

DISPUTE RESOLUTION SERVICE

D00017470

Decision of Independent Expert

Master Chicken Limited

and

Abi ebrahim

1. The Parties:

Lead Complainant: Master Chicken Limited
70 Seabourne Road
Bournemouth
Dorset
BH5 2HT
United Kingdom

Complainant: Mr Darius Majidi
25 Shore Road
Poole
Dorset
BH13 7PJ
United Kingdom

Respondent: Abi ebrahim
1609 Wimborne road
Kinson
Bournemouth
BH11 9AP
United Kingdom

2. The Domain Name:

californiafriedchicken.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 into question my independence in the eyes of one or both of the parties.

12 May 2016 14:58 Dispute received
16 May 2016 09:17 Complaint validated
16 May 2016 09:28 Notification of complaint sent to parties
03 June 2016 02:30 Response reminder sent
07 June 2016 10:10 Response received
07 June 2016 10:11 Notification of response sent to parties
10 June 2016 02:30 Reply reminder sent
14 June 2016 13:05 Reply received
14 June 2016 13:05 Notification of reply sent to parties
14 June 2016 13:06 Mediator appointed
17 June 2016 12:45 Mediation started
01 July 2016 11:03 Mediation failed
01 July 2016 11:04 Close of mediation documents sent
13 July 2016 02:30 Complainant full fee reminder sent
15 July 2016 16:58 Expert decision payment received

4. Factual Background

UK trade mark No. 2503436, registered on May 1, 2009 in the name “Dariush Majidi” (which I take to be a reference to the Complainant, Mr. Darius Majidi) comprises a smiling caricature character wearing sunglasses seated in a deckchair next to a sunshade emblazoned “CFC”, together with the words: “CALIFORNIA FRIED CHICKEN AND PIZZA”, as shown below (“the Trade mark”). The Trade mark is registered in classes 29, 30 and 43 in respect of, *inter alia*, poultry, pizzas and fast food services.



CALIFORNIA FRIED CHICKEN
AND PIZZA

According to a WHOIS search conducted on May 12, 2016 the Respondent registered the domain name <californiafriedchicken.co.uk> (“the Domain Name”) on April 11, 2016.

5. Parties' Contentions

Complainants

The Complainants say that Mr. Darius Majidi has for approximately 20 years conducted a business under the name California Fried Chicken and Pizza. He recently licensed Master Chicken Limited to operate the business under the name California Fried Chicken on his behalf. As a result of these activities the Complainants have developed a significant reputation in the Dorset area in relation to the sale of fast foods, predominantly fried chicken.

The Domain Name redirects to a website at <onlineordergo.co.uk/calimanabi-chicken-pizza-kebab-kinson> offering a range of foods and drinks and containing the statement: "Caliman Abi Kebab, Pizza, Fried Chicken, Burgers, Established 2012, open 7 days a week serving the best takeaway food for collection or delivery in Kinson within a 3 mile radius..."

In view of the substantial goodwill and reputation in the Dorset area of the Trade mark, and the Respondent's use of a substantial part of the Trade mark in the Domain Name in connection with the sale of fried chicken and pizza, it is clear that the Domain Name is likely to cause confusion in the minds of the public that the products the Respondent is selling as 'Caliman Abi' are those of the Complainants, or are associated or connected with those of the Complainants, because the Respondent has used identical wording.

The Domain Name was registered with the primary purpose of disrupting the Complainants' business and has been used to confuse internet users.

The Complaint includes a draft solicitor's letter to the Respondent dated 5 May 2016 asserting that the Respondent had obtained a shop unit at 238 Ashley Road, Poole, Dorset previously occupied by Mr. Darius Majidi and, whilst leaving signs outside, had added a sign in the window indicating an intention to open the shop as "California Fried Chicken" and that people could order online at <www.californiافriedchicken.co.uk>. Photographs of the shop attached to the draft letter show the signage outside the shop to be the Trade mark.

Respondent

The Respondent says he purchased a dissolved company name California Fried Chicken Ltd, registration number 10121211. He seeks confirmation as to whether Mr Dariush Majidi held any official position within the dissolved company and as to whether California Fried Chicken Ltd was dissolved prior to the establishment of Master Chicken Ltd.

The Respondent says he "purchased the domain name for 10 years of CaliforniaFriedChicken.co.uk"; that it is up to the owner of California Fried Chicken & Pizza to remove the signage at 238 Ashley Road, which has nothing to do with the Respondent; and that according to the Trip Advisor website on May 10th the Complainants have had 75 reviews as California Fried Chicken & Pizza, with the following ratings: Excellent 1, Very Good 4, Average 4, Poor 9, Terrible 57.

Complainants' Reply

Since the Reply is largely restricted to matters newly raised in the Response, I am prepared to admit it into this administrative proceeding, pursuant to paragraph 6.b. of the Procedure.

The Complainants say the Respondent did not purchase a dissolved company, he incorporated a new company on 13 April 2016, No. 10121211 and named it California Fried Chicken Ltd; dissolved companies are not relevant to this matter; Master Chicken Limited, company number 09674349 was incorporated on 7 July 2015; the owner of the goodwill in the name California Fried Chicken is Mr Dariush Majidi, not Master Chicken; the date of the Respondent's registration of the Domain Name is not relevant, since the Respondent has only recently started to use it to divert business away from the owner of the goodwill; and the removal of signage at 238 Ashley Road is not relevant to Nominet.

