

Nominet UK Dispute Resolution Service

DRS Number 03658

Spa Finder Europe Ltd -v- Healthy Venues

Decision of Independent Expert

1. Parties

Complainant Type: Business
Complainant: Spa Finder Europe Ltd
Address: Suite C206
1-6 Barton Road
Water Eaton
Milton Keynes
Bedfordshire
Postcode: MK2 3HU
Country: GB

Respondent: Healthy Venues
Address: Entanet
Stafford Park 6
Telford
Shropshire
Postcode: TF3 3AT
Country: GB

2. Domain Name

spafinders.co.uk ('the Domain Name')

3. Procedural Background

The complaint was lodged by Mr Kevin Turnbull, a Director of Spa Finder Europe. It was lodged electronically with Nominet on 5 May 2006. Hard copies were received on 8 May 2006.

The Respondent was notified of the complaint by written correspondence to the above postal address, and email to three separate email addresses, one of which returned 'undeliverable' messages. Nominet received no response.

Accordingly, on 1 June 2006, the Complainant was invited to pay the fee for an expert decision. The fee was received on 6 June 2006 and on that day Claire Milne was appointed to act as expert in the case, having confirmed that she knew of no reason why she could not properly do so; and that she knew of no matters which ought to be drawn to the attention of the parties, which might appear to call into question her independence and/or impartiality.

4. Outstanding Formal/Procedural Issues (if any)

In this case it is open to reasonable doubt whether the Respondent has received any of the correspondence to date.

The Complaint form does not include the Respondent's postal address. (Copies of earlier correspondence supplied as evidence were addressed to Mr Jason Goldberg of Spa Seekers Ltd at Jasten House, 40 Moor Street, Coventry, CV5 6EQ.) Nominet therefore used the postal address of the Administrative Contact given in its registration record for the Domain Name, which is that of the Respondent's registration agent, the Internet Service Provider

Entanet. Entanet doubtless has many clients, and may well not normally forward mail to them sent to it in error (whether postal or electronic).

One of the three email addresses that Nominet used when trying to reach the Respondent also belonged to Entanet. The other two were at healthyvenues.co.uk and spafinders.co.uk. The URLs www.healthyvenues.co.uk and www.spafinders.co.uk both currently resolve to a home page at www.spaseekers.com (where clicking on 'contact us' leads to the postal address Spa Seekers Ltd, Jastan House, 40 Moor St, Coventry CV5 6EQ but no email address). The email to the healthyvenues.co.uk address led to a delivery failure message, saying 'mailbox disabled for this recipient'.

5. The Facts

Evidence of the following domain and US trademark registrations by the US company Spa Finder Inc (whose correspondence address is in New York) is supplied with the complaint:

- In September 1997 they registered the domain name spafinder.com.
- In November 1997 they registered the US mark SPA FINDER, giving a first use date of March 1987.
- In October 2005 they registered the US mark LUXURY SPAFINDER THE SPA LIFESTYLE AT ITS FINEST, giving a first use date of August 2004. The graphic version of this mark gives prominence to the central word SPAFINDER, with the other words fitted around it in much smaller typefaces.
- In March 2006 they filed to register the US mark SPAFINDER, giving a first use date of May 1998.

The Complainant has also supplied copies of the following documents as evidence of their use of the name SPAFINDER:

- A two-page company profile, which includes a mention of the spafinder.com website, stating that it is in the top 3% of all websites on the Internet, with over 40 million pageviews and close to 4.5 million unique visitors annually.
- Front covers of the 2006 SPAFINDER Worldwide Directory, Luxury SPAFINDER magazine (undated), and the Spa Enthusiast newsletter (spring 2005). All these include the URL www.spafinder.com. The complaint states that SpaFinder magazine and its retitled successor Luxury SpaFinder magazine have been published since the early 1990s.
- A printout of the home page of www.spafinder.com on 5 May 2006.

Copies of the following items of correspondence have also been supplied:

- A letter (A) dated 21 November 2005 from Neil Kurlander, General Counsel for Spa Finder Inc, to Jason Goldberg of Spa Seekers Ltd, headed "Trademark: SPA FINDER and SPA FINDERS". This letter refers to a previous contact on the same subject in November 2003. It claims that Spa Finder has a prominent reputation throughout the entire spa industry and that Spa Seekers' use of www.spafinders.co.uk may either dilute the distinctiveness of Spa Finder's service marks, or mislead people into believing that Spa Seekers is associated with Spa Finder. It mentions that correspondence from third parties expressing confusion has already been received. Assurance of no more use of the name is requested by 9 December 2005.
- A letter (B) dated 23 November 2005 from Jason Goldberg of Spa Seekers to Neil Kurlander of Spa Finder, responding to letter A. In this letter Mr Goldberg says that his use of the name Spa Finder is not intended to cause any harm or confusion to Mr Kurlander's customers; that his company represents around 250 UK spas; and that the

name Spa Finder is generic and appropriate for his spa search tool. He requests evidence of confusion between Spa Finder and Spa Seekers (not including spabreak.co.uk).

