

DISPUTE RESOLUTION SERVICE**D00019643****Decision of Independent Expert**

Charles & Keith International Pte Ltd

and

Royjm

1. The Parties

Complainant: Charles & Keith International Pte Ltd
6 Tai Seng Link
Singapore
534101

Respondent: Royjm
21 Fairlea Place
London
W5 1SP
United Kingdom

2. The Domain Name

charleskeith.co.uk

3. Procedural History

- 3.1 I 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.
- 3.2 On 22 December 2017 the complaint was received. On 2 January 2018 the complaint was validated and notification of it sent to the parties. On the same day the response was received and notification of it sent to the parties. On 5 January 2018 a reply reminder was sent. On 10 January 2018 no reply having been received a mediator was appointed. On 15 January 2018 the mediation started. On 19 January 2018 the mediation failed and close of mediation documents were sent. On 22 January 2018 the Expert decision payment was received.

4. Factual Background

- 4.1 The Complainant is a Singapore company which was incorporated on 3 January 2005. The Complainant is the owner of various trademark registrations for CHARLES & KEITH including EUTM no. 004520672 which was registered on 3 July 2006 in classes 14, 18 and 25.

- 4.2 CHARLES & KEITH is a brand of women's footwear and accessories which was established in 1996 from a shoe store in Singapore by two brothers, Charles and Keith Wong. In 2000 the business expanded into Southeast Asia and in 2004 it expanded into the Middle East. CHARLES & KEITH has grown into an international chain with more than 500 outlets. CHARLES & KEITH and its co-founder, Mr Charles Wong, have won a number of business awards.
- 4.3 The Complainant's group company, Charles & Keith (Singapore) Pte Ltd, has registered the domain name charleskeith.com. This domain name is used for a CHARLES & KEITH e-commerce site¹. The site received 1.45 million visitors from May 2017 to October 2017 and, according to Alexa.com, is the 1,389th most popular site in Singapore and 47,210th globally. CHARLES & KEITH has over 1.2 million likes on Facebook and over 490,000 followers on Instagram.
- 4.4 The Domain Name was registered on 20 January 2010 and resolves to a parking page containing sponsored links.

5. Parties' Contentions

The Complainant's complaint

- 5.1 The Complainant submits that it has Rights in the CHARLES & KEITH mark which it says is identical or similar to the Domain Name:
- (a) The Complainant relies on its registered trade mark rights as set out at paragraph 4.1.
 - (b) The Complainant contends that the CHARLES & KEITH mark has substantial inherent and acquired distinctiveness. It says there is significant awareness of the mark across the world and online. The Complainant refers to the protection that is afforded by trade mark law to well known marks.
 - (c) The Complainant says the missing '&' and spaces in the Domain Name do not distinguish it from the Complainant's mark.
- 5.2 The Complainant contends the Domain Name, in the hands of the Respondent, is an Abusive Registration:
- (a) The Complainant says there is a considerable risk that the public will perceive the Domain Name as owned by or in some way connected to it. The Complainant contends that the Respondent's use of the CHARLES & KEITH mark in the Domain Name exploits the goodwill and image of the Complainant's mark which may dilute and damage the mark. The Complainant alleges there is initial interest confusion.
 - (b) The Complainant says the Domain Name was registered significantly after the trade mark registrations for CHARLES & KEITH and the registration of charleskeith.com. The Complainant argues that at the time of registration of the Domain Name the Respondent would therefore have been fully aware of the Complainant's Rights in this mark and domain name.
 - (c) The Complainant contends that due to the fame and distinctiveness of the CHARLES & KEITH mark, the Respondent knew, or at least should have known, of

¹ I note that there is an unexplained anomaly in the WHOIS record information annexed to the complaint which show two creation dates for charleskeith.com of 10 September 1999 and 6 July 2017. The evidence suggests the CHARLES & KEITH site at this domain name has been operating since 2004.

its existence. The Complainant says its growth to about 500 stores in Asia Pacific, Europe and the Middle East demonstrates the worldwide fame of CHARLES & KEITH. The Complainant states that searches on Internet search engines using 'charleskeith' return multiple links referencing the Complainant and its business.

