



DISPUTE RESOLUTION SERVICE

DRS 23600

Decision of Independent Expert

7-Eleven, Inc

Complainant

and

Lee Owen

Respondent

1 The Parties

Complainant:	7-Eleven, Inc
Address:	3200 Hackberry Road Irving Texas 75063 United States

Respondent:	Lee Owen
Address:	Constanta 900170 Romania

2 The Domain Name

7eleven.uk (the "Domain Name").

3 Procedural History

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,

which need be disclosed as being of such a nature as to call into question my independence in the eyes of one or both of the parties.

6 April 2021	Dispute received
9 April 2021	Complaint validated
9 April 2021	Notification of complaint sent to parties
29 April 2021	Response reminder sent
30 April 2021	Response received
30 April 2021	Notification of response sent to parties
6 May 2021	Reply reminder sent
7 May 2021	Reply received
7 May 2021	Notification of reply sent to parties
7 May 2021	Mediator appointed
7 May 2021	Mediation started
24 May 2021	Mediation failed
24 May 2021	Close of mediation documents sent
4 June 2021	Complainant full fee reminder sent
7 June 2021	Expert decision payment received

4 Factual Background

- 4.1 The Complainant is a US headquartered chain of convenience stores established in 1946, since when it has operated in a number of countries under the 7 ELEVEN mark, directly or through licensees.
- 4.2 The Domain Name was registered on 14 March 2019, but not by the Respondent. It appears initially to have been registered by a UK company named Stenning Limited ("Stenning"), and subsequently to have been transferred to the Respondent on 30 March 2021.
- 4.3 The Respondent appears to offer various website related services, under the name squillions.com, including trading in domain names.
- 4.4 The Domain Name is not currently pointing to any website. The Whois database indicates that it is not currently linked with any name servers.

5 Parties' Contentions

Complaint

- 5.1 The Complainant asserts that it has established a substantial global reputation associated with the 7 ELEVEN mark and name, as a result of its extensive use of its trade marks, its approximately 70,000 stores worldwide and its marketing and advertising. It asserts that its trade marks have become uniquely identified with the Complainant in the minds of consumers.
- 5.2 The Complainant says that its rights predate the registration of the Domain Name in March 2019. It also submits that the Domain Name is identical to its trade marks and contends that it therefore has Rights (as defined in the Policy) in respect of a name or mark that is identical or similar to the Domain Name pursuant to paragraph 2.1.1 of the Policy.
- 5.3 As to Abusive Registration, it is the Complainant's case that the Respondent acquired the Domain Name primarily to sell it to the Complainant or a competitor (Policy, 5.1.1.1), as a blocking registration (Policy, 5.1.1.2) or unfairly to disrupt its business (Policy, 5.1.1.3); that the

Respondent is using, or threatening to use, the Domain Name in order to confuse people (Policy, 5.1.2); that the Respondent is engaged in a pattern of registration of domain names corresponding to well-known names or marks with which he has no connection (Policy 5.1.3); that he has provided false contact details (Policy, 5.1.4); and that he falls foul of the presumption of Abusive Registration under paragraph 5.3 of the Policy because there have been three previous findings of Abusive Registration against the Respondent in the last two years.

