

ADMINISTRATIVE PANEL DECISION

Haringey London Borough Council v. Host Master, 1337 Services LLC
Case No. D2023-1321

1. The Parties

Complainant is Haringey London Borough Council, United Kingdom, represented by Bevan Brittan, LLP, United Kingdom.

Respondent is Host Master, 1337 Services LLC, Saint Kitts and Nevis.

2. The Domain Name and Registrar

The disputed domain name <haringeylscb.org> (hereinafter the “Disputed Domain Name”) is registered with Tucows Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on March 28, 2023. On March 28, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. On March 28, 2023, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the Disputed Domain Name, which differed from the named Respondent (UNKNOWN REGISTRANT, REDACTED FOR PRIVACY), and contact information in the Complaint. The Center sent an email communication to Complainant on March 29, 2023, providing the registrant and contact information disclosed by the Registrar, and inviting Complainant to submit an amendment to the Complaint. Complainant filed an amended Complaint on April 3, 2023.

The Center verified that the Complaint together with the amended Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the “Policy” or “UDRP”), the Rules for Uniform Domain Name Dispute Resolution Policy (the “Rules”), and the WIPO Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the “Supplemental Rules”).

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified Respondent of the Complaint, and the proceedings commenced on April 11, 2023. In accordance with the Rules, paragraph 5, the due date for Response was May 1, 2023. Respondent did not submit any response. Accordingly, the Center notified Respondent’s default on May 5, 2023.

The Center appointed Lawrence K. Nodine as the sole panelist in this matter on May 22, 2023. 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.

On June 9, 2023, the Panel issued a procedural order directing Complainant to submit additional evidence relevant to Complainant's claimed residual goodwill in the mark HARINGEY LSCB (the "Procedural Order"). On June 16, 2023, Complainant submitted additional evidence in accordance with the Procedural Order.

4. Factual Background

In 2006, Complainant established the Haringey Local Safeguarding Children Board ("Haringey LSCB") to facilitate and promote local safeguarding arrangements for children in the London Borough of Haringey, which had a population of 264,310 in 2021. During this time, specifically, from 2009 to 2018, Complainant owned and operated the Disputed Domain Name. Then, in June 2019, the Haringey LSCB was reorganized to include other agencies and the multi-agency configuration was renamed the Haringey Safeguarding Children's Partnership ("Haringey SCP"). After that reorganization, Complainant inadvertently let the Disputed Domain Name lapse and adopted the domain name <haringeyscp.org.uk>. The services previously offered under the Disputed Domain Name are now offered under the website at the domain name <haringeyscp.org.uk>.

Respondent registered the Disputed Domain Name on September 29, 2020, *i.e.* after Complainant failed to renew it. This was long after Complainant first used the HARINGEY LSCB mark. At the time the Complaint was filed, the Disputed Domain Name resolved to a website featuring pornographic articles and corresponding images. Currently the Disputed Domain Name is inactive.

In response to the Procedural Order, Complainant submitted evidence of service users and professionals within partner organizations who continue to refer to Complainant by its former name "Haringey LSCB". Specifically, Complainant provided emails from (1) Haringey Safeguarding Children Partnership's Strategic Manager, (2) North Central London Integrated Care Board's Interim Director of Quality, and (3) the Independent Chair of Haringey Safeguarding Children Partnership, all attesting to the fact that many professionals and organizations use the terms "Haringey SCP" and "Haringey LSCB" interchangeably and refer to Complainant's services. Additionally, Complainant submitted screenshots of websites associated with (1) Belmont Infant School, (2) Little Crickets Daycare, and (3) Rokesly Infant and Nursey School that still refer to Complainant as "Haringey LSCB".

