

DISPUTE RESOLUTION SERVICE

D00008999

Decision of Independent Expert

Dream Doors Ltd

and

Alan Mark / Homestyle WTC Ltd

1. The Parties:

Lead Complainant: Dream Doors Ltd
D22 Heritage Business Park
Heritage Way
Hampshire
PO12 4BG
United Kingdom

Respondent: Alan Mark
Homestyle WTC Ltd
Wigan
Lancashire
WN3 4BW
United Kingdom

2. The Domain Name(s):

The domain name in dispute in these proceedings is <dreamdoors.co.uk>
(the “Domain Name”).

3. Procedural History:

- 3.1 The Complaint entered Nominet's system on 2 September 2010. The Complaint was validated under Nominet's dispute resolution service policy (the "Policy") and sent to the Respondent on 9 September 2010.
- 3.2 A Response was filed on 24 September 2010.
- 3.3 Mediation having failed and the Complainant having paid the relevant fee, the Complaint was referred to me. I confirmed that I was not aware of any reason why I could not act as an Independent Expert in this case and I was appointed as such by letter dated 18 November 2010.

4. Factual Background

- 4.1 The poor quality of the submissions of each of the parties, and particularly that of the Complainant, means that the facts in this case are far from clear. Nevertheless, what follows is reasonably apparent from the submissions, a review of the parties' websites at www.dreamdoorsltd.co.uk and www.bedroomdoors.co.uk, and basic checks of the online trade mark database maintained by the Intellectual Property Office.
- 4.2 The Complainant is a company that controls a franchise operation and whose franchisees sell kitchen unit replacement doors and worktops and other kitchen related items. It has 35 franchise showrooms around the country that all trade under the "Dream Doors" name.
- 4.3 The Complainant is the owner of the following registered trade marks:
 - (i) UK registered trade mark no 2280059 filed on 6 September 2001 in classes 35 and 37, with a registration date of 22 March 2002; and
 - (ii) Community trade mark no E3886041 filed on 15 June 2004 in classes 19, 35 and 35 and published on 21 March 2005, with a registration date of 19 August 2005,

The Complainant claims the colours red and white in respect of these marks, both of which take the following form:



- 4.4 The Domain Name was registered in May 2004. It is registered in the name of Alan Mark, who has taken advantage of the "non-trading individual" information opt out so that address details are not displayed. In fact, there seems to be no dispute that the Domain Name is controlled by

Homestyle WTC Ltd, a company that sells replacement bedroom and kitchen unit doors.

- 4.5 If the Domain Name is typed into a browser the user is taken to a website page at www.bedroomdoors.co.uk. At the top of the page in small print is the statement:

“Please be aware that we do not propose to portray or pass ourselves off to be Dream Doors Ltd, or any of it's subsidiary franchises”

The page offers replacement bedroom unit doors, although it also contains in a reasonably prominent position on the page the text and link:

“For Kitchen Doors please click here”

5. Parties' Contentions

Complaint

- 5.1 The Complainant claims that it “used to own the [D]omain [N]ame ... “but didn't re-register it quick enough”. No further details are given in this respect. It contends that it owns a trade mark (which is not identified) in the Dream Doors name.

- 5.2 On the issue of abusive registration, it is easiest to set out the Complainant's contentions in full:

“The other company has bought the domain name but have no relation or work with Dream Doors at all. The company is purely using the Dream Doors .co.uk in order to improve their own ranking on Google as it re-directs to a different website which is nothing to do with Dream Doors. They are taking unfair advantage of our trade mark to improve their position on google.

There was a clear unfair motive when they registered the domain name to use our ranking and online presence to boost their own position and redirect customers to their own site.

Customer searching for Dream Doors will get confused if they then go onto the bedroomdoors.co.uk website where there is a statement saying they are not in anyway connected to Dream Doors. This surely underlies their motive.