- 5.4 In support of those submissions, the Complainant points out that the Respondent is not using the Domain Name in connection with a bona fide offering of goods or services. Indeed, it is not being used at all. The Complainant also annexes a screenshot of the website from November 2020, demonstrating that, at that time at least, the Domain Name was "potentially for sale or lease".
- 5.5 The Complainant submits that, given the scale of its operation and the reputation associated with its trade marks, it is "inconceivable" that the Respondent would not have known about the Complainant's brand prior to registering (sic) the Domain Name. It relies in this regard on the decision of the Appeal Panel in DRS 23040 (*7eleven.co.uk*) dated 22 February 2021.
- 5.6 In the alternative, the Complainant submits that "it is clear" that the Respondent acquired the Domain Name to sell it to a competitor of the Complainant. It asserts that the Domain Name would be very valuable to a competitor of the Complainant "as it would enable them to benefit from the reputation and goodwill of the Complainant's Trade Marks and their extensive marketing and promotional efforts".
- 5.7 In support of its case on a blocking registration, the Complainant says that "it is clear" that the website (sic) is targeting UK consumers because it is using the .uk ccTLD. It asserts that "it is also inevitable" that consumers will assume that the Domain Name is connected with the Complainant and, for that reason, constitutes a blocking registration within the meaning of paragraph 5.1.1.2 of the Policy.
- 5.8 The Complainant further argues that the Respondent's failure to make any commercial use of the Domain Name for 12 months "illustrates" that it was registered in bad faith and it was, therefore, acquired for the purpose of unfairly disrupting the Complainant's business.
- 5.9 As to the likelihood of confusion pursuant to paragraph 5.1.2, it is the Complainant's case that "it is impossible to imagine how any use of the [Domain Name] would not cause confusion to the relevant consumer" because the average consumer "familiar with the 7 ELEVEN brand would assume such a domain name related to the provision of convenience store services and products by the Complainant, and so would assume that the business provided under the [Domain Name] was connected with the Complainant". The Complainant contends that it is therefore "a reasonable assumption" that the Respondent intentionally registered the Domain Name to attract, for commercial gain, internet users to the Respondent's website by creating a likelihood of confusion with the Complainant.
- 5.10 In support of its claim that the Respondent has engaged in a pattern of registering infringing domain names (5.1.3), the Complainant attaches an extensive list of domain names, which it says have been registered by the Respondent "many of which belong to third party brands". While the list is extensive, and a number appear prima facie to infringe the rights of third parties, no evidence is provided as to the registrant of any of them.
- 5.11 The Complainant asserts that it has been independently verified that the Respondent has given it false contact details, and that such conduct therefore constitutes evidence of Abusive Registration under paragraph 5.1.4 of the Policy. No further details or evidence are or is provided.

- 5.12 Finally, the Complaint contends that the Respondent falls foul of the 'three strikes' principle under paragraph 5.3 of the Policy on the basis that the Appeal Panel found for the Complainant in its DRS complaint concerning the domain name *7eleven.co.uk*.

Response

- 5.13 The Respondent very fairly accepts that the Complainant has Rights in the 7 ELEVEN mark and name. However, he says that those Rights are limited to the relevant trade mark classes, none of which covers his "current activity" with the Domain Name.
- 5.14 He also points out that he only acquired the Domain Name on 30 March 2021, which renders a substantial proportion of the Complainant's submissions irrelevant.
- 5.15 The Respondent defends the Complainant's case on Abusive Registration on a number of bases. First, he denies that the Domain Name causes any initial interest confusion because it is not currently being used to point to a website, or otherwise, on the internet.
- 5.16 Secondly, he implies that he had no knowledge of the Complainant because he was a child when the Complainant last traded in the UK and he subsequently emigrated to Romania in 2007, where the Complainant does not trade.
- 5.17 Thirdly, he asserts that he acquired the Domain Name to use in connection with a dice game named 7-11, which is apparently a drinking game where any player rolling a 7 or 11 is required to have a drink.
- 5.18 Fourthly, the Respondent relies on the Experts' Overview (paragraph 4.7) and the Appeal decision in DRS 4889 (*wiseinsurance.co.uk*) to suggest that this is a case where the Complainant's name or mark is a dictionary word or a combination of dictionary words and not well known and the Respondent reasonably registered and has been using the Domain Name in ignorance of the Complainant's rights. In particular, he relies on the following sentence in the Overview: "*In such circumstances, if the confusion is likely to be very limited, an Expert might conclude that it would be unjust to deprive the Respondent of his domain name*".

Reply

- 5.19 In its Reply, the Complainant appears to accept that the Domain Name has recently changed hands but, nonetheless, asserts that its contentions should nonetheless be taken into consideration, essentially because the transfer of the Domain Name was a ruse by the previous registrant (and Respondent to DRS 23040 concerning *7eleven.co.uk*), Stenning, to avoid a second finding against it under the DRS and thereby creating exposure pursuant to paragraph 5.3 of the Policy.
- 5.20 The Complainant explains that Stenning approached the Complainant's lawyers. The relevant without prejudice correspondence between Stenning and the Complainant's lawyers is exhibited. It demonstrates that Stenning had registered both *7eleven.co.uk* and *7eleven.uk*. Shortly after the Appeal decision had upheld the transfer decision in relation to *7eleven.co.uk* on 22 February 2021, on 24 February Stenning offered the Domain Name to the Complainant for £3,000. When the Complainant declined to pay and shortly before this Complaint was filed, Stenning transferred the Domain Name to the current Respondent.
- 5.21 The Complainant asserts that it is, therefore, evident that Stenning and the Respondent are colluding and acting in bad faith. In support of that assertion, it points out that a number of the arguments advanced by the Respondent are the same or similar to those advanced by Stenning in the *7eleven.co.uk* case.