- A letter (C) dated 23 November 2005 from Neil Kurlander to Jason Goldberg, responding to letter B. This letter attempts to explain to Mr Goldberg that his use of the Spa Finder name is in violation of US intellectual property laws, and repeats the deadline of 9 December 2005. It also states that Spa Finder already had a substantial presence in the UK market in 2003, and this has since grown substantially. It mentions a similarity between the fonts used in the Spa Seekers and Spa Finders trademarks, and alleges that Mr Goldberg has chosen to use this name and font in order to capitalise on Spa Finder's universal recognition.
- A letter (D) from Neil Kurlander to Jason Goldberg, dated 19 January 2006. The content of this letter is almost identical to that of letter A. Letter D makes no reference to any other letter.
- A letter (E) from Neil Kurlander to Jason Goldberg, also dated 19 January 2006. The content of this letter is very similar to that of letter C, though it starts by acknowledging receipt of a letter of 25 November **2003**. However letter E includes an additional statement that Spa Finder provides marketing services to 5 spas in the UK. It also mentions a letter from Mr Goldberg which is not letter B (and not included as evidence), and reproduces (in order to contradict) his assertion that "the UK market in general [is] unaware of [Spa Finder]". It states that the fact that UK websites are accessible in the US means that their proprietors are subject to US jurisdiction. Like letter C, it offers Mr Goldberg a second opportunity to cease use of the Spa Finder name, though the deadline here is 15 December. Letter E makes no reference to letter D.

The Complainant states that it has a large marketing budget, its marketing initiatives are distributed worldwide including the UK, that it is active in the UK through its subsidiary Spa Finders Europe Ltd, and that a list of current UK spa partners can be seen at the www.spafinder.com website. I have been unable to find these directly, but at www.spafindereurope.com, which leads through to www.spafinderuk.co.uk, under 'Regional Highlights', I have found three UK spas listed.

Company details for Spa Finder Europe Ltd supplied with the complaint show that it was incorporated on 9 March 2006 and has two Directors (Kevin Turnbull, nationality British, and Peter Ellis, nationality American).

On 15 August 2000, the Domain Name spafinders.co.uk was registered on behalf of Healthy Venues by Entanet. Nominet's records show Entanet details as both administrative and billing contacts, and show a renewal date for the registration of 15 August 2006.

The URL www.spafinders.co.uk redirects to www.spaseekers.com, the Respondent's website, which includes details of around 200 spas in the UK. The website claims that Spa Seekers has been a central point for UK spa reservations since 1989 and has the largest online selection.

6. The Parties' Contentions

The Complainant's contentions follow, as made in the complaint itself and provided copies of correspondence.

Rights

1. The Complainant has Rights in respect of the mark SPAFINDER (the supporting evidence for this claim has been listed above). It has invested heavily in promoting this name and has achieved substantial recognition for it worldwide, including the UK.

2. The incorrect use of the spafinders.co.uk URL was drawn to the attention of the Respondent in November 2003 and more recently in correspondence from November 2005 onwards. The Respondent trades under other names, Spa Seekers Ltd and Healthy Venues.

Abusive registration

The Domain Name in the hands of the Respondent is abusive because:

3. It has been registered with the purpose of driving traffic to non-related sites.
4. It has been registered to stop the Complainant registering it.
5. It is abusing the Complainant's market position and taking unfair advantage of the Spa Finder goodwill in the UK and international markets.
6. Their registration is confusing people by pointing the URL at non related websites.
7. The Respondent is falsely representing themselves as a related Spa Finder entity.

The Respondent has not responded. He may be unaware of this proceeding. From the evidence supplied, I gather that his view a few months ago was that he chose to register and use in his UK business an appropriate generic name, and that this will not cause confusion because the Complainant is American and is little known in the UK.

7. Discussion and Findings:

The Nominet Dispute Resolution Service Policy ('the Policy') paragraph 2 requires that for a complaint to succeed the Complainant must prove, on the balance of probabilities, that both:

- i. the Complainant 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.

