



## WIPO Arbitration and Mediation Center

### ADMINISTRATIVE PANEL DECISION

Fall Nummer: DIE2003-0001

Entscheidung vom 19. Dezember 2003

#### 1. The Parties

The Complainant is Electricity Supply....

The Respondents/Registrants (hereafter referred to as "the Respondents") are ....

#### 2. The Domain Name and Registrar

The disputed domain name <shopelectric.ie> is registered with IE Domain Registry Limited.

#### 3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on August 26, 2003. On August 28, 2003, the Center transmitted by email to IE Domain Registry Limited a request for registrar verification in connection with the domain name at issue. On September 5, 2003, IE Domain Registry Limited transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details for the administrative, billing, and technical contact.

In response to a notification by the Center that the Complaint was administratively deficient, the Complainant filed an amendment to the Complaint on September 23, 2003. The Center verified that the Complaint together with the amendment to the Complaint satisfied the formal requirements of the IE Dispute Resolution Policy (the Policy), the WIPO Dispute Resolution Rules of Procedure for .IE Domain Name Registrations (the Rules), and the WIPO Supplemental Rules for .IE Domain Name Dispute Resolution Policy (the Supplemental Rules). In accordance with the Rules, paragraphs 2.1 and 4.1, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on October 2, 2003. In accordance with the Rules, paragraph 5.1, the due date for Response was October 30, 2003. The Response was filed with the Center on October 30, 2003.

The Center appointed Edmund Fry as the sole panelist in this matter on November 10, 2003. The Panel finds that it was properly constituted. The Panel has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the Center to ensure compliance with the Rules, paragraph 7.

#### 4. Factual Background

The Complainant states it is a vertically integrated electricity utility operating internationally but principally in the Republic of Ireland. One element of the Complainant's business is "ESB Retail", a branch of the Complainant that sells electrical appliances through retail shops throughout the Republic of Ireland. According to the Complainant, ESB Retail is the largest electrical retailer in the Republic of Ireland with 81 shops operating nation-wide. The Complainant trades under the "shopelectric" brand name and has done so since in or around 1968, and states that it has built up a substantial body of goodwill in this name with its customers. The Complainant registered "SHOPELECTRIC" as a trademark in the Republic of Ireland on October 21, 1997. The Complainant says it did this in order to protect the goodwill that it had built up in the "shopelectric" brand in the Republic of Ireland.

The Complainant accepts that the "shopelectric" brand has been used outside the Republic of Ireland by third parties. The most relevant use for the purposes of this case has been by the Respondents and their predecessors in relation to retail outlets in Northern Ireland. There is no connection whatsoever between the Complainant and the Respondents, although both have for some time traded under the "shopelectric" name in the Republic of Ireland and in Northern Ireland, respectively.

Respondant L. was incorporated in September 1997, following a management buy-out of Northern Ireland Electricity Retail Limited, who had previously provided electrical retail services under the name "Shop Electric" for about 30 years. As part of the management buy-out Lislyn Retail Limited acquired from Northern Ireland Electricity Retail Limited the rights to the name "Shop Electric". By January 2003, L. had a network of 29 High Street "Shop Electric" stores and six superstores that were all located across Northern Ireland. During the financial year April 2001 to March 2002, its turnover was in the region of £48.9m.

On April 30, 2003, Respondant Shop Electric .... was incorporated. This company is the parent company of Northern Retail Limited, which is an English registered company cited in the Complaint as the "User". On May 14, 2003, Shop Electric Group Plc acquired the business and assets of the other Respondent, Lislyn Retail Limited, namely the shopelectric stores in Northern Ireland.

According to the Complaint, the <shopelectric.ie> domain name automatically connects an Internet user to the "www.pluggedin.co.uk" website. This is described as the online store of Northern Retail Limited. At the time that the Complaint and Response were received by the Panel, the Panel found that no use whatsoever was being made of the <shopelectric.ie> domain name; an Internet user is greeted with a proxy report stating that the domain name cannot be contacted. Nonetheless, the Respondents in their Response have not refuted that the "shopelectric.ie" domain name "resolved to the Group's customer facing website at "www.pluggedin.co.uk".

## **5. Parties's Contentions**

### **A. Complainant**

The Complainant objects to the Respondents's registration and use of the <shopelectric.ie> domain name. The Complainant states that, to the best of its knowledge, the Respondents have no physical presence in Ireland and no real or substantive connection with Ireland. Furthermore, the Complainant states that the Respondents have held the domain name "for some years" and believes that no website has ever been connected with the domain name.