5. Parties' Contentions

A. Complainant

Complainant alleges it has common law rights in the HARINGEY LSCB mark (the "Mark") because it continuously and substantially exclusively used the mark from 2006 to June 2019. Complainant contends that the residents of Haringey, service users, and partner organizations still associate the Mark with Complainant's services, and many still refer to its services using the Mark. Complainant states that by 2014, the Disputed Domain Name, while under Complainant's control, had over 85,000 views, which Complainant claims is evidence of the reach and recognition of its Mark. Complainant also cites its use of the Mark in its Annual Reports from January 2009 to September 2019, as well as third party references to "Haringey LSCB" online (see *supra* Section 4) as evidence of the public's continued awareness of the Mark. Asserting these common law rights, Complainant contends that the Disputed Domain Name is identical to its HARINGEY LSCB mark.

Complainant further asserts that Respondent lacks rights or legitimate interests in the Disputed Domain Name as Complainant has not licensed Respondent to use the HARINGEY LSCB mark and Respondent has never been known by the Disputed Domain Name. Additionally, Complainant alleges that Respondent has never used the Disputed Domain Name in connection with a *bona fide* offering of goods or services.

Specifically, at the time of the filing of the Complaint, the Disputed Domain Name resolved to a website that displayed pornographic content. Complainant states that the display of this content is prejudicial to Complainant's renown and is highly damaging to the reputation and goodwill associated with the services that Complainant provides. Complainant further argues that this pornographic content is precisely the type of content from which Complainant's services seek to protect vulnerable children.

Additionally, Complainant contends that Respondent registered and is using the Disputed Domain Name in bad faith because Respondent has intentionally attempted to attract, for commercial gain, Internet users to the Disputed Domain Name by creating a likelihood of confusion with Complainant's Mark. Further, Complainant argues the Disputed Domain Name's display of pornographic content is evidence of bad faith registration and use of the Disputed Domain Name.

B. Respondent

Respondent did not reply to Complainant's contentions.

6. Discussion and Findings

A. Identical or Confusingly Similar

In order to "establish unregistered or common law trademark rights for purposes of the UDRP, a complainant must show that its mark has become a distinctive identifier which consumers associate with the complainant's goods and/or services". WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.3. Relevant evidence may include (i) the duration and nature of use of the mark in question, (ii) the amount of sales under the mark, (iii) the nature and extent of advertising using the mark, (iv) the degree of actual public (e.g., consumer, industry, media) recognition, and (v) consumer surveys. *Id.*

In support of its claim of unregistered trademark rights, Complainant states that "between 2006 and 2019, the safeguarding service provided by Complainant was well known by the residents of Haringey and the use of the Mark by Complainant in relation to those services was well understood by residents to refer to the services that originated from and were provided by Complainant", and "[a]lthough Complainant's safeguarding services are now provided under the HSCP name, residents of Haringey, service users, and partner organizations still know the service by its former name (*i.e.* the Mark), and many still refer to the service by that name".

Complainant submits evidence that it adopted the name "Haringey Local Safeguarding Children Board" and the corresponding acronym version, Haringey LSCB (the Mark) in 2006; that it registered the Disputed Domain Name <haringeylscb.org> in 2009, and that the Mark appeared prominently on Complainant's website from 2009 through 2019. Complainant's evidence also shows that the website was frequently visited, as evidenced by business records claiming a substantial number of the relevant public accessed Complainant's website that described its child welfare services under the Haringey LSCB mark. For example, Complainant offered evidence of 85,000 page views of the website in 2014-2015. Complainant also offered annual reports for the period 2009-2019 quantifying the public's reliance on Complainant's services. Apart from website visits, the annual reports document extensive interaction with Complainant and its services. For example, the annual report indicates that in 2017-2018, Complainant received 12,968 contacts relating to child welfare, and that it referred nearly half of these to other agencies for further attention. About 20 percent of these cases are "re-referrals", a fact that reinforces the inference that the relevant public perceives Complainant and its Mark as a specific source for child welfare services in the area. In the same period, Complainant completed 2,832 assessments.

In assessing the sufficiency of this evidence, the Panel notes that Haringey is a borough of London, United Kingdom, with a population (in 2021) of 264,130. In this context, the foregoing evidence is more than sufficient to support a finding of unregistered trademark rights. "[T]he fact that secondary meaning may only

exist in a particular geographical area or market niche does not preclude the complainant from establishing trademark rights (and as a result, standing) under the UDRP.” [WIPO Overview 3.0](#), section 1.3.

