

DISPUTE RESOLUTION SERVICE**D00019549****Decision of Independent Expert**

TCM Group International EHF.

and

Bob Scott

1. The Parties

Complainant: TCM Group International EHF.
Sudurlandsbraut 4A
Reykjavik
108
Iceland

Respondent: Mr Bob Scott
c/o Web Advance Limited
The Old Presbytery Studios
2 Warren Park
Warlingham
Surrey
CR6 9LD
United Kingdom

2. The Domain Name

tcmuk.co.uk (the "Domain Name")

3. Procedural history

On 17 November 2017, the Dispute was received by Nominet. It was validated on 21 November and notification of the complaint was sent to the parties. On 08 December, a Response reminder was sent but by 13 December no Response had been received and notification of this was sent to the parties on the same day. On 15 December, the Expert

decision payment was received and on 20 December the Expert – Tim Brown – was appointed.

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.

4. Factual background

The Complainant is an international debt collection company incorporated in Reykjavik, Iceland which provides debt recovery solutions in numerous countries around the world. The Complainant is the successor to TCM Group International Ltd, a company that was incorporated in the Bailiwick of Jersey in January 2002 and TCM Group International (L) Limited a company that was incorporated in Labuan, Malaysia at some point in 1987.

The Complainant's services are provided in each country where it has presence by companies which enter into "Member" or "Agent" agreements with the Complainant.

The Complainant says that from 2001 to 2004 it had been providing its services in the United Kingdom ("UK") under the "TCM" name through a representative member but in 2004 that member and the Complainant terminated their arrangement.

In April 2004, a company incorporated in the UK called Key2 Recoveries Limited ("Key2") executed a Member's Agreement with the Complainant's predecessor in order to become a representative for the Complainant's predecessor's services in the UK.

Documents from Companies House showing the Respondent was an appointed director of Key2 between June 2003 to May 2012 have been exhibited by the Complainant.

The Member's Agreement between the Complainant's predecessor and Respondent has been exhibited. The contract notes that any logos, visual representations or other depictions which may serve as a service mark, trade mark or any other such representation belong to the Complainant. In addition, the contract provides that upon termination of the agreement parties to the contract agree to cease use of any related trade marks.

In July 2013, the Complainant terminated the agreement between it and Key2. A letter to Key2 from the Complainant terminating the agreement has been exhibited.

The Domain Name was registered on 18 May 2006 and resolves to a website which features a logo incorporating a globe device and the words "TCM UK / Global Debt Collection" which is notably similar to the Complainant's own logo. Both logos are represented below:



Respondent's logo



Complainant's logo

The website notes in the top left paragraph that:

TCM UK is the sole United Kingdom representative of the TCM Group which is the world's largest independent network of debt recovery agents. Learn more about the Group [here](#).

The latter word "here" links to the Complainant's website at www.tcmgroup.com. The remainder of the website describes the Respondent's business but includes references to the Complainant.

As noted in the procedural history above, the Respondent did not respond to these proceedings.

5. Parties' contentions

5.1 Complainant – Rights

The Complainant has exhibited a European Union Trade Mark, number 7318306, for the term TCM. It has a filing date of 15 October 2008 and a registration date of 07 April 2009; it is registered in classes 9 and 36.

The Complainant has provided a witness statement from its Chief Executive Officer which sets out the Complainant's history and details its predecessors including the companies in Jersey and Malaysia noted above. The Complainant says that all assets and goodwill were assigned to it from these predecessors.

The Complainant observes that it and its predecessors have been providing services under the "TCM" name continuously since 1987. The Complainant has provided a plethora of press releases relating to its business and activities under the "TCM" name. Exhibited articles include, for example, one titled "*TCM Group International – 30 successful years in business*". It has also listed details of its world congresses that it has held every year since at least 1998 in cities including, *inter alia*, Oslo, Amsterdam, Budapest, Prague, Los Angeles, Dubai and Warsaw.

