

DISPUTE RESOLUTION SERVICE

DRS 08006

Decision of Independent Expert

Shedstore LLP
Guardian Buildings Partnership
Keith Taylor

and

Robert Lee t/a Easy Shed

1. The Parties:

Lead Complainant:	Shedstore LLP
Address:	Unit 1 Southview Park Caversham Reading
Postcode	RG4 5AF
Country:	GB
Other Complainants:	Guardian Buildings Partnership Keith Taylor
Address:	as above
Respondent:	Robert Lee t/a Easy Shed
Address:	69 Old Bromford Lane Birmingham West Midlands
Postcode:	B8 2RR
Country:	GB

2. The Domain Name(s):

ukshedstore.co.uk (the “Domain Name”)

3. Procedural History:

4 December 2009	Nominet validated the Complaint
4 December 2009	Nominet sent the Complaint to the Respondent
11 January 2010	Response received from the Respondent
15 January 2010	Reply received from the Complainant
2 March 2010	Mediation failed to achieve a settlement
19 March 2010	Tony Willoughby appointed as Expert Reviewer
19 March 2010	Steve Ormand appointed as Expert

Definitions used in this decision have the same meaning as set out in the Nominet UK Dispute Resolution Service Policy Version 3, July 2008 (the “Policy”) and/or the Nominet UK Dispute Resolution Service Procedure Version 3, July 2008 (the “Procedure”) unless the context or use indicates otherwise.

4. Factual Background

The Guardian Buildings Partnership commenced trading in 1997 and from 2000 traded as Shedstore LLP. Shedstore LLP sells sheds, garden buildings and other related retail services direct to the public via a website at www.shedstore.co.uk registered on 24 January 2000.

The Guardian Buildings Partnership is the proprietor of two UK trade marks in the mark SHEDSTORE:

- a. registration number 2366372 registered on 22 June 2004 for the mark SHEDSTORE; and
- b. registration number 2366572 registered on 24 June 2004 for the mark Shedstore & logo

The Domain Name was registered to Easy Shed, a UK sole trader, on 20 November 2008. The Respondent sells sheds and garden buildings direct to the public via a website connected to the Domain Name.

5. The Parties’ Contentions

The Complaint

The Complainants contend that they have Rights in the mark SHEDSTORE arising from trade mark rights in this mark, registered in 2004, and from trading as Shedstore LLP, via the website www.shedstore.co.uk, since 2000.

The Complainants contend that the Respondent’s registration and use of the Domain Name is an Abusive Registration because:

1. The Domain Name incorporates the Complainants’ trade mark.
2. Members of the public may purchase sheds and garden buildings via the website connected to the Domain Name.
3. A customer searching for SHEDSTORE on a search engine may come across the Domain Name and be misled into thinking that the Respondent is authorised by the Complainants to use the SHEDSTORE mark, or that the Domain Name is operated by the Complainants, or will naturally assume that there is some connection between the Domain Name and the Complainants.
4. The addition of UK to SHEDSTORE is not sufficient to prevent confusion from arising since it is merely a geographical term indicating products originating from the UK.

5. The Domain Name is calculated to poach customers from the Complainants.
6. The meta description for the Complainants' website, www.shedstore.co.uk, is as follows:

<meta name="description" content="Garden sheds and wooden, metal and plastic garden buildings. Buy sheds online at discount prices with free UK delivery from only 5 days! Shedstore - not just sheds! Our extensive range also includes garages, children's playhouses, summerhouses, log cabins, greenhouses and much more.">

The Domain Name copies some of this meta tag content so that the organic listings on Google resemble that of the Complainants' website.

Identical wording is to be found in the meta description of the website connected to the Domain Name. The Respondent has used the same text, grammar and capitalization; word for word. This is a clear attempt to confuse consumers.

7. The Respondent has declined to comply with the Complainants' written request to cease use of the Domain Name. The Respondent admitted in its undated letter to the Complainants that *"Our web site name 'ukshedstore' does indeed bear resemblance to your 'shedstore'"*.
8. In the circumstances, the Complainants submit that the Domain Name is a deliberate attempt to trade on the Complainants' good name and reputation.