Based on this evidence, the Panel finds that Complainant has demonstrated unregistered trademark rights in the HARINGEY LSCB Mark. Moreover, to the extent the Mark could be considered descriptive, that foregoing evidence is sufficient to support a finding of secondary meaning and the Panel so finds.

In 2019, Complainant adopted a new name, transitioning from “Local Safeguarding Children Board” to “Safeguarding Children Partnership”, and, correspondingly, transitioning from HARINGEY LSCB to HARINGEY SCP. The 2019 edition of the website and the 2019 annual report notified the public of the transition and continuity of services of the modified version of the Mark.

The Panel finds that the current mark HARINGEY SCP and the prior mark HARINGEY LSCB are sufficiently similar that relevant consumers would consider them synonymous. It is well understood that trademarks may evolve. Whether a period of prior use can be “tacked on” to a new altered version of the mark is a question of fact. The question is whether the “new” mark creates a different commercial impression from the prior version. If the relevant consumers would consider the marks substantially the same, then the prior period may be included for determining questions of validity and priority.

The Panel finds that the older “Haringey LSCB” mark and the newer “Haringey SCP” mark create substantially the same impression to the relevant public. There is little or no difference in their respective meanings. Dropping “local” is insignificant, given that the term is implied by reference to “Haringey”. Similarly, changing “board” to “partnership” likely would not affect consumer perception. A consumer likely would think the name of the entity had evolved in a minor way. Indeed, Complainant submitted evidence that the public continues to refer to the current “partnership” as the local board. Consequently, Complainant may rely on the long prior use of its ancestor HARINGEYL SCB mark to support a finding of unregistered trademark rights in the modern HARINGEY SCP version of its mark.

Moreover, Respondent has not answered Complainant’s allegations or responded to the asserted evidence that it has unregistered trademark rights in the Mark. Accordingly, the Panel finds that (1) Complainant may rely on its prior use of the HARINGEY LSCB Mark to show long use in support of the its claim of unregistered trademark rights in its current mark HARINGEY SCP; and (2) Complainant continues to enjoy residual goodwill in the HARINGEY LSCB mark. See *California Stormwater Quality Association v. Vilma Morales*, WIPO Case No. [D2004-0617](#).

The Panel also finds that the Disputed Domain Name is identical to Complainant’s HARINGEY LSCB Mark, in which Complainant has residual rights. The Disputed Domain Name is also confusingly similar to the current version of Complainant’s Mark, HARINGEY SCP. The “Haringey” and “SC” components are identical and sufficient for a finding of confusing similarity. Indeed, Complainant offers evidence that some residents use the two names interchangeably, a fact which affirms the confusing similarity.

For the foregoing reasons, Complainant has satisfied paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

Complainant has made out a *prima facie* case that Respondent lacks rights or legitimate interests in the Disputed Domain Name, shifting the burden of production onto Respondent to demonstrate its rights or legitimate interests, with the burden of proof remaining on Complainant.

Respondent has not submitted a response to the Complaint to rebut this *prima facie* case. The Panel finds that there is no evidence that Respondent has any authorization to use Complainant’s trademark; that there is no evidence that Respondent is commonly known by the Disputed Domain Name; and, that there is no evidence that Respondent is making a legitimate noncommercial or fair use of the Disputed Domain Name or that, before any notice of the dispute, Respondent had made use of, or demonstrable preparations to use the Disputed Domain Name or a name corresponding to the Disputed Domain Name in connection with a *bona*

vide offering of goods or services. Instead, Complainant submitted evidence that the Disputed Domain Name was being used in connection with a website displaying pornography and advertisements, none of which refers to HARINGEY LSCB. See *Tetra Laval Holdings & Finance S.a. v. Johnson Zhang*, WIPO Case No. [D2022-2424](#). See also [WIPO Overview 3.0](#), section 2.13.

