

.KY DISPUTE RESOLUTION

Information and Communications Technology Authority (the 'Authority' or 'ICTA')

Decision - D0001

Artisan Metal Works

and

Mr. Dave Bennett

1. The Parties:

Complainant: Karoly Szücs
Custom Metals Ltd.
T/A Artisan Metal Works
Grand Cayman
CAYMAN ISLANDS

Respondent: Mr. Dave Bennett
dave@malar.ky

2. The Domain Name:

artisanmetalworks.ky

3. Procedural History:

3.1 The Complaint was filed with the Authority on 12 July 2014.

- 3.2 On 22 July 2014, the Authority sent the Complaint to the Respondent's .ky registered email address and provided the Respondent with an opportunity to respond to the Complaint. However, that email was returned to the Authority as "undeliverable".
- 3.3 The Authority was given a different email address by the Complainant as a possible contact address for the Respondent and the Complaint was resent to that email address on 4 August 2014 for a response.
- 3.4 The Respondent did not submit a response to the Complaint.

4. Factual Background:

- 4.1 The complaint was brought by Mr. Karoly Szücs on behalf of the company Custom Metals Ltd (t/a Artisan Metal Works), which is licensed to carry on the trade or business of the production of custom and artistic metal work and sculpture.
- 4.2 The Respondent registered the Domain Name on 22 February 2006.

5. Parties' Contentions

The Complainant

- 5.1 In summary, the Complainant submitted that the Domain Name should be transferred to it for the reasons below.
- 5.2 The Complainant submitted that, in early 2000 [though the Authority notes that the Domain Name was registered in 2006] the Respondent (who was servicing Artisan Metal Works' computer at that time) registered the Domain Name without the Complainant's permission and has refused to sign it back to the Complainant when asked to.
- 5.3 The Complainant holds a current Cayman Islands Trade and Business Licence (a copy of which was provided to the Authority).
- 5.4 The Complainant works locally and, from time to time, internationally.

The Respondent

- 5.5 The Respondent did not respond to the Complaint.

It is important to note that the Complainant does not automatically receive the remedy it has requested merely because the Respondent has not responded to

the Complaint. The Authority has based the Decision on the facts and evidence before it.

6. Discussions and Findings:

6.1 Those who register domain names with the Authority agree to be bound by the Uniform Domain Name Dispute Resolution Policy (the 'Policy') as approved by the Internet Corporation for Assigned Names and Numbers ('ICANN') on 24 October 1999 (including any subsequent revisions of the Policy).

6.2 The current version of the Policy can be found at:
<https://www.icann.org/resources/pages/policy-2012-02-25-en>.

6.3 Paragraph 4 a. of the Policy provides that, in order to be entitled to a transfer of the Domain Name, the Complainant shall prove on the balance of probabilities the following three elements:

(i) [the] domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights;

(ii) [the Respondent] has no rights or legitimate interests in respect of the domain name; and

(iii) [the] domain name has been registered and is being used in bad faith.

(i) Identical or Confusingly Similar

6.4 The Complainant has not brought forward evidence that it has obtained registered trademark protection for the name "Artisan Metal Works" (the 'Name'); a registered trademark being an enforceable right as understood by the reference to rights in paragraph 4 a. (i) of the Policy.

6.5 However, unregistered trademark rights can also suffice in such circumstances to meet this requirement and the Authority has considered whether the Complainant has such a non-registered enforceable right in the Name.

6.6 To show such unregistered trademark rights in the Name, the Complainant must show that the Name has become a distinctive identifier associated with the Complainant or its goods or services. Relevant evidence of such a 'secondary meaning' includes such things as the longevity of the business, the amount of sales, the nature and extent of any advertising using the Name, and media recognition.

6.7 As set out by the WIPO Arbitration and Mediation Center which considers disputes under the Policy, in these circumstances the fact that such a secondary meaning may only exist in a small geographical area does not limit the complainant's rights in an unregistered trademark.¹

6.8 In this regard, the Authority considers that the Name itself is capable of being distinctive; the combination of the words "*Artisan*", "*Metal*" and "*Works*" are unique to the Complainant in the Cayman Islands. Further, in the view of the Authority, the combination of the words is not generic and is not a usual combination in the English language.

6.9 After undertaking a limited search of the Internet for references to the Complainant, the Authority notes that:

- the Complainant was mentioned in a 2004 list of registered local contractors on the Cayman Islands Chamber of Commerce website, such a list being made prior to the registration of the Domain Name;
- the Complainant won an award for outstanding craftsmanship in an international competition sponsored by the National Ornamental & Miscellaneous Metals Association, as reported in 2012; and,
- the Complainant advertised its goods and services through the Cayman Compass in 2014.

6.10 The Authority considers that the Complainant in this way has used the Name for a 'not insignificant' period and to 'a not insignificant degree' having generated sufficient business and consequent turnover at least from 2004 to keep the business running.

6.11 Thus, the Authority considers that, on the balance of probabilities, the Name serves to indicate to the purchasing public in the Cayman Islands the goods or services of the Complainant.