5.2 Complainant – Abusive Registration

The Complainant contends that the Domain Name is being used for the purpose of unfairly disrupting the business of the Complainant per paragraph 5.1.1.3 of the Policy; and that there are circumstances indicating that the Respondent is using the Domain Name in a way which has confused or is likely to confuse people or business into believing that the Domain Name is registered to, or operated or authorised by or otherwise connected with the Complainant per paragraph 5.1.2 of the Policy.

The Complainant has exhibited screenshots of the website associated with the Domain Name, which is as described above in the Factual Background, and says that it indicates that the Respondent is still claiming to be connected with the Complainant despite the agreement between the Parties having been terminated in 2013.

The Complainant says that its representative wrote to the Respondent by email on 14 June, 24 July and 02 July 2013, requesting that it cease use of the "TCM" trade mark. Furthermore, the Complainant's representative wrote to the Respondent on 21 August 2017 requesting that the Respondent cease use of the Domain Name. Copies of this correspondence have been provided. The Complainant says that it did not receive a response to its correspondence.

The Complainant avers that the UK is one of its largest potential markets and it is therefore important that the Complainant has a member for the UK who can provide the Complainant's services in the UK. The Complainant says that it wants to appoint a UK member but cannot because each of its potential UK agents has stated, *inter alia*, that they are only prepared to invest in becoming the Complainant's members if the Respondent's website no longer operates and that the Domain Name is transferred to the Complainant. The Complainant avers that its members are concerned that the continued use of the Domain Name and the

Respondent's website will, firstly, dilute the rights of the Complainant in the Complainant's mark and, secondly, lead to confusion by potential customers who may believe that the website is connected with the Complainant and mistakenly use the Respondent's services believing them to be provided by the Complainant.

Furthermore, the Complainant says that it has no control over what appears on the website and that if there are any complaints about the misuse of the website by the Respondent then this could damage the reputation of the Complainant and the Complainant's mark. The Complainant avers that it is concerned that any such complaints could have dire consequences for the Complainant because potential customers may believe that the Complainant has approved the Respondent as a member of the Complainant's business.

5.3 Respondent

As noted above, the Respondent did not reply to these proceedings.

6. Discussions and findings

For a Complaint to succeed under the DRS a complainant must show that, on the balance of probabilities, it has Rights in respect of a name or mark which is identical or similar to the domain name and that the domain name, in the hands of the respondent, is an Abusive Registration.

I will discuss these two elements in turn after noting two preliminary issues.

6.1 Preliminary issues

6.1.1 Respondent not taking part in proceedings

As noted above, the Respondent did not reply to the proceedings. I have therefore referred to paragraph 5.6 of the Experts' Overview Version 3 (the "Expert's Overview". This is a document published on Nominet's website which discusses common issues that arise under the DRS). Paragraph 5.6 asks "*If the Respondent fails to respond to the complaint, is it inevitable that the complaint will succeed?*" and answers:

No. Whether the Complainant seeks a full decision or a summary decision, it is still necessary for the Expert to be satisfied that the elements necessary to make a finding of Abusive Registration are present. See, for example, the decision in DRS 04635 (martinyale.co.uk), a case where, in spite of the lack of a response, the Complainant failed to establish Abusive Registration to the satisfaction of the Expert. The case was decided under the previous version of the Policy, but the essential criteria remain the same.

It is clear that in the event of a respondent not taking part in proceedings a complainant does not get a "default" decision in its favour. I will therefore proceed on the basis that the Complainant still must prove its case in terms of the Policy.

6.1.2 Relationship between Respondent and "Key2"

The registrant of the Domain Name and therefore the Respondent in this matter is Mr Bob Scott. Most of the Complainant's contentions relate to a company called Key2 Recoveries Limited ("Key2") of which the Complainant says Mr Scott was a director and has accordingly produced extracts from Companies House to show this.