The Complainant believes that the Respondents's use of the domain name will attract Irish users to its website and that this will cause confusion with the Complainant's registered trademark. In addition the Complainant considers that the domain name is being used by the Respondents in a way that is likely to dilute the reputation of the Complainant's rights in its trademark in that a member of the public would reasonably infer from the automatic link from the domain name to the Respondents's website that no website for the Irish "shopelectric" shops existed.

The Complainant goes on to state that its "www.esb.ie" website contains a shopelectric section through which users can obtain information in relation to the Complainant's shops and products. The Complainant believes that the efficiency of this aspect of its website is undermined by the Respondents's use of the domain name to channel Irish Internet users to the Respondents's online store. Furthermore the Complainant contends that the domain name has been registered and/or is being used primarily in order to prevent the Complainant from reflecting its trademark "SHOPELECTRIC" in a corresponding domain name.

The Complainant also states that the Respondents's website did not allow any deliveries to addresses in Ireland, and that "Irish users seeking to purchase electrical appliances therefore will be unable to place orders via the website". The Complainant believes that the Respondents do not believe their use of the domain name is of any positive benefit to their business. Furthermore, the Complainant states that the Respondents do not appear to have gained any positive benefit from the domain name, as, according to the Complainant, it was unused for several years. The Complainant believes that its inability to use the domain name represents a significant curtailment of its legitimate business interests.

### **B. Respondents**

The Respondents state that the <shopelectric.ie> domain name is not identical to the Complainant's registered trademark in that the Complainant's registered trademark is for a stylised mark. The

Respondents cite the decision in *Cream Holdings Limited .v. National Internet Source, Inc*, WIPO Case No. D2001-0964 as authority that where a Complainant's registered trademark is a word in a stylised form that this could not be considered identical to the disputed domain for the purposes of the ICANN UDRP policy. The Respondents suggest that the Complainant's registered mark is not identical to the disputed domain name and therefore the Complainant must provide sufficient evidence to support a claim that it has unregistered rights in the "shopelectric" name. Furthermore it states that the Complainant has not provided any evidence to support the assertion that it has built up a substantial body of goodwill in this name. The Respondents make reference to the Complainant's website at "www.esb.ie" and the relative absence of reference to "Shop Electric". The Respondents also refer to a copy of a press release dated April 12, 2002, on the Complainant's website which is entitled "ESB Retail officially opened its flagship Shop Electric store today...It is the fourth and largest store to open as part of the major expansion plan by ESB Retail."

The Respondents continue by stating that they have rights in law and legitimate interests in respect of the domain name <shopelectric.ie>. The Respondents state that it was even acknowledged by the Complainant in its Complaint that "the Registrant has a right to the trademark "SHOPEELECTRIC" in Northern Ireland". The Respondents further state that the Respondents or their predecessors have been trading under the "Shop Electric" name in Northern Ireland for over 30 years. They state that they are the registered proprietors of several trademarks in the United Kingdom for the name "Shop Electric" which is registered in respect of various classes. The Response exhibits copies of extracts from the trademarks registry in relation to "Shop Electric".

The Respondents also state that since they started trading under the "Shop Electric" name in Northern Ireland, the Respondents and their predecessors "[have] built up substantial goodwill and reputation in the words "Shop Electric". They state further that Lislyn's turnover for the sales of goods and services in Northern Ireland are in the region of £48.9m and exhibit accounts to support same. They also state that the Respondents have invested a substantial amount of money advertising and promoting the name "Shop Electric" in Northern Ireland. They state that during the financial year to March 2003, Lislyn Retail Limited spent in the region of £776,000 advertising and promoting the name in Northern Ireland.

The Respondents state that neither their registration nor their use of the <shopelectric.ie> domain name has been in bad faith. In refuting this argument they state that they have been using the name "Shop Electric" for the past 30 years and as a result they considered that it was good business practice to register the relevant country code and domain name in the areas in which it traded, including Northern Ireland.

The Respondent then discussed its rights, as a Northern Irish entity, to register a domain name with a ".ie" country code. They state that ".ie is intended to be the country code for the island of Ireland". As part of this argument, the Respondents quote extracts from the domain registry's website and rules wherein it is provided that (among other things) an applicant must have a substantial connection to Ireland. Since November 5, 2001, Ireland has been construed as the 32 counties of the island of Ireland. They conclude their argument by stating "at the date of registration of the disputed domain name, Shop Electric Limited was providing retail services under the name Shop Electric in Northern Ireland". Accordingly it was entitled to register the domain name <shopelectric.ie> to reflect its trading name and it registered the disputed domain name in good faith".