The Response

The Respondent responded to the Complaint as follows:

1. The Domain Name was legally and lawfully purchased (with the intent of making, selling and distributing sheds in the United Kingdom) early in January 2009¹. The Complainants have misunderstood the Respondent's intent and use of the Domain Name.
2. It is admitted that pictures from the Complainants' website were being used on the Respondent's website. Following receipt of an email from the Complainants concerning such use, the Respondent apologised to the Complainants and made amendments immediately to the website. The Respondent's web site builder had used the pictures to demonstrate the overall layout of the website, but was inadvertently asked to publish the site before he had been asked to replace the pictures with the Respondent's own pictures.
3. The Respondent received further correspondence from the Complainant requiring the website to be dismantled, stating that the Respondent could be liable to pay all profits made from this area of trading and that the Complainants did not wish their customers to be misled. The Respondent also does not wish to mislead the Complainants' customers.
4. Further changes were made to the Domain Name in an attempt to satisfy the Complainants' extreme requirements and demands, but these changes have not satisfied the Complainants.
5. It is quite clear from looking at both sites that the only trading area of similarity is with regard to wooden sheds. It is apparent that the Complainants do not make sheds but sell them, as a garden centre would do, along with many other products of a great variety, whereas the Respondent makes, sells, distributes and fits only wooden sheds.

¹ In the Response the Respondent refers to the purchase of the Domain Name as being "early in January 2009" when in fact the Domain Name was registered to the Respondent on 20 November 2008.

The Reply

The Complainant replied to the Response as follows:

1. The Respondent states that the Domain Name was "*legally and lawfully purchased*". Nominet does not vet new domain names to ensure that they do not infringe existing intellectual property rights. It is up to the owner of such prior rights to take action via the Dispute Resolution Service. The fact that a party has registered a domain name does not entitle it to disregard or infringe existing trade mark rights.
2. The Respondent's admission that pictures from the Complainants' website were used in the creation of the Domain Name shows that from the beginning the Respondent was intent on copying the contents of the Complainants' website and deliberately chose a domain name that included the Complainants' trade mark SHEDSTORE.
3. The Respondent deliberately copied pictures and meta tags from the Complainant's website. This was no mere accident. Pictures could have been taken from any number of existing websites as "examples of the overall layout", but the fact is that they were copied from the Complainants' website. These pictures were only removed after the Complainants wrote to the Respondent in May 2009.
4. The Respondent argues that somehow the respective products/areas are different because the Complainants "*do not make their own sheds, but sell them (as like with a garden centre) along with many other products of a great variety*" whereas the Respondent "*makes, sells, distributes and fits 'only' wooden sheds*". The Complainants submit that this is not relevant. The fact is that both websites offer wooden garden sheds for sale and the Domain Name incorporates the Complainants' mark. Therefore, there is the potential for confusion to arise between the two. The Complainants' UK trade mark registration covers, amongst other things, "sheds". Accordingly, it is clear that there is infringement of the registration. Whether the sheds are wooden or not, or own brand or not, and whether other items apart from sheds are sold has no bearing on the issue.
5. The Respondent claims that the Complainants' requirements are "*extreme*". The Complainants simply wish to protect their existing rights. The Complainants have held and utilised a 'Shedstore' style and the primary .co.uk domain since January 2000, whereas the Domain Name has been in existence for a year at the most.
6. The Complainants sell as Shedstore, because their name is Shedstore (LLP), a market-leading presence. The Respondent is Easy Shed, so why does it not sell as such? The only possible reason is that, despite its claims to the contrary, the Respondent wants to cause confusion and harm to the Complainants.
7. The Domain Name does cause confusion. The trade sector knows that the Complainants are Shedstore, but the public through word of mouth can (and have) become confused. Shedstore covers the whole of the UK, whereas ukshedstore does not, leading to yet more confusion.
8. The Complainants simply want their trade mark removed from the Domain Name.

6. Discussions and Findings

General

To succeed in this Complaint, the Complainants have to prove to the Expert on the balance of probabilities, pursuant to §2 of the Policy, both limbs of the test that:

1. *The Complainant has Rights in respect of a name or mark which is identical or similar to the Domain Name; and*

2. *The Domain Name, in the hands of the Respondent, is an Abusive Registration.*

Complainants' Rights

Rights is defined in §1 of the Policy as rights enforceable by the Complainant, whether under English law or otherwise, and may include rights in descriptive terms which have acquired a secondary meaning.

The wholly generic suffix “.co.uk” is discounted for the purposes of establishing whether a complainant has Rights in a name or mark which is identical or similar to a domain name.

Despite extensive guidance on the Nominet website setting out a complainant's responsibility to provide evidence to substantiate its complaint, the Complaint is lacking in this respect. No evidence is presented to show the relationship between the Complainants, when trading commenced under the style SHEDSTORE through the website www.shedstore.co.uk and/or the extent of such trading.