- 5.22 In addition, the Complainant says that the fact that other parties may have used names or marks similar to 7 ELEVEN does not assist the Respondent because the rights holder "is not required to pursue every infringement and it is their choice to determine which infringements warrant action".
- 5.23 The Complainant rejects the Respondent's assertion that UK consumers are no longer aware of the Complainant and its brand. It further asserts that it is entitled to rely on reputation in other jurisdictions, citing DRS 20156 (*tdbank.co.uk*). It asserts that consumers would remember its name, given that it had over 50 stores in the UK in the 1990s and that in 2019 48,000 users from the UK accessed its corporate website. Accordingly, the Complainant submits that "this evidence shows that UK consumers are familiar with 7 ELEVEN because of its reputation and presence in the UK". In addition, it says that consumers all over the world would be familiar with the brand "via social media, television programmes and films". It repeats its case on confusion.
- 5.24 It also repeats its assertion that the Respondent was aware of its name because "there is no doubt" that he was aware of the decision in the *7eleven.co.uk* case.
- 5.25 It rejects the Respondent's argument on trade mark classes on the grounds of irrelevance for the purposes of the DRS Policy.
- 5.26 It repeats that "the only reason" that the Respondent registered (sic) the Domain Name was to sell it either to the Complainant or to a competitor.
- 5.27 The Complainant suggests that the Respondent has downplayed the Complainant's presence in other European countries.
- 5.28 Finally, the Complainant rejects the Respondent's reliance on DRS 04889 (*wiseinsurance.co.uk*) because it says that this is not a case where a mark is made up of dictionary words which are not well known.

6 Discussions and Findings

General

6.1 To succeed under the DRS Policy, the Complainant must prove on the balance of probabilities, first, that it has Rights (as defined in the Policy) in respect of a name or mark that is identical or similar to the Domain Name (paragraph 2.1.1 of the Policy), and secondly, that the Domain Name is an Abusive Registration in the hands of the Respondent (paragraph 2.1.2).

6.2 Abusive Registration is defined in paragraph 1 of the Policy in the following terms:

"Abusive Registration means 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) is being or has been used in a manner which has taken unfair advantage of or has been unfairly detrimental to the Complainant's Rights."

Complainant's rights

- 6.3 Paragraph 2.1.1 of the Policy requires the Complainant to prove that it "*has Rights in respect of a name or mark which is identical or similar to the Domain Name*". "Rights" means "*rights enforceable by the Complainant, whether under English law or otherwise, and may include rights in descriptive terms which have acquired a secondary meaning*" (paragraph 1).
- 6.4 The Complainant has provided copious evidence of its extensive 7 ELEVEN and 7-ELEVEN trade mark rights, and unregistered common law rights in the form of goodwill and reputation in the 7 ELEVEN name, which is identical to the Domain Name (omitting the .uk suffix, as is permissible for these purposes under the DRS). This is not challenged by the Respondent.
- 6.5 Accordingly, the Complainant satisfies paragraph 2.1.1 of the Policy.

Abusive registration

- 6.6 The Complainant takes a blunderbuss approach to the question of Abusive Registration, relying on no fewer than seven of the factors which may be evidence of Abusive Registration set out in section 5 of the Policy.
- 6.7 First, it contends that the Respondent is in breach of all three limbs of paragraph 5.1.1, i.e. that the Respondent has acquired the Domain Name primarily to:
- (a) sell it back to the Complainant or one of its competitors (5.1.1.1),
 - (b) as a blocking registration against a name or mark in which the Complainant has Rights (5.1.1.2), and/or
 - (c) unfairly to disrupt the Complainant's business (5.1.1.3).
- 6.8 However, none of the Complainant's assertions in this regard is supported by any evidence. Paragraph 5.1.1 requires the Complainant to prove, on the balance of probabilities, that the Respondent acquired the Domain Name primarily for one (or more) of the three purposes identified. It is probably permissible to invite the Expert to draw an inference, but any such inference would have to be based on evidence of some kind, e.g. an approach by the Respondent to the Complainant offering to sell it the Domain Name.
- 6.9 The Complainant advances no such inferential case. It exhibits a screenshot of a web page dated 13 November 2020, showing the Domain Name as "potentially for sale or lease". However, that does not assist the Complainant, given that that was more than four months before, on its own case, the Respondent acquired the Domain Name from Stenning.
- 6.10 Indeed, if the Complainant's case as to collusion between the former registrant and the Respondent is correct, as seems likely, the Respondent would have known that the Complainant had no interest in buying the Domain Name, which makes it unlikely that that was his primary purpose in acquiring it.
- 6.11 While the Complainant asserts that "it is clear" that the Respondent acquired the Domain Name to sell it to a competitor, this appears to be based on no more than the Complainant's belief that such a competitor could use it as an instrument of passing off and/or trade mark infringement. However, not a shred of evidence is provided to support that allegation.
- 6.12 In support of its case on a blocking registration, the Complainant asserts that "the website" is targeting UK consumers because it is using the .uk ccTLD. This line of argument is hard to follow, given that, on the Complainant's own case, and in fact, there is no website.

