

DISPUTE RESOLUTION SERVICE

D00016138

Decision of Independent Expert

AlixPartners UK LLP

and

Alix Part

1. The Parties:

Lead Complainant: AlixPartners UK LLP
20 North Audley Street
London
Greater London
W1K 6WE
United Kingdom

Complainant: AlixPartners, LLP
Suite 2400, 2000 Town Centre, Southfield
Detroit
Michigan
48075
United States

Complainant: AlixPartners Limited
20 North Audley Street
London
Greater London
W1K 6WE
United Kingdom

Respondent: Alix Part
34/6
Gillespie Crescent
Edinburgh
City of Edinburgh

EH10 4HX
United Kingdom

2. The Domain Name(s):

alixpartners.org.uk (the “Disputed Domain”)

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.

Relevant dates

24 June 2015 16:52 Dispute received
25 June 2015 10:34 Complaint validated
25 June 2015 10:51 Notification of complaint sent to parties
14 July 2015 02:30 Response reminder sent
17 July 2015 10:34 No Response Received
17 July 2015 10:34 Notification of no response sent to parties
20 July 2015 16:20 Expert decision payment received
21 July 2015 Michael Silverleaf appointed as expert

4. Factual Background

4.1 The present case is one in which, although a full decision has been requested, there has been no response from the respondent. Accordingly, the factual background set out here is taken wholly from the complaint.

4.2 The complainants are members of a group of companies which provide a variety of business advice and consultancy services. They trade under the name ALIXPARTNERS. The first complainant is the successor in business in the UK to the second complainant. The second complainant traded here from shortly after its incorporation in 2002 and the first complainant took over shortly after its incorporation in December 2010.

4.3 The third complainant is an LLP incorporated in the State of Delaware, USA. It is the head trading company in the group and is the registered proprietor of five trade mark registrations. There are two Community registrations and three US registrations. Community registration number 003517307 is for the mark ALIXPARTNERS and is registered in Classes 35, 36 and 42 for the following services:

Class 35: Business management services; business auditing; business acquisition and merger consultation; business consultation; business information technology management, namely, information management services in the field of technology for business; business organizational consultation, including relating to bankruptcy and reorganization proceedings; business supervision; business turnaround consulting services.

Class 36: financial analysis and consultation, financial research; financial forecasting; business valuation services.

Class 42: Litigation consultation services; intellectual property consultation.

The registration was filed on 31 October 2003. Community registration number 007014467 was registered for the mark ALIXPARTNERS WHEN IT REALLY MATTERS for a similar range of services (although I note that there is an – immaterial for present purposes – inconsistency between the classes to which certain of the registered services have been allocated in the two registrations) from a filing date of 24 June 2008.

The third complainant is also the registered proprietor of three largely corresponding registrations in the US.

4.4 The business currently carried on by the complainants has been in existence for 34 years and it is apparent from promotional material submitted with the complaint that amongst the business's areas of particular expertise is advising on investing in distressed businesses and advice on business turnaround.

4.5 The third complainant is also the proprietor of the domains alixpartners.com (registered on 30 January 2002) and alixpartners.co.uk (registered on 5 September 2012).

4.6 The Disputed Domain (alixpartners.org.uk) was registered by the respondent on 19 May 2015 in the name of "Alix Part" who is said on the WHOIS lookup to be a non-trading individual who has opted to keep his or her address off the public domain register. On the same date an email was sent from the address info@alixpartners.org.uk to the complainants containing the following text:

"Hi all

New website coming soon.

Before you instruct look at the alleged fraudulent activities of the company, the errors, the incompetence [sic], the unprofessional conduct

Why would you want to devalue your PLC?

Who really gives the advice?

What will the cost to your business be?

Best use another advisor but you will be able to download a full report on the disaster that awaits you FCA referrals / insolvency service referrals read it all (soon)

You worked hard to build your business don't let it be destroyed”

The email is signed with the url www.alixpartners.org.uk. However, at the date of the complaint that url displayed no content.

5. Parties' Contentions

5.1 The complainants say that they have rights arising from their trade mark registrations, domain registrations and the goodwill built up by the business carried on under the name ALIXPARTNERS for the last 34 years.

5.2 The complainants also assert that the Disputed Domain is abusive for the following reasons. First they say that it has been registered primarily as a blocking registration to prevent the complainants acquiring a domain name which corresponds to their registered trade marks. This is to be inferred from the facts that no permission has been sought from for the registration by the respondent, that the respondent must have been aware of their reputation and goodwill and that he or she was therefore misappropriating the complainants' intellectual property and that the respondent's name is either false or, even if true, could not properly be used to justify the registration of the Disputed Domain given the complainants' widespread use of the name ALIXPARTNERS. Further the complainants point out that if the respondent's name really is Alix Part, then one would expect him or her to have registered the domain alixpart.co.uk or alixpart.com, both of which are currently available.