In view of this un rebutted evidence, the Panel finds that Complainant has satisfied paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

The Panel finds that Respondent registered the Disputed Domain Name in bad faith.

In making this finding, the Panel draws adverse inferences from Respondent's failure to respond Complainant's allegations of bad faith registration and use. "Further to paragraph 14(b) of the UDRP Rules however, panels have been prepared to draw certain inferences in light of the particular facts and circumstances of the case *e.g.*, where a particular conclusion is *prima facie* obvious, where an explanation by the respondent is called for but is not forthcoming, or where no other plausible conclusion is apparent." [WIPO Overview 3.0](#), section 4.3. For three reasons, adverse inferences are appropriate here.

First, it is likely that Respondent was aware Complainant of and sought to exploit the history of frequent web traffic to the Disputed Domain Name. Respondent does not deny this allegation, which is certainly the most probable explanation, especially given that the Disputed Domain Name has no meaning related to the pornography displayed on the associated webpages. Because the Disputed Domain Name has no meaning related to pornography, it was incumbent upon Respondent to offer a good faith explanation for its registration and use of the Disputed Domain Name, failing which the Panel infers and finds that Respondent registered the Disputed Domain Name in bad faith to exploit the interest of Internet users searching for Complainant, as evidenced by the evidence of significant web traffic.

Second, Respondent has been found to engage in a pattern of bad faith registration in at least twenty cases. See, *e.g. Panda Restaurant Group, Inc. v. Host Master/1337 Services LLC*, FA2305002042636; *Webjet Marketing Pty Ltd v. Host Master, 1337 Services LLC*, WIPO Case No. [D2020-2976](#). Because Respondent is a "repeat offender", the Panel deems it appropriate to draw an adverse inference of bad faith registration and use. It cannot be ignored that dozens of prior panelists have found that Respondent has registered and used domain names in bad faith. Given this pattern, it is fair to draw adverse inferences from Respondent's failure to submit any response in this case to the allegations of bad faith use and registration.

Third, because Respondent registered the Disputed Domain Name after its prior owner allowed it to lapse, Respondent should have known that Complainant, the immediate prior owner, had rights in the HARINGEY LSCB and HARINGEY SCP marks.

Respondent is a domainer who undertakes bulk purchases and automated registrations, including in particular by "drop-catching" previously-registered domain names. The Panel is of the view that the knowledge (and, for that matter, the intention) of such a domainer generally should be judged objectively. Thus, what may be observed here is that Respondent registered the disputed domain without concern as to whether doing so abused the trademark rights of a third party, and without any apparent effort to avoid so doing. *Supernac's (Holdings) Limited v. Domain Administrator, DomainMarket.com*, WIPO Case No. [D2018-0540](#). See also [WIPO Overview 3.0](#), section 3.2.3.

A domainer, especially one who has repeatedly abused the domain name system, has a duty to investigate whether the prior owner of a lapsed domain name has rights in the domain name of interest. The Panel has confirmed that a simple online search in Google for "haringeylscb" leads to Complainant's domain name <haringeyscp.org.uk> where information about its services would have been available. An Internet archive search would have shown Complainant's prior use of the Disputed Domain Name and also of the continuity of those services under the current version of the Mark. Respondent would have learned that services

relating to child welfare were provided under these marks for many years. Under these circumstances, it was bad faith to register the Disputed Domain Name to be used in association with pornography.

The Panel also accepts Complainant's allegation, which Respondent does not deny, that it was bad faith to use the Disputed Domain Name to display pornography, especially given that Complainant's users are people looking for help safeguarding children, which in many cases would be abused children. Certainly, displaying pornography under the Disputed Domain Name would constitute tarnishment of a trademark for services relating to child welfare. [WIPO Overview 3.0](#), section 3.2.

7. Decision

For the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the Disputed Domain Name, <haringeylscb.org> be transferred to Complainant.

/Lawrence K. Nodine/

Lawrence K. Nodine

Sole Panelist

Date: June 27, 2023