6.12 The Authority also considers that, on the balance of probabilities, the Complainant has generated goodwill and reputation in the Name sufficient to give rise to unregistered trade mark rights in respect of the Name.² Relevant to

¹ For further discussion, please see <http://www.wipo.int/amc/en/domains/search/overview2.0/>. To assist awareness of decision-making under the UDRP, the WIPO Arbitration and Mediation Center (one of the approved dispute-resolution service providers) produced the linked document which sets out an informal overview on key procedural and substantial issues.

² Goodwill has been defined as: "the benefit and advantage of the good name, reputation and connection of a business. It is the attractive force which brings in custom." –case *Inland Revenue Commissioners v Muller & Co Margarine Ltd* [1901] A.C. 217 at 223,224 (England & Wales).

this is that the Complainant has a good reputation (exemplified by winning the craftsmanship award) and has spent money advertising locally.³

- 6.13 Given the reasoning above, the Authority considers that “Artisan Metal Works” is a term directly connected with the Complainant’s activities in the production of custom and artistic metal work and sculpture (the 'Mark').
- 6.14 Further, the Authority considers that the Mark is identical to the Domain Name (in concluding the above, the Authority has disregarded the domain suffix '.ky').
- 6.15 Therefore, the Authority considers the Domain Name to be identical to the Complainant’s Mark, and that the Complainant has satisfied the first element.

(ii) Rights or Legitimate Interests

- 6.16 In relation to paragraph 4 a. (ii) of the Policy, paragraph 4 c. of the Policy provides some examples without limitation of how a Respondent can demonstrate a right or legitimate interest in a domain name:

(i) [before receiving any notice of the dispute, the respondent used or made] demonstrable preparations to use, the domain name [...] in connection with a bona fide offering of goods or services; or

(ii) [the respondent has been] commonly known by the domain name [...]; or

(iii) [the respondent is] making a legitimate noncommercial or fair use of the domain name without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark [...] at issue.

- 6.17 Based on the Complaint, the Authority considers that the above circumstances are not present in this particular case.
- 6.18 The Respondent has not brought forward any evidence that it is commonly known by the Mark or has been licensed or authorised to use the Mark.
- 6.19 Consequently, the Authority is satisfied that the Respondent has no rights or legitimate interests in the Domain Name, and the Complainant has proven the second element.

³ The case *Redwood Tree Services Ltd v Warren Apsey t/a Redwood Tree Surgeons* [2011] EWPC 14 (*England & Wales*), supports an argument that small businesses with only local custom can generate Goodwill in a localised geographic area sufficient to prevent third parties from passing off in that area.

(iii) Registered and Used in Bad Faith

6.20 Paragraph 4 b. of the Policy states that the following circumstances, in particular but without limitation, shall be evidence of the registration and use of the Domain Name in bad faith:

(i) circumstances indicating that [the respondent has] registered or [...] acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of [...] documented out-of-pocket costs directly related to the domain name; or

(ii) [the respondent] registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that [the respondent has] engaged in a pattern of such conduct; or

(iii) [the respondent has] registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the domain name, [the respondent has] intentionally attempted to attract, for commercial gain, Internet users to [its] web site or other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of [its] web site or location or of a product or service on its web site or location.

6.21 While it may be helpful to consider the Respondent's intentions at the time he registered the Domain Name, and in relation to any subsequent use of the Domain Name, as the Respondent has not replied to the Complaint, the evidence available to the Authority is that provided by the Complainant.

6.22 The Authority notes that, as at the date of the Decision, no website is linked to the Domain Name. The apparent lack of so-called 'active use' of the Domain Name does not as such prevent a finding of bad faith; such a finding will depend on all the circumstances of the case.

6.23 In this regard, the Authority notes the Complainant's submission that the Respondent was working for the Complainant prior to or at the time of the registration of the Domain Name and, in this way, he would have known about the Complainant at the time of the Domain Name's registration.

6.24 Noting that Paragraph 4 b. of the Policy is not an exhaustive list, the Authority considers that the Respondent registered the Domain Name primarily for the purpose of disrupting the Complainant's business. On the balance of

probabilities, the Authority considers that in so registering the Domain Name, the Respondent intended to deprive the Complainant from selling its goods and services to prospective clients who would be clearly looking for the Complainant.

- 6.25 Accordingly, on the balance of probabilities the Authority considers that the Complainant has proved that the Domain Name was registered and in this way is being used in bad faith, satisfying the third element.

7. Comments

- 7.1 The Authority notes that the Respondent's contact details on its Registry were not current.
- 7.2 It is incumbent on those who register *.ky* domain names to keep their contact details current. In circumstances where this is not the case, the Authority reserves the right to cancel a domain name registration where it has been provided with significantly inaccurate, not correct, unreliable or false contact details (including names), or the Registrant has failed to keep contact details up to date, or failed to give us those details at all.

8. Decision

For the foregoing reasons, in accordance with paragraphs 4(i) of the Policy, the Authority determines that the Domain Name be transferred to the Complainant.

ICTA, 5 September 2014