5.3 Second the respondents say that, based on the content of the email quoted in paragraph 4.6 above, it is anticipated that the Disputed Domain will be used unfairly to disrupt the business of the complainants. The respondents say that if the Disputed Domain is used to host a website containing material of the kind presaged in the email it is highly likely that members of the public will access it in the belief that it is associated with the complainants and find material which would be damaging to the complainants' reputation and business. The respondents assert that the content of the email indicates that the registration of the disputed domain was not in good faith and is consequently abusive.

5.4 The respondent makes no arguments as he or she has not responded to the complaint.

6. Discussions and Findings

6.1 The version of the DRS Policy relevant to the present dispute is version 3 which relates to complaints lodged after 29 July 2008. Paragraph 1 of that policy defines an Abusive Registration 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”

6.2 Paragraph 1 of the DRS Policy defines “Rights” for the purposes of this procedure 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.”

6.3 Under Paragraph 2 of the DRS Policy a complainant must show on the balance of probabilities

- (a) that it has Rights in a name or mark identical or similar to the Domain Name; and
- (b) that the Domain Name in the hands of the Respondent is an Abusive Registration.

6.4 Paragraph 3 of the DRS Policy identifies a non-exhaustive list of factors which may be evidence that the Domain Name is an Abusive Registration. The relevant factors for the purposes of the present case are

- “(a)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;
 - 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;

...

The remaining factors are not relevant in the present case. I have accordingly taken the above factors into account in reaching my conclusions.

6.5 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. These include the following which are relevant to the present case:

- “(a)i. Before being aware of the Complainant’s 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;

B. been commercially known by the name or legitimately connected with a mark which is identical or similar to the Domain Name;
...

6.6 The first question in any DRS complaint is whether the complainant has Rights. As the DRS Policy definition makes clear Rights are limited to rights which are enforceable by the complainant whether under English law or not: see also paragraph 1.10 of the Expert Overview. Equally, as has been said in many cases, the requirement to establish Rights sets a low threshold test.

6.7 In the present case it is clear that the complainant has Rights in the name ALIXPARTNERS. The name is the subject of trade mark registrations in the European Community covering the UK and the USA. The name has also been used as the name of a business advisory and consultancy services provider for 34 years and in the UK for over a decade. The goodwill and reputation built up by such use would be protectable by a claim for passing off in this country and the equivalent tort in the US.

6.8 I turn therefore to consider whether the registration of the Disputed Domain is Abusive under the DRS Policy.

6.9 The only information I have about the respondent's reasons for registering the disputed domain are inferences to be drawn from the circumstances of the registration and the email sent on the same day to the complainants. From this it seems to me to be probable that the name given by the respondent when registering the domain is false. The complainants' point that the appropriate domain for a person with the name Alix Part to register would be alixpart rather than alixpartners is not conclusive – the Disputed Domain might be a clever pun on the respondent's name intended to indicate both his or her name and the nature of the organisation being registered. However, I do not think that this is in the least likely. The content of the email quoted above suggests that the respondent is someone disgruntled by his or her dealings with the complainants. Given the nature of the complainants' business – dealings with distressed or insolvent businesses – this seems likely to be someone who feels he or she has suffered financially as a result of the complainants' advice.

6.10 The contents of the email further indicate clearly an intention to present material which is at least unflattering the business practices of the complainants on the promised website at www.alixpartners.org.uk. As the Disputed Domain is in the trading name of the complainants it is likely that persons who know of the complainants who view the material on the Disputed Domain will think that it is in some way associated with them. This will obviously be highly damaging to the complainants' goodwill and reputation and disruptive to the complainants' business.

6.12 Given that it is probable that the respondent's name is false, that he or she intends to use the Disputed Domain to present information damaging to the complainants and that such activities would damage and disrupt the complainants' business, reputation and goodwill, it seems to me to follow that the Disputed Domain is Abusive under at least paragraphs 3(a)(i)(C) and 3(a)(ii) of the

DRS Policy. It is unnecessary to decide whether it is also Abusive under paragraph 3(a)(i)(B) although my tentative view is that it is not. The circumstances of the present registration do not seem to me to indicate that the respondent intended to block the complainants' registration of the Disputed Domain. That is just a side effect of the respondent's registration.

7. Decision

7.1 In the above circumstances I determine that the Disputed Domain is an Abusive registration and direct that it be transferred to the complainants.

Signed Michael Silverleaf

Dated 30 July 2015