- 6.13 The Complainant's submission that it is "inevitable" that consumers will assume that the Domain Name is connected with the Complainant and, for that reason, constitutes a blocking registration, does not bear scrutiny. It is hard to see how any alleged inevitability as to confusion in the minds of consumers could constitute evidence that the Respondent acquired the Domain Name primarily as a blocking registration. The Complainant also claims that the Respondent would have known of the 7 ELEVEN brand and therefore sought "to benefit in some way" or to interrupt or block the Complainant's business. Again, however, no evidence, even circumstantial, that such thinking played any part in the Respondent's acquisition of the Domain Name from the previous registrant is provided, let alone that it was his primary motivation (as required under 5.1.1).
- 6.14 As regards 5.1.1.3 (acquisition in order unfairly to disrupt Complainant's business), it is simply asserted that the Respondent's failure to make any commercial use of the Domain Name for 12 months demonstrates that it was registered in bad faith. Even leaving aside the fact that the Domain Name has been in the hands of the Respondent only since 30 March 2021, that assertion does not come close to evidence that unfair disruption was the Respondent's primary purpose in acquiring the Domain Name.
- 6.15 Paragraph 5.1.2 of the Policy, on which the Complainant also relies, includes, as a factor which may be evidence that a domain name is an Abusive Registration, circumstances indicating that the Respondent is using the domain name in a way which is confusing 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.
- 6.16 The Complainant contends that it is "a reasonable assumption" that the Respondent intentionally registered the Domain Name to attract, for commercial gain, internet users to the Respondent's website by creating a likelihood of confusion with the Complainant, essentially because the average consumer would assume that any products or services provided by reference to the Domain Name were connected to the Complainant.
- 6.17 The Complainant's submissions in this regard are confused and confusing. On the one hand, as set out at 5.8 above, it is the Complainant's case that the Respondent has made no use of the Domain Name and indeed it relies on that as evidence of bad faith. But, for the purposes of paragraph 5.1.2 of the Policy, it simultaneously asserts that the Respondent acquired the Domain Name "to attract for commercial gain internet users to the Respondent's website by creating a likelihood of confusion with the Complainant as to the source, sponsorship, affiliation or endorsement of the Respondent's website or location or of a product or service on the Respondent's website." It says that "as a result of all of this" it is clear that the Respondent falls foul of paragraph 5.1.2. Not only is no evidence provided of any such confusion or likelihood of confusion, but it is part of the Complainant's own case that the Respondent has no such website, products or services.
- 6.18 The Respondent picks up on this. He says that there can be no initial interest confusion in circumstances where the Domain Name is not being used. However, paragraph 3.3 of the Experts' Overview (the "Overview"), considering the question of confusing use under paragraph 5.1.2 of the Policy, puts it this way:
- "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'?" (emphasis added).*
- 6.19 Confusion or the likelihood thereof can arise simply from the existence of the domain name. There may be a question as to the likelihood of an internet user seeing a domain name in

circumstances where it is not being used for any purpose. But it would not be correct to assume that non-use of a domain name is a complete defence under 5.1.2.