I have no reason to doubt the Complainant's contentions that Mr Scott was indeed a director of Key2 at the relevant time. The Respondent has not taken part in these proceedings and has therefore not raised any objections to this point.

As a director of Key2, Mr Scott was both the registrant of the Domain Name and a controlling force in Key2. I take the view that it is reasonable to conflate the two entities and that the Complainant's contentions relating to Key2 apply to the Respondent and *vice versa*.

6.2 Rights

The Complainant has exhibited a registered European Union Trade Mark, number 7318306, for the term "TCM". It has a filing date of 15 October 2008 and a registration date of 07 April 2009.

I note that the Domain Name was registered on 18 May 2006 and therefore the exhibited registered mark post-dates the creation of the Domain Name. It is therefore convenient at this point to discuss whether the Complainant had any other Rights beyond its European Union trade mark at the point of the Domain Name's registration.

The Policy defines Rights as "rights enforceable by the Complainant, whether under English law or otherwise" and such Rights can be derived both through registered rights, such as the trade mark noted above, or through unregistered or "common law" rights. On this point, I have again referred to the Expert's Overview, which asks "*What is required for a Complainant to prove that he/she/it 'has rights' in paragraph 2.1.1 of the Policy?*" and observes:

As indicated above, the relevant right has to be an enforceable right (i.e. a legally enforceable right). Bare assertions will rarely suffice. The Expert needs to be persuaded on the balance of probabilities that relevant rights exist. The Expert will not expect the same volume of evidence as might be required by a court to establish goodwill or reputation, but the less straightforward the claim, the more evidence the better (within reason – this is not an invitation to throw in the 'kitchen sink').

...

If the right is an unregistered trade mark right, evidence needs to be put before the Expert to demonstrate the existence of the right. This will ordinarily include evidence to show that (a) the Complainant has used the name or mark in question for a not insignificant period and to a not insignificant degree (e.g. by way of sales figures, company accounts etc) and (b) the name or mark in question is recognised by the purchasing trade/public as indicating the goods or services of the Complainant (e.g. by way of advertisements and advertising and promotional expenditure, correspondence/orders/invoices from third parties and third party editorial matter such as press cuttings and search engine results).

The Complainant has provided a good deal of evidence that it and its predecessors have used the "TCM" mark for a not insignificant period and to a not insignificant degree. The exhibited press releases before me show that the Complainant and its predecessors have clearly used the "TCM" mark since at least 1987, when its Malaysian predecessor was founded, and that it has been used extensively since, as exemplified by its annual symposiums held since 1998 in multiple cities around the globe. It is equally clear, in my view, from the Complainant's evidence that the "TCM" name or mark in question is recognised by the purchasing trade/public as indicating the goods or services of the Complainant.

I therefore find that in addition to its registered Rights noted above, the Complainant also has unregistered Rights in the term "TCM" which long pre-date the registration of the Domain Name.

The Domain Name only differs from the Complainant's "TCM" mark by the addition of the letters "UK", presumably standing in this context for "United Kingdom". I take the view that the letters "UK" are generic and descriptive and do not distinguish the Domain Name from the Complainant's mark.

I therefore conclude that the Complainant has Rights in respect of a mark which is similar to the Domain Name.

6.3 Abusive Registration

In addressing the Complainant's contention regarding Abusive Registration, I will turn first to the issue of whether the Domain Name is likely to confuse people or businesses into believing that the Domain Name is registered to, or operated or authorised by or otherwise connected with the Complainant in terms of paragraph 5.1.2 of the Policy.

I take the view that the Domain Name, in and of itself, is inherently confusing in that it is likely that web users who find the Domain Name through a search engine or who type it directly into their browser will assume that the Domain Name is registered to, operated or authorised by, or otherwise connected with the Complainant even before they arrive at the Respondent's website. This species of confusion is often called "initial interest confusion".