The Response continues by stating that the use of the <shopelectric.ie> domain name has not been in bad faith. It accepts that the disputed domain name resolves to the "group's customer facing website at "pluggedin.co.uk"". It also accepts that the site at "pluggedin.co.uk" does not, as yet, allow products that are ordered online to be distributed in Northern Ireland but feels that this does not constitute bad faith use of the name. It states that, since the acquisition in March 2003, referred to earlier, efforts have been made to put in place the necessary infrastructure to enable products ordered over the Internet to be delivered to Northern Ireland. It argues that as Shop Electric Limited has a significant presence in Northern Ireland it is entitled to register the domain name and to use the name to promote its service as it sees fit, in line with the Group's trading policies. It states that the "www.pluggedin.co.uk" website is clearly branded as part of the Shop Electric group of companies.

## 6. Discussion & Findings

In accordance with paragraph 1.1 of the ie Dispute Resolution Policy (the "ieDRP"), in order to succeed in this

proceeding and to obtain the transfer of the domain name, the Complaint must satisfy the Panel that the three elements quoted therein are satisfied. The Panel shall refer to each of these elements in turn. Paragraph 1.4 of the ieDRP states that " the Complainant carries the burden of proving, prima facie, that the three conditions specified in paragraph 1.1 are met"

1. That the domain name is identical or misleadingly similar to a Protected Identifier in which the Complainant has rights.

2. Does the Registrant have any rights in law or legitimate interests in respect of the domain name?

"Where the Registrant can demonstrate that, before being put on notice of the Complainant's interest in the domain, it had made demonstrable good faith preparations to use the domain name in connection with a good faith offering of goods or services or operation of a business" *emphasis added*

The Respondents do not admit any use of the <shopelectric.ie> domain name itself. Furthermore, they admit that <shopelectric.ie> merely redirects an Internet user to the "www.pluggedin.co.uk" website. Of itself, this redirection to another of the Respondents's sites would probably not cause any difficulty to the Panel, but in this case (and as admitted by the Respondents in paragraph 12.5 of their Response), "the "pluggedin.co.uk" site does not as yet allow products which are ordered online to be distributed in Northern Ireland".

The Response continues by stating that this "process [i.e. of developing a system to allow the sale of its products to Northern Ireland] is reasonably time consuming". Presumably, the Respondents used the term "as yet" to mean that they intend to develop a system in the future, which would allow deliveries to Northern Ireland. Nonetheless, the Panel holds that any expectation of future activity is usually irrelevant unless it occurred before the date that the Respondents were put on notice of the Complainant's interest in the domain. No evidence of "demonstrable good faith preparations" have been submitted in relation to the use of the "www.shopelectric.ie" website. Furthermore, the Panel cannot accept that there has been any "good faith offering of goods or services or operation of a business" where it is impossible for an Internet user anywhere on the island of Ireland to purchase goods from the site. See *World Wrestling Federation Entertainment v. Ringsend Collectibles* WIPO Case No. D2000-1306, 24 January 2001, as quoted in the *DK Bellevue, Inc d/b/a Digital Kitchen v. Sam Landers* WIPO Case No. D2003-0780 ("holding mere assertion of preparations to make bona fide commercial use insufficient to demonstrate legitimate interest").

Following this interpretation of paragraph 3.1 of the ieDRP, the Panel might find that the Respondents do not have any legitimate right to the domain name. Nonetheless, the Panel would note that the three factors quoted in paragraph 3.1 are to be considered "without limitation". The Panel finds that it must consider the undisputed long use of the "SHOP ELECTRIC" mark by the Respondents for over thirty years. Furthermore, the Panel recognises that the Respondents hold registered trademarks in the "Shop Electric" name in Northern Ireland, which forms part of the relevant jurisdiction for the purposes of .the ieDRP. As discussed above, the ieDRP does not stipulate that long use and the existence of trademarks are factors which should receive "particular" consideration. Nonetheless, the list is expressly not exhaustive and, despite the Panel's misgivings as to the shortcomings of paragraph 3.1, the Panel finds that these factors are also essential when considering whether legitimate rights exist. Despite the lack of "demonstrable good faith preparations..." the Panel finds that the Respondents do have legitimate rights in the "shop electric" name due to the undisputed long use and the existence of trademarks in Northern Ireland.