- (d) The Complainant says that by registering the Domain Name the Respondent sought to trade on the goodwill and reputation of the CHARLES & KEITH mark. The Complainant contends that it is not possible to conceive of a plausible situation in which the Respondent would have been unaware of the Complainant's brand at the time of registration of the Domain Name. The Complainant alleges the Respondent registered the Domain Name to "ride on" the Complainant's Rights taking undue advantage and causing detriment. In so doing, the Complainant says the Respondent must have realised, if not intended, that this would cause unfair disruption to the Complainant's business.
- (e) The Complainant says that when users arrive at the web site at the Domain Name they may click on the advertising links which divert them to the Complainant's competitors resulting in the Respondent earning pay-per-click revenue. The Complainant argues that the Respondent's registration of the Domain Name which is closely similar, if not identical, to the CHARLES & KEITH mark and its subsequent association with related pay per click advertising is Abusive.
- (f) The Complainant states the Respondent does not use and has not 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 Complainant says the Respondent does not and could not offer goods or services using the CHARLES & KEITH mark or any similar name. The Complainant states there is no connection or co-operation between it and the Respondent and that it has not licensed or authorised the Respondent to use the CHARLES & KEITH mark. The Complainant has searched the UK and EU trademark databases and has not found any trade mark registrations by the Respondent corresponding to the Domain Name.
- (g) The Complainant says the Respondent is not commonly known by a name or legitimately connected with a mark which is identical or similar to the Domain Name and has not made legitimate non-commercial or fair use of the Domain Name. The Complainant argues that, in the absence of a prima facie right in the Domain Name or a valid reason to register the Domain Name, the Respondent has blocked or prevented the Complainant from registering and using the Domain Name.

The Respondent's response

- 5.3 The Respondent's response is brief and is set out in its entirety below:

"I registered this domain name many years ago with the view of applying for a franchise. I since then did not pursue this and it has just remained parked and automatically renewed by the domain registration provider."

6. Discussions and Findings

- 6.1 Paragraph 2.2 of the Nominet Dispute Resolution Service Policy ("the Policy") sets out that the Complainant is required to prove to the Expert that both of the following elements are present on the balance of probabilities:

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

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

Rights

- 6.2 Under Paragraph 1 of the Policy, 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.” It is well accepted that the question of Rights falls to be considered at the time the Complainant makes its complaint and is a test with a low threshold to overcome.
- 6.3 I am satisfied on the basis of the Complainant’s registered trade mark set out at paragraph 4.1 that the Complainant has Rights in the CHARLES & KEITH mark.
- 6.4 The Domain Name differs only from the CHARLES & KEITH mark by the omission of the ‘&’ and the spaces before and after it. However, the Domain Name comprises of the distinctive elements of the Complainant’s mark, namely the combination of ‘CHARLES’ and ‘KEITH’ in that order. I do not consider the missing characters distinguish the Domain Name from the CHARLES & KEITH mark. I am therefore satisfied the Complainant has Rights in a name or mark, CHARLES & KEITH, which is similar to the Domain Name.

Abusive Registration

- 6.5 Under Paragraph 1 of the Policy 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. *is being or has been used in a manner which has taken unfair advantage of or has been unfairly detrimental to the Complainant’s Rights.*

It is sufficient to satisfy either of these limbs for there to be a finding of an Abusive Registration.

- 6.6 For there to be an Abusive Registration under paragraph 1.i. of the Policy it generally must be established that the Respondent knew of the Complainant and/or its Rights at the time of registration of the Domain Name.
- 6.7 The Respondent is said to be a UK sole trader. The Complainant has not provided any evidence of the extent of its trade in the UK such as details of its UK turnover. While it ships orders to the UK from its web site at charleskeith.com there is no indication of the value of those orders. Further, although the complaint refers to CHARLES & KEITH stores in Europe, no stores in the UK or Europe are shown in the store locator section on the charleskeith.com site². The Complainant’s evidence suggests that its main sales are in the Middle and Far East. Indeed in an article adduced in the Complainant’s evidence relating to an actress carrying a CHARLES & KEITH handbag at the US Emmys awards the brand is described as a “little-known Singapore-based label”. Accordingly, on first consideration it is not immediately apparent how the Respondent would have been aware of the CHARLES & KEITH business at the time of registration of the Domain Name.