Nevertheless, given the low threshold of the first limb of the test and the fact that the Respondent has not disputed the Complainants' assertions in this respect, I accept that the Complainants have Rights in the name SHEDSTORE which predate the registration of the Domain Name and have traded under this style since around 2000.

The Domain Name is a combination of the name SHEDSTORE and a descriptive element, the geographic term UK. The latter does not detract from the dominant and distinctive use of the name SHEDSTORE in the Domain Name. I am satisfied on the evidence before me that through use the name has acquired a secondary meaning. Moreover, as indicated above, one of the Complainants has registered rights in respect of the name dating back to 2004.

Accordingly, the Complainants have satisfied the first limb of the test by demonstrating that they have Rights in the name SHEDSTORE, a name which is similar to the Domain Name save for the addition of the generic suffix.

Abusive Registration

Abusive Registration is defined in the Policy as a Domain Name which either:

1. *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*
2. *has been used in a manner which has taken unfair advantage of or has been unfairly detrimental to the Complainant's Rights.*

The Complainants' allegations of Abusive Registration essentially fall under two heads of a non-exhaustive list of factors set out in the Policy which may be evidence that the Domain Name is an Abusive Registration, namely:

1. §3 a i C of the Policy

“Circumstances indicating that the Respondent has registered or otherwise acquired the Domain Name primarily for the purpose of unfairly disrupting the business of the Complainant”.

2. §3a ii of the Policy

“Circumstances indicating that the Respondent is using or threatening to use the Domain Name in a way which has confused 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”;

The Complainants assert that the Respondent’s selection and use of the name SHEDSTORE in the Domain Name can only be for the purposes of disruption and/or confusion. The Complainants cite the Respondent’s copying of aspects of its www.shedstore.co.uk website, including meta tag data and description, trading in the same products, and the Respondent’s admission of similarities in layout. Evidence is presented by the Complainant to support the first of these assertions, without any time reference point, but nothing else.

The Complainants’ reliance on the incorporation of its trade mark in the Domain Name is cited by the Complainants as leading to confusion. However, there has to be more than this for a finding of Abusive Registration. An allegation of trade mark infringement does not necessarily lead to a finding of Abusive Registration under the Policy (see for example the Appeal Panel decision in DRS 07066).

Fortunately for the Complainants, the Respondent comes to their rescue in the Response by admitting that it had used photographs from the Complainants’ website in creating the website connected to the Domain Name. The Respondent says that the Complainants’ photographs were inadvertently included when the Domain Name went live, but fails to explain why it used the Complainants’ photographs in the first place.

The Respondent trades as Easy Shed and sells sheds and other garden buildings through its Easy Shed website (www.easyshed.co.uk - its domain name having been registered on 15 February 2007). Surely it would have been far easier to have used pictures of its own products and materials from this existing website? The fact that it did not, but used the Complainants’ photographs instead, is significant in establishing the Respondent’s awareness of the Complainants’ Rights and their trading under the Shedstore mark at the time of registration of the Domain Name.

The Respondent fails to explain why it selected the Domain Name and offers nothing by way of justification of its use of the Domain Name save for its claim that since the Respondent manufactures sheds (and the Complainants do not) then there is some distinguishing feature in its use of the Domain Name. I do not accept this claim.

I also note that on visiting the Respondent’s website at www.easyshed.co.uk the visitor is presented with prominent links to other websites operated by the Respondent, including www.shedsale.co.uk which contains a strapline at the bottom of the page which states “Partner UK Shed Store”. This suggests that the Respondent’s strategy was to use the Domain Name to expand its capture of internet traffic looking for sheds and other garden buildings.

I conclude, therefore, on the balance of probabilities, that the Respondent was aware of the Complainants’ Rights at the date of registration of the Domain Name and chose the Domain Name deliberately to take advantage of such Rights for the purpose of achieving, or enhancing, its sales of competing products.

Accordingly, I find that the Respondent registered the Domain Name for the purpose set out in §3a i C of the Policy and is thus an Abusive Registration.

7. Decision

In light of the foregoing findings, namely that the Complainants have Rights in a name which is similar to the Domain Name, and the Domain Name, in the hands of the Respondent, is an Abusive Registration, I direct that the Domain Name, ukshedstore.co.uk, be transferred to the Lead Complainant.

Signed: Steve Ormand

Dated: 12th April 2010