an exacting one. The question is nevertheless complicated in this case, as the Complainant company Look Fabulous Forever Ltd claims rights in the name of a separate legal person, i.e. in the personal name of its founder and managing director, Ms Tricia Cusden. It is unsurprising that Ms Cusden should, for practical purposes, conflate her personal and her legal or directorial identities. For example, the Complainant's submissions, though made in the name of the company, are written in the first person and are very clearly authored by Ms Cusden. Paragraph 1 of the Experts Overview (2013 edition) published by Nominet for the guidance of parties to DRS proceedings discusses this issue as follows:

***1.1 (a) Who should the Complainant be and (b) when is it necessary or appropriate for there to be more than one Complainant?***

*(a) The Complainant should be the owner/licensee of the Rights in the name or mark, which the Complainant contends is identical or similar to the domain name in dispute.*

In the circumstances, it is appropriate to infer that The Complainant company has an implied license from Ms Cusden to make use of her name for business purposes. The Complainant submits evidence of its December 2014 registration of a Community trademark, TRICIA CUSDEN. This registration does confer rights in the name upon the Complainant. The Respondent argues that this registration post-dates the Domain Name registration and amounted to a tactical ploy which cannot endow the Complainant with rights in the name retrospectively. However, the Complainant had a registered trademark in the name at the time of making the Complaint. The trademark is self-evidently identical to the name which forms

the substantive portion of the Domain Name and these two facts suffice to meet the rights requirement.

Having found that the Complainant is in possession of trademark rights in a name identical to the Domain Name, it is not necessary for me to reach a decision on the unregistered rights claimed by the Complainant, or on the Respondent's case in respect of these. However, for completeness, I offer the view that the Complainant's evidence of unregistered rights is not enough to substantiate such a claim.

The Complainant claims unregistered rights in the name Tricia Cusden based on the facts that that the name is uncommon and that it is clearly associated in the public mind with Look Fabulous Forever Ltd.

The Respondent argues that the Complainant cannot claim rights in Ms Cusden's name because it is "generic". I take this to mean that the name is not unique to the person concerned and that it is not associated in the public mind with this individual to the extent that a secondary meaning attaches to it. The Complainant does argue that the name is unusual, but offers no proof or means of measuring whether or not this is an accurate statement. There may be other grounds for a private individual to claim unregistered rights in their name but the Complainant does not explore any of these possibilities.

The Respondent also argues that a person's name cannot automatically entitle that person to each and every domain name which uses that name. This is correct and the Complainant does not argue otherwise.

More pertinently, the Complaint argues that the name is closely linked to the her business and that all marketing activities refer to Ms Cusden by name and associate this name with Look Fabulous Forever products and services. Regrettably, the evidence in support of this argument is very slight. In its Reply to the Response, the Complainant states

*4. Whilst all branding is labelled Look Fabulous Forever, communications via twitter, You Tube, Facebook and Mailchimp are always personalised and clearly come from Tricia Cusden*

The evidence supporting this statement consists of a single You Tube screen shot. This contains an image of an unidentified person (whom I take to be Ms Cusden) and a stylised version of the Complainant's trading name, "Look Fabulous Forever" in the top left hand corner. Does this screenshot amount to evidence that "Tricia Cusden" is the name under and by reference to which the Complainant company conducts a trade or business? I do not think it does. DRS Experts are not obliged or expected to conduct their own investigations by, for example, visiting websites or social media pages. It is up to the Complainant to make its case and I am not persuaded that the evidence submitted is sufficient for this purpose.

However, by virtue of its registered trademark TRICIA CUSDEN, I find that the Complainant has rights in a name identical to the Domain Name, discounting the .co.uk suffix.

## Abusive Registration

Paragraph 3.a. of the DRS Policy sets out a non-exclusive list of factors which may be evidence that the Domain Name is an Abusive Registration, as follows:

*i. Circumstances indicating that the Respondent has registered or otherwise acquired the Domain Name primarily:*

*A. for the purposes of selling, renting or otherwise transferring the Domain Name to the Complainant or to a competitor of the Complainant, for valuable consideration in excess of the Respondent's documented out-of-pocket costs directly associated with acquiring or using the Domain Name;*

*B. as a blocking registration against a name or mark in which the Complainant has Rights; or*

*C. for the purpose of unfairly disrupting the business of the Complainant;*

*ii. 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;*

Paragraph 3.a.i above addresses the behaviour of the Respondent at the moment of registration. It is not disputed that the Respondent registered the Domain Name the day after a dispute between that Parties had been brought to an ill-tempered end. The Complaint alleges that the Respondent's motives and behaviour in registering the Domain Name are in line with sub-paragraph A above. However, very little evidence is adduced in support of either side, leaving little except the conflicting assertions of the Parties. Each side offers a plausible version of the discussion during which a price of £2500 is placed upon transfer of the domain names. The Complainant alleges that the Respondent demanded this price to transfer the domain names. The Respondent says that she made no attempt to sell the names, but mentioned this sum when asked by a director of the Complainant how much she would charge during a wider discussion concerning an earlier unpaid invoice. The Respondent explains that the basis of the £2500 price tag was her customary charge rate for work involving company name changes. The Complainant asserts that this was a vindictive move by someone whose invoice had been challenged.

Paragraph 3.a.i B and C describes circumstances suggesting that a respondent's motives for registration were to block a complainant from registering a domain name, or to disrupt its business. The Complainant argues that the Respondent registered the Domain Name in full knowledge of the Complainant's plans to adopt "Tricia Cusden" as its trading name, inviting the inference that this knowledge was used when making a bad faith registration. The Respondent asserts that she registered the Domain Name in good faith, for non-infringing purposes. The Complainant maintains that she told the Respondent that she had taken advice about changing the name of the business, but insists that she did not ask the Respondent to carry out work connected to this fact. The Response has nothing to say on this point. While much of what is alleged boils down to one



Party's word against the other's, the Respondent's reasons for registering the Domain Name are not convincing. No evidence has been submitted to show that the Respondent has made any use, or preparations for use, of the Domain Name "for a branded business or as a blog site" as mentioned in the Response.

Paragraph 3.a.ii of the DRS Policy concerns a respondent's use of a domain name after registration. The Domain Name was registered the day after the settlement of the Respondent's invoice, in an acrimonious climate related to unpaid invoices more generally. At the time of writing, the Domain Name resolves to a holding page with click through links unrelated to the Complainant's business. Even if the Respondent had acted in good faith in making the original registration, in this context it is hard to see any justification for the continued holding of the Domain Name which make unadorned use of Ms Cusden's name. Such an act is highly likely to give rise to confusion relating to the ownership, control or authorisation of the Domain Name as contemplated in paragraph 3.a ii of the DRS Policy.

Paragraph 4 of the DRS Policy sets out a non-exhaustive list of factors which may be evidence that the Domain Name is not an Abusive Registration. For the most part, this list allows a Respondent to show that it had acted in good faith, or that its use of the Domain Name was a fair use for a legitimate purpose. I have not been presented with evidence to suggest that the Respondent is making legitimate fair use of the Domain Name or making demonstrable preparations for doing so. I do not think any of the factors in Paragraph 4 of the Policy can assist the Respondent and I confirm my conclusion that the Domain Name is an Abusive Registration.

## **6. Decision**

For the reasons set out above I find that the Domain Name is an Abusive Registration in the hands of the Respondent and direct that the Domain Name be transferred to the Complainant.

**Signed: Peter Davis**

**Dated** 31 August, 2014