² The brand profile page at charleskeith.com adduced in evidence refers to a pop-up (that is a temporary) store in Paris’s Galeries Lafayette in the last 3 years, which would be after registration of the Domain Name.

- 6.8 The Respondent states that he registered the Domain Name “*with the view of applying for a franchise*”. The charleskeith.com site states that it operates its international operations predominantly through authorised franchises. The site says the preference is to work with franchisees who have the requisite experience in retail and who are prepared to open multiple stores within a territory. Authorised franchisees are granted a right to sell CHARLES & KEITH and CHARLES & KEITH COLLECTION merchandise subject to compliance with standards. Taking this into account and given the nature of the Domain Name, I consider that the Respondent is referring in his response to registration of the Domain Name with the view to applying for a franchise from the Complainant (or a group company) to be able to sell CHARLES & KEITH merchandise. I therefore consider that the Respondent was aware of the Complainant and/or its Rights at the time of the Domain Name registration.
- 6.9 In D00002193 GuideStar UK and Wilmington Business Information Limited the Appeal Panel stated “*Registering as a domain name, the name of another (without any adornment), knowing it to be the name of that other and intending that it should be recognised as the name of that other and without the permission of that other is a high risk activity insofar as the DRS Policy is concerned. Ordinarily, it would be tantamount to impersonating the person whose name it is. Rarely will it be the case that deliberate impersonation of this kind will be acceptable under the DRS Policy*”. As explained by the Appeal Panel in D00016416 World Wrestling Entertainment, Inc. and Daniel Raad, the reason this is objectionable under the Policy is that it is likely to fall within Paragraph 5.1 of the Policy which sets out a non-exhaustive list of factors which may be evidence that the Domain Name is an Abusive Registration. I consider these factors further below.
- 6.10 The Complainant (and/or its group companies) use and at the time of registration of the Domain Name used the CHARLES & KEITH mark and charleskeith.com. In this case I consider that at the time of registration of the Domain Name the Respondent knew that the Domain Name incorporated the distinctive elements of the CHARLES & KEITH mark and knew that as he had not been granted a franchise he had no rights to use the CHARLES & KEITH mark. I also consider the Respondent registered the Domain Name because he knew that it would be recognised by Internet users as being owned by or connected with the CHARLES & KEITH business, especially given that charleskeith.com is used for this business. As the Respondent states, he registered the Domain Name with a “view” to becoming a franchisee, which I have found is a reference to a CHARLES & KEITH franchisee. The Respondent’s registration of the Domain Name may have been due to his wishful thinking (he has not provided any evidence of his resources to satisfy the Complainant’s criteria for a franchisee) but even if that was the case he should have quickly realised that he could not keep the Domain Name if he did not become a franchisee (and there is no suggestion that any attempts were made to actually become one).
- 6.11 The Domain Name is used for a parking site containing links relating to the Complainant and to competing products to those of the Complainant (for example links for “Bags” and “Branded Bags”). The Respondent states in his response that he did not pursue a franchise and the Domain Name has “*just remained parked*”. This suggests the Domain Name has been used since registration for a parking page containing sponsored links. This is supported by the Complainant’s screenshot of the web site at the Domain Name; above the sponsored links it states “This domain name has just been registered” indicating that there has been no change of use of the Domain Name since registration. In my view whilst the Respondent may have

registered the Domain Name with some sort of “view” of applying for a future franchise, he registered it with the immediate intention of parking the Domain Name.