- 6.20 Further, the Overview is clear that "*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)*". That is the case here.
- 6.21 Paragraph 5.1.3 of the Policy provides that a domain name may be an Abusive Registration where the Complainant can demonstrate that the Respondent is engaged in a pattern of registrations where the Respondent is a registrant of domain names which correspond to well-known names or trade marks in which the Respondent has no apparent rights, and the Domain Name is part of that pattern.
- 6.22 While the Complainant's case on paragraph 5.1.3 is not challenged by the Respondent, the Complainant has not done enough to discharge its burden of proof. It has exhibited a long list of domain names, some of which may correspond to well known names or trade marks, but most of which do not appear to do so, and in any event the Complainant has not explained how the list has been put together or provided any printouts or other evidence to show that any of them was or is registered by the Respondent.
- 6.23 In the body of the Complaint itself, the Complainant identifies just three such domain names, *amsel.co.uk*, *fourseasons.co.uk* and *skyports.co.uk* which it asserts correspond to the Amstel, Four Seasons Hotel and Sky Sports brands respectively. But even in those three cases, there is no evidence that they were registered by the Respondent. Nor is it certain that there are not other legitimate explanations for registering those three domain names, none of which corresponds precisely with the name or trade marks on which the Complainant relies. Accordingly, the Complainant fails under 5.1.3.
- 6.24 The Complainant's case on 5.1.4 is extremely cursory, again unsupported by any evidence, and in any event misconceived because the Complainant asserts that false contact details were provided to it, whereas the Policy refers to a situation where the false contact details were provided to Nominet.
- 6.25 As to paragraph 5.3 of the Policy, again, the Complainant's submissions are misconceived. It cites only one previous adverse finding in DRS 23040, whereas paragraph 5.3 is clear that a presumption of Abusive Registration arises only if the Complainant proves that the Respondent has been found to have made an Abusive Registration in three or more DRS cases in the two years before the Complaint was filed.
- 6.26 In this case, not only has the Complainant only been able to point to one such case, but that finding was not against the Respondent. It was against the previous registrant of the Domain Name, Stenning. Its case on 5.3 therefore fails.
- 6.27 While the Complainant's case on Abusive Registration may be confused and lack evidential support, the Response is hardly convincing. The Respondent's reliance on his emigration to Romania and the fact that he was a child when the Complainant last traded in the UK does not sit well with the fact that only a few months ago he acquired the Domain Name from a registrant against which a finding had been made under the DRS in respect of a virtually identical domain name (*7eleven.co.uk*). Even if, which seems a little unlikely, he had previously been unaware of the Complainant's brand, it is even more unlikely that at the time he acquired the Domain Name in March 2021, following that Appeal decision, he still had no idea of the Complainant's existence.

- 6.28 Similarly, the Respondent's purported explanation for acquiring the Domain Name by reference to a drinking game sounds more like the result of Googling after the event than a genuine reason, not least because no evidence at all has been provided of any demonstrable preparations to use the Domain Name in that connection, as is required under paragraph 8.1.1 of the Policy.
- 6.29 Nor are the Respondent's submissions in relation to a combination of dictionary words very compelling. Apart from anything else, he has quoted selectively from the relevant paragraph of the Experts' Overview by omitting the last sentence of the paragraph in question which states as follows:
- "However, there is a view among some experts (albeit a minority) that a confusing use which is likely to constitute trade mark infringement cannot be anything than unfair".*
- 6.30 Even leaving that aside, the Respondent appears to have overlooked that the guidance on which he relies applies to a situation "*where the Complainant's name or mark is not well-known and the Respondent reasonably registered and has been using the Domain Name in ignorance of the Complainant's rights*".
- 6.31 In this case, the 7 ELEVEN name and mark cannot realistically be described as not well known. Nor, for the reasons explained above, is it very likely that the Respondent was in ignorance of the Complainant's rights.
- 6.32 Accordingly, the Respondent has failed to demonstrate that the Domain Name is not an Abusive Registration, whether by reference to the factors set out in section 8 of the Policy or otherwise.
- 6.33 The chronology of events set out in the Reply concerning the circumstances in which the Domain Name was obtained by the Respondent is telling. It is almost inconceivable that, whatever the Respondent's state of knowledge prior to last March, he was not in those circumstances aware of the Complainant's rights. That in turn calls into question the bona fides of some of the submissions made by the Respondent.
- 6.34 It is more likely that this was a case of a domainer (Stenning) offloading a potentially compromising domain name to a fellow domainer (the Respondent), having failed to sell it to 7-Eleven Inc. and knowing, in light of the decision in relation to *7eleven.co.uk*, that 7-Eleven was likely to file a second Complaint against it which it was also likely to lose. It is difficult to believe that he was not on notice of the Complainant's rights in the name, not only because it is so well known, but also because Stenning had just lost a DRS Complaint in respect of a virtually identical domain name.
- 6.35 In those circumstances, and on the balance of probabilities, the Complainant has just about demonstrated that the Respondent's acquisition of the Domain Name took unfair advantage of or was unfairly detrimental to the Complainant's Rights, and accordingly that the Domain Name is an Abusive Registration.

7 Decision

- 7.1 The Expert accordingly finds that the Complainant has Rights in a name or mark which is identical or similar to the Domain Name and that the Domain Name is, in the hands of the Respondent, an Abusive Registration.
- 7.2 It is therefore determined that the Domain Name be transferred to the Complainant.

Signed: **David Engel**

Dated: 9 July 2021