6. Discussions and Findings

Pursuant to paragraph 2.a.i of the Policy, for a complainant to succeed it must prove on the balance of probabilities that:

- I. It has Rights in respect of a name or mark which is identical or similar to the Domain Name; and
- II. The Domain Name, in the hands of the Respondent, is an Abusive Registration.

Rights

The meaning of 'Rights' is defined in the Policy 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.

Here the Complainants have shown that Mr. Majidi has rights as registrant in the Trade mark, which is a combination of an image, initials and the descriptive words "California Fried Chicken and Pizza".

The Complainants assert, but have provided no evidence, that the words "California Fried Chicken" alone have acquired a secondary meaning identifying Mr. Majidi's business or that of his licensee. However, the Trip Advisor website, to which the Respondent refers and which I have visited for the purposes of this administrative proceeding, contains numerous reports from people on their experiences in ordering online fast food from a restaurant called "California Fried Chicken and Pizza" in Poole, Dorset. Almost all of those reviews are by people from Dorset. I conclude that, separately from the Trade mark, "California Fried Chicken and Pizza" has acquired secondary meaning as a name recognised by Dorset residents as identifying the operator of that restaurant and is therefore a name in which Mr. Majidi has rights.

The Domain Name does not include the words “and pizza”. The suffix “.co.uk” may be disregarded as inconsequential. I find the Domain Name to be similar to the Trade mark and to the name in which Mr. Majidi has acquired rights through use, despite the absence of the words “and pizza”.

Abusive registration

“Abusive Registration” is defined in paragraph 1 of the Policy 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.

Paragraph 3 of the Policy sets out a non-exhaustive list of factors, any of which may be evidence that a domain name is an Abusive Registration. The Complainants rely upon the following factors:

Policy 3 a. i. c: circumstances indicating that the Respondent has registered or otherwise acquired the Domain Name primarily for the purpose of unfairly disrupting the business of the Complainant; and

Policy 3 a. 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.

Nominet’s online guidance tools for parties to disputes include the Experts’ Overview. Paragraph 3.3 of the Overview, which is directed to the issue of confusing use, contains the following passage:

“What is meant by confusing use? The ‘confusion’ referred to in this paragraph of the Policy is confusion as to the identity of the person/entity behind the domain name. Will an Internet user seeing the domain name or the site to which it is connected believe or be likely to believe that “the domain name is registered to, operated or authorised by, or otherwise connected with the Complainant”?

Paragraph 4 of the Policy sets out a non-exhaustive list of factors, which may be evidence that the Domain Name is not an Abusive Registration. Two potentially applicable here are:

Policy 4 a i. A: Before being aware of the Complainant’s cause for complaint (not necessarily the ‘complaint’ under the DRS), the Respondent has 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; and

Policy 4 a. ii: that the Domain Name is generic or descriptive and the Respondent is making fair use of it.

On April 11, 2016 the Respondent registered the Domain Name. On 13 April 2016 he incorporated a company and named it California Fried Chicken Ltd. By 5 May, 2016 he had occupied the former shop operated by Mr. Majidi, which still bore the Trade mark prominently as signage outside, and had separately displayed three signs on the otherwise white painted window: "California Fried Chicken"; "order online now at www.californiafriedchicken.co.uk" and "opening soon under new management".

It is unnecessary to determine whether the Respondent was aware of the Complainant's Trade mark when he registered the Domain Name. The timeline of the events just described points in that direction, since it seems highly unlikely that the Respondent had not already formed the intention of occupying Mr. Majidi's former shop when he registered the Domain Name and incorporated his company. Suffice it to say that the Respondent has used the Domain Name as a sign displayed in the window of the shop which still bore the Trade mark as signage. In that context, I find that residents of Dorset seeing that sign at the shop would be confused as to the identity of the person/entity behind the Domain Name.

I also find that Internet users familiar with the Complainants' business, seeing the Domain Name and the site to which it is connected, would be likely to believe that the Domain Name is registered to, operated or authorised by, or otherwise connected with the Complainants.

As to Policy 4 a i. A, the Respondent clearly knew of the Trade mark before displaying the Domain Name in the window of the shop and was therefore aware of the Complainants' cause for complaint before offering his goods.

As to Policy 4 a. ii, the Domain Name is descriptive but, in using it in juxtaposition to the Trade mark outside the shop, the Respondent is not making fair use of it.

In all the circumstances of this case, I find that the Domain Name has been used in a manner which has taken unfair advantage of or has been unfairly detrimental to the Complainants' Rights.

7. Decision

I find that the Complainants have Rights in a name that is similar to the Domain Name and that the Domain Name is an Abusive Registration in the hands of the Respondent. I note that the Respondent does not dispute the assertion that Mr. Majidi has licensed the Lead Complainant and therefore

direct that the Domain Name, <californiafriedchicken.co.uk> be transferred to the Lead Complainant.

Signed

Dated August 13, 2016