- 6.12 I consider there is a real risk that Internet users, particularly those based in the UK, guessing the URL for the Complainant, will use the Domain Name and thereby visit the Respondent’s site. I also consider there is a real risk that Internet users will visit the Respondent’s site in response to a search engine request looking for the Complainant. There is therefore a risk that users who find the Respondent’s site when looking for the Complainant will be diverted to third party sites earning the Respondent click through revenue.
- 6.13 Under paragraph 5.1.1.3 of the Policy a factor which may be evidence that the Domain Name is an Abusive Registration is circumstances indicating that the Respondent has registered the Domain Name primarily for the purpose of unfairly disrupting the business of the Complainant. I consider that at the time of registration of the Domain Name the Respondent knew that Internet users may find the Domain Name when looking for the Complainant (or an authorised franchisee) and that he intended to take unfair advantage of this likely confusion to divert traffic to third party sites to earn click through revenue. In such circumstances I consider that the Domain Name is an Abusive Registration under paragraph 1.i. of the Policy.
- 6.14 Further I consider there is an Abusive Registration under paragraph 1.ii. of the Policy. Under paragraph 5.1.2 of the Policy a factor which may be evidence of an Abusive Registration is 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. As set out above I consider there is a likelihood of Internet users being initially confused into visiting the Respondent’s web site in the expectation of finding the CHARLES & KEITH business and of potentially being diverted to third party web sites in respect of which the Respondent earns click through revenue. Even if users appreciate that they have not found the CHARLES & KEITH business when they reach the Respondent’s site, he has still used the Domain Name in a way to cause initial interest confusion that the Domain Name is registered to, operated or authorised by or otherwise connected with the Complainant.
- 6.15 In reaching my conclusion that there is an Abusive Registration under paragraphs 1.i. and 1.ii. of the Policy I have taken into account paragraph 8.5 of the Policy which sets out a factor which may be evidence that the Domain Name is not an Abusive Registration as follows:
- 8.5 *Sale of traffic (i.e. connecting domain names to parking pages and earning click-per-view revenue) is not of itself objectionable under this Policy. However, the Expert will take into account:*
 - 8.5.1 *the nature of the Domain Name;*
 - 8.5.2 *the nature of the advertising links on any parking page associated with the Domain Name; and*
 - 8.5.3 *that the use of the Domain Name is ultimately the Respondent’s responsibility.*
- 6.16 In this case the Domain Name is identical to the domain name used for the CHARLES & KEITH business (ignoring the .co.uk and .com suffixes); the Respondent registered the Domain Name knowing that it would be recognised by Internet users as being

owned by or connected with the CHARLES & KEITH business; some of the advertising links are for competing goods to those of the Complainant; and use of the Domain Name for those links is the Respondent's responsibility. In such circumstances I regard the registration and use of the Domain Name to be objectionable under the Policy.

- 6.17 Finally, as a matter of completeness I deal with the delay between registration of the Domain Name and the bringing of the complaint over 7 years afterwards (although it is unclear when the Complainant became aware of the registration). The issue of delay has been considered by the Appeal Panels in D00017490 Jockey Club Racecourses Limited and Moneta Communications Limited and in D00015788 Lucasfilm Ltd.,LLC and Abcissa.com Limited. These decisions make it clear that delay does not automatically bar an action where the use complained of is ongoing (as is the case here) but, depending on the facts, it might mean that an otherwise Abusive Registration is acceptable.
- 6.18 In this case I do not consider the delay between registration and complaint has prejudiced the Respondent being able to argue his case or has prejudiced a proper consideration of the issues. Nor do I consider there has been any unfair prejudice to the Respondent as a result of any delay. He has not, for example, developed a proper business under the Domain Name; instead its use has been for click through revenue. Accordingly, I do not consider that the delay between registration and the complaint makes the Abusive Registration in this matter acceptable.
- 6.19 I therefore find that the Domain Name, in the hands of the Respondent, is an Abusive Registration under paragraphs 1.i. and 1.ii. of the Policy.

7. Decision

- 7.1 I find that the Complainant has Rights in 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.
- 7.2 I direct that the Domain Name be transferred to the Complainant.

Patricia Jones

19 February 2018