Decision for dispute CAC-UDRP-101287

Case number	CAC-UDRP-101287
Time of filing	2016-09-07 11:10:49
Domain names	playspennies.com

Case administrator

Name	Aneta Jelenová (Case admin)

Complainant

Organization	Upfeat Media Inc

Complainant representative

Organization	McEvedys Solicitors & Attorneys Ltd

Respondent

Name	Zhou Yan

OTHER LEGAL PROCEEDINGS

None of which the Panel is aware.

IDENTIFICATION OF RIGHTS

The Complainant relies upon:

1. Common law rights under the English law of passing off by reason of the use of the term "Playpennies" since in or about 2009; and

2. UK trade mark No. 3159469 filed on 12 April 2016 and proceedings to registration on 15 July 2016, for the work mark PLAYPENNIES in classes 35, 28, 41 and 42.

FACTUAL BACKGROUND

FACTS ASSERTED BY THE COMPLAINANT AND NOT CONTESTED BY THE RESPONDENT:

The Complainant is a Canadian company which has a presence in London and Canada and operates a publishing and advertising website at the domain name <playpennies.com> which provides editorial content and advertises third party offers and deals, all focused on parents of young children in the UK/EU. The site has been operational and trading since

2009. The business has been a success and turnover now approaches £400,000 per annum. It has affiliate partners that include the major UK retailers and supermarkets and the Alexa ranking of the site is No. 6,649 in the UK. The Complainant has acquired a goodwill and reputation by its trading that is protected by the law of passing-off in the UK. In 2016, the Complainant registered its name and mark, PLAYPENNIES, in the UK under the number UK No. 3159469 in classes 35, 38, 41 and 42.

The disputed domain name was registered on 3 March 2016 by the Respondent, is parked by Godaddy, and used in sponsored ads purporting to be offers by the Complainant.

The disputed domain name includes in its entirety, the trademark with the addition of one additional character or letter, the ‘s’ between the words ‘play’ and ‘pennies'. This is blatant and overt typosquatting and paradigm bad faith registration and use to divert traffic to the disputed domain name.

The vouchers offered at the clicked through pages on the disputed domain's URL are designed to compete directly with the Complainant's affiliate partner offers. Indeed, the Respondent's Bad Faith use has almost led to the termination of two relationships with major UK retailers as a result of actual confusion with the disputed domain name as it is a breach of those contracts to bid on certain terms. This has caused the Complainant to remove some of its own pages to avoid a breach and has resulted in lost revenue.

This is actual disruption with real loss and actual confusion by the internet users who complained. The Policy requires only likelihood of confusion and it is submitted that this can be inferred from the similarity of the domains in issue alone.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the Domain Name is identical or confusingly similar to a trademark or service mark in which the complainant has rights (within the meaning of paragraph 4(a)(i)of the Policy).

NO RIGHTS OR LEGITIMATE INTERESTS

The Complainant has, to the satisfaction of the Panel, shown the Respondent to have no rights or legitimate interests in respect of the Domain Name (within the meaning of paragraph 4(a)(ii)of the Policy).

BAD FAITH

The Complainant has, to the satisfaction of the Panel, shown the Domain Name has been registered and is being used in bad faith (within the meaning of paragraph 4(a)(iii)of the Policy).

PROCEDURAL FACTORS

The Panel is satisfied that all procedural requirements under UDRP were met and there is no other reason why it would be inappropriate to provide a decision.

PRINCIPAL REASONS FOR THE DECISION

The Panel accepts that the Complainant has common law rights under the English law of passing off in the term "PLAYPENNIES" by reason of its use as the name of its business in a website operating from the domain name <playpennies.com>. Common law rights under the law of passing off have long been recognised as providing trade mark rights for the purposes of the Policy (see paragraphs 1.6 and 1.7 of the WIPO Overview 2.0).

The Panel also accepts that the Complainant is the owner of a United Kingdom registered trade mark in that term.

The Domain Name comprises that term in its entirety with an additional "s" inserted after the word "play", together with the top level domain ".com". In the circumstances, the Complainant has demonstrated that the Domain Name is confusingly similar to a trade mark in which it has rights.

The Domain Name was registered many years after the Complainant had started to use the term "PLAYPENNIES" and the Panel accepts that the most likely explanation for the registration of the Domain Name is because of its similarity to the name adopted for the Complainant's business. Further, the use made of the Domain Name after registration reinforces the conclusion that that the Domain Name was registered with knowledge of the Complainant's use of that term "PLAYPENNIES" and also leads the Panel to conclude that the Domain Name has been registered with the intention of using the Domain Name to divert traffic from the Complainant to a pay-per-click website.

In short the Panel accepts that this is a case of typosquatting. Typosquatting by reference to another's mark does not provide rights or legitimate interests and also involved registration and use in bad faith (see, for example, the cases identified in paragraph 1.10 of the WIPO Overview 2.0).

Accordingly the Complainant has made out the requirements of the UDRP.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

AND THE DISPUTED DOMAIN NAME(S) IS (ARE) TO BE

1. **PLAYSPENNIES.COM**: Transferred

PANELLISTS

Name	**Matthew Harris**

DATE OF PANEL DECISION 2016-10-17

Publish the Decision