Whether the Complainant succeeds depends very much on the evidence supplied, which is mainly contained in Letters A to E outlined above. That outline shows some puzzling discrepancies – letters D and E do not fit into what would otherwise be a coherent sequence of correspondence. I note that letters A, B and C are all photocopied from faxed originals, while letters D and E have been copied directly from word processor printouts. My inference is that letters D and E have acquired their dates by automatic fill of the 'date' field on the day when they were printed out. Letter D appears to be an early draft of letter A, and in all probability was not sent as it stands. Letter E may similarly be an early draft of letter C, and may or may not ever have been sent – as it stands it is hard for me to fully understand it. Given their doubtful status, I can attach little weight to letters D and E as evidence.

Complainant's Rights

The Complainant has provided evidence of US Rights in the names SPA FINDER and SPAFINDER, and of registration of the Domain Name spafinder.com. Nominet has provided registration details for the company Spa Finder Europe. I note that the complainant is also using the domains spafinders.com, spafindereurope.com, and spafinderuk.co.uk. I find all these similar, though plainly not identical, to spafinders.co.uk.

The term 'spa finder' can certainly be read as generic, but the Complainant has traded under that name for some time, albeit predominantly in the USA, and now has a European branch. The DRS requires only Rights at the present time and not at the time of registration. I therefore accept that the Complainant has adequate Rights for the purpose of Nominet's DRS.

Abusive Registration

Paragraph 1 of the Policy defines Abusive Registration to be 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 took unfair advantage of or was unfairly detrimental to the Complainant's Rights.

The Complaint makes a number of allegations relating to the original registration of the Domain Name, but has provided no evidence relevant to that period. I note that its UK subsidiary was set up only in March 2006, and it appears still to have a rather small presence in the UK market. I infer that at the time of registration, in August 2000, it was little known among UK spa users. (I note that the spa business has become international, but believe it is still a fair assumption that a large majority of bookings will be in the customer's own country).

Spa Seekers Ltd, being professionally involved in this market, may have been aware of Spa Finder as a US company in a similar business to itself but in the USA. However, I have been given no evidence that Spa Seekers should have expected Spa Finder to start operating in the UK. I therefore assume they did not expect this and so this could not have been a blocking registration. By the same token, there would have been no significant UK brand recognition of the name Spa Finders of which Spa Seekers could have taken advantage. I therefore cannot find Abusive Registration under Paragraph 1(i).

I must now consider whether, under Paragraph 1(ii), the Domain Name has been used in a manner which has taken unfair advantage of the Complainant's Rights. The Complainant alleges actual confusion, but has not supplied evidence of this and I therefore assume that whatever confusion may have occurred has been small. I do not find the website at www.spaseekers.com very similar to, or likely to be confused with, that at www.spafinders.com. Each is plainly strong in one geographic market – the first in the UK, the second in the US. Were there any confusion among customers looking for Spa Finder's UK spas and finding instead Spa Seekers' UK spas, it would be mainly to Spa Finder's advantage, as the customers would find a much longer list of UK spas. Spa Finder has not yet put itself in a position where it can benefit from booking commissions for all these spas by listing them in its directory.

I see no evidence that the Respondent is claiming any connection with Spa Finders, or indeed that he would wish to do so, given that his strength in the UK market is much greater than that of the US company. The indications are that he registered the name because it was a generic that was clearly relevant to his business. He is indeed using it with the purpose of driving traffic to his website, but on the basis of its generic meaning rather than on the strength of the US company's reputation. So I have not found unfair use.

To sum up my views on the different points in the Complaint:

3. It has been registered with the purpose of driving traffic to non-related sites. *I agree, but do not see this as unfair, since the name in the UK is still mainly generic.*
4. It has been registered to stop the Complainant registering it. *I disagree – I believe the Complainant's intention to move into the UK was not widely known in the UK at the time of registration.*
5. It is abusing the Complainant's market position and taking unfair advantage of the Spa Finder goodwill in the UK and international markets. *I disagree – Spa Finder has only recently set up in the UK and as yet has little goodwill there.*
6. Their registration is confusing people by pointing the URL at non related websites. *I disagree – no evidence has been provided of confusion and I do not find the websites confusingly similar.*

7. The Respondent is falsely representing themselves as a related Spa Finder entity. / *disagree – no evidence has been provided of this.*

8. Decision

Abusive registration has not been established. The complaint fails. No action is required.

Claire Milne
23 June 2006