Accordingly, the Panel finds that the Complainant has not satisfied its burden under paragraph 1.1.2 as the Respondents do have rights in law and legitimate interests in respect of the domain name and the Complaint fails.

### 3. Was the Domain Name Registered or Used in Bad Faith.

## 7. Decision

For all the foregoing reasons, in accordance with Paragraphs 5.1 of the Policy and 14 of the Rules, the Panel finds that the Complaint has failed to establish that the Respondents have no rights or legitimate interests in the said domain name and the Complaint is denied. The registration of the domain name <shopelectric.ie> is confirmed.

(Sole Panelist)

Due to the finding, under the second element that the Respondents have legitimate interest in the domain name the panel need not determine whether Respondents have registered or used the domain name in bad faith. The UDRP at paragraph 4(c) specifies three circumstances which, if proven, demonstrate that a Respondent has rights or legitimate interests in the domain name. Of course the UDRP does not govern this dispute. Similarly, the ieDRP at paragraph 3.1 provides three factors which "in particular but without limitation, may be considered as evidence of rights to, or legitimate interest, in the domain name". Although not exhaustive these circumstances are highly relevant and influential indications of whether a Respondent has any legitimate rights in the domain name. If the Panel finds that any of these circumstances exist then the Panel must find that a Respondent has rights or a legitimate interest in the domain name and accordingly the Complaint must fail. The Panel has compared the circumstances in the respective dispute resolution policies. Paragraph 4(c) (i) in the UDRP is very similar to Paragraph 3.1 of the ieDRP. Both paragraphs relate to demonstrable good faith preparations to use the domain name. Thereafter, however, the differences are considerable. Under the UDRP rights or legitimate interests can be found where "[the Respondent has] been commonly known by the domain name, even if [the Respondent has] acquired no trademark or service mark rights". The final circumstance relates to where "[the Respondent is] making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert customers or to tarnish the trademark or service mark at issue". The second and third specified factors regarding legitimate rights under the ieDRP are as follows: "where the domain name corresponds to the personal name or pseudonym of the registrant" and "where the domain name which is identical or misleadingly similar to a geographical indication has been used, in good faith, by the registrant before such geographical indication was protected in the island of Ireland." Under the ieDRP the factors are very different ? there is no mention of a Registrant being "commonly known by the domain name". Nor is there any reference to "legitimate noncommercial or fair use". No discussion is made as to why these circumstances were not included in the ieDRP. In considering the existence of the Respondent's legitimate rights to the <shopelectric.ie> domain name, the Panel will not consider paragraphs 3.1.2 and 3.1.3 as they are not relevant in this case. The first factor in paragraph 3.1.1 is most relevant, however: The Respondents claim that the domain name <shopelectric.ie> is not identical to the "SHOPELECTRIC" trademark due to the fact that the Complainant's registered trade mark is a stylised mark. The Panel does not accept that this is the case. The Panel has the benefit of a copy of the Certificate of Registration from the Controller of Patents, Designs and Trademarks, Dublin as registered by the Complainant on October 21, 1987. The Panel finds that the letters making up the word "SHOPELECTRIC" are clearly visible and clearly identifiable from the Certificate and the stylised effect is minimal. As such, the letters making up the words are identical. A person wishing to input the letters which form part of the trademark as a domain name would not be in any way inhibited by its stylised form. The Panel finds that the terms are identical or at very least, misleadingly similar. Furthermore, the Panel finds that the "www.cream.com" case Cream Holdings Limited v. National Internet Source, Inc., WIPO Case No. D2001-0964 cited by the Respondent can be distinguished on the basis that it relates to a word which is "commonly used as a descriptive term" and also that it was a generic term. This is not so in relation to the term "shopelectric". It is not a generic term; it is an original descriptive term that identifies the services to be provided which does not

have common usage in everyday parlance. The Respondents assert that the Complainant failed to discharge its burden to prove (in circumstances where the Panel finds that the marks are not identical) that it has unregistered rights to the name. The point is academic given the above finding, although the Panel would state that the Complainant has discharged its burden in this regard, and the Panel is aware that the "Shop Electric" brand has been a well-known brand of the Complainant's throughout the Republic of Ireland for many years.