On this point, I have again referred to the Expert's Overview. Paragraph 3.3 discusses such confusing use at some length and observes:

Commonly, Internet users will visit web sites either by way of search engines or by guessing the relevant URL. If the domain name in dispute is identical to the name of the Complainant and that name cannot sensibly refer to anyone else, there is bound to be a severe risk that a search engine, which is being asked for the Complainant, will produce high up on its list the URL for the web site connected to the domain name in issue. Similarly, there is bound to be a severe risk that an Internet user guessing the URL for the Complainant's web site will use the domain name for that purpose.

In such cases, the speculative visitor to the registrant's web site will be visiting it in the hope and expectation that the web site is a web site "operated or authorised by, or otherwise connected with the Complainant." This is what is known as 'initial interest confusion' and the overwhelming majority of Experts view it as a possible basis for a finding of Abusive Registration, the vice being that even if it is immediately apparent to the visitor to the web site that the site is not in any way connected with the Complainant, the visitor has been deceived. Having drawn the visitor to the site, the visitor may well be faced with an unauthorised tribute or criticism site (usually the latter) devoted to the Complainant; or a commercial web site, which may or may not advertise goods or services similar to those produced by the Complainant. Either way, the visitor will have been sucked in/deceived by the domain name.

...

Findings of Abusive Registration in this context are most likely to be made where the domain name in issue is identical to the name or mark of the Complainant and without any adornment (other than the generic domain suffix). See for example DRS 00658 (chivasbrothers.co.uk).

The further away the domain name is from the Complainant's name or mark, the less likely a finding of Abusive Registration. However, the activities of typosquatters are generally condemned - see for example DRS 03806 (privalege.co.uk) - as are those people who attach as appendages to the Complainant's name or mark a word

appropriate to the Complainant's field of activity. See for example the Appeal decisions in DRS 00248 (seiko-shop.co.uk) and DRS 07991 (toshiba-laptop-battery.co.uk).

...

The Domain Name only differs from the Complainant's mark by two letters, namely "UK", which web users would be likely to associate with an entity, such as the Complainant, with a significant presence in the UK. I take the view that the Domain Name is visually very close to the Complainant's mark and that web users are likely to be confused by the Domain Name itself.

When web users do find their way to the Respondent's website it is unlikely that such confusion will be dissipated. As described in the Factual Background above, the Respondent has made prominent use of a logo that is visually very similar to the Complainant's. Equally, the Respondent says, *inter alia*, that it is a "...representative of the TCM Group which is the world's largest independent network of debt recovery agents".

Given the date of the Domain Name's registration, it is likely that the Respondent created the website when it was a member of the Complainant's organisation and, perhaps, it may have had some grounds on which it could legitimately associate itself with the Complainant at that point.

However, the Complainant terminated its agreement with the Respondent in July 2013 and the Respondent can no longer claim that it is associated with the Complainant. That it clearly and unambiguously continues to do so will inevitably give the impression that the Domain Name is registered to, or operated or authorised by or otherwise connected with the Complainant in terms of paragraph 5.1.2 of the Policy. Such use renders the Domain Name an Abusive Registration.

I also conclude that the Domain Name itself and the confusing use to which it has been put will be unfairly detrimental to the Complainant's Rights. This detriment is specifically evidenced by the Complainant's contentions that its potential new UK agents have raised objections about the Domain Name and that this has apparently caused difficulties in recruiting new agents. While the existence of the Domain Name does not prevent the Complainant from operating in the UK, the Domain Name is evidently causing difficulties to the detriment of the Complainant's business. Again, this renders the Domain Name an Abusive Registration in terms of the Policy.

7. Decision

Having determined that the Complainant has Rights in respect of a mark that is similar to the domain name and that the Domain Name, in the hands of the Respondent, is an Abusive Registration, I order that the Domain Name is transferred to the Complainant.

Signed,

Tim Brown – 20 December 2017