When we approached the company they said it would cost us £15,000 to buy it off of them which we do not have the funds to do so. The customer is not willing to enter into any negotiations with us to resolve this matter.”

- 5.3 What the Complainant means by reference to “customer” in the latter paragraph is not clear.

Response

5.4 The Respondent complains that this is the second complaint that has been brought against it under the Policy; the first having been brought against it in August 2005 and having dispute resolution service reference number 2804.

5.5 The Respondent claims that a number of other companies use the term “dream doors”, and lists a number of websites. However, it does not appear to be alleged that any of them use the term “dream doors” in connection with replacement kitchen unit doors.

5.6 The Respondent asserts:

“We use the domain name dreamdoors.co.uk because we sell dream doors”

That does not appear to be a claim that it sells the products of the Complainant but instead an assertion that it is using the term in a descriptive sense.

5.7 The Respondent contends that the words ‘Dream Doors’ cannot be a registered trade mark in its entirety and claims that the registration is limited to the portrayal of that term in red and white. It further claims that the trade mark was only registered in August 2005 (which appears to be a reference to the registration date of the Complainant’s community trade mark).

5.8 The Respondent further claims that it:

“checked at the time of registration [of the Domain Name] if this name had been used before but could not find any reference that it had.”

5.9 The Respondent acknowledges the Complainant’s trade mark but claims that it was registered “on 19th August 2005 which is a year after [the Respondent’s]s own site was live”. It also claims that at the time it registered the Domain Name:

“[w]e did not find any companies using the domain dreamdoors in any format the time of registration other th[a]n an American company. The American company uses the green and yellow trade mark attached.”

5.10 The Respondent further claims that at the time of registration it was unaware of the Complainant and had since 1985 used the terms “doors of your dreams”, “kitchens of your dreams” and “bedrooms of your dreams” in its sales literature. No corroborative evidence is brought forward in support of these contentions.

- 5.11 The Respondent claims that the reason why a disclaimer is to be found on the webpage operating from the www.bedroomdoors.co.uk, was that this was agreed during the mediation process in the previous proceedings commenced under the Policy. It claims that it agreed to display this disclaimer whilst "Dream Doors Ltd decided whether to take [a settlement] offer or go to an independent expert for a decision."
- 5.12 The Respondent denies that it sought £15,000 from the Complainant for the Domain Name. In support of that contention it provides a copy of a without prejudice email from the Complainant dated 9 September 2005 in which the Complainant claimed that a price of £3,000 previously sought for the Domain Name was excessive. The Respondent claims that it then offered the Domain Name to the Complainant for £1,500.

Reply

- 5.13 The Complainant submitted no Reply.

6. Discussions and Findings

General

- 6.1 To succeed under the Policy, the Complainant must prove first, that it has Rights in respect of a "name or mark" that is identical or similar to the Domain Name (paragraph 2(a)(i) of the Policy) and second, that the Domain Name is an Abusive Registration in the hands of the Respondent (paragraph 2(a)(ii) of the Policy). The Complainant must prove to the Expert that both elements are present on the balance of probabilities (paragraph 2(b) of the Policy).
- 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) has been used in a manner which took unfair advantage of or was unfairly detrimental to the Complainant's Rights."*

Complainants' Rights

- 6.3 I do not accept the Respondent's apparent contention that the registered trade mark rights of the Complainant are limited to the use of those marks in red and white and in the exact form identified on the register. There is a difference in trade mark law between limiting one's rights to a mark

expressed in a specific colour and claiming rights in a certain colour¹. The Complainant has done the latter not the former.

- 6.4 I also do not accept (if this is what the Respondent is trying to maintain) that the words “Dream Doors” are so lacking in distinctive character that those words should be ignored for the purposes of comparing mark with domain name under the Policy².
- 6.5 The test under the Policy is simply whether the relevant mark and domain name are similar. This test is easily satisfied in this case. Although the words “Dream Doors” are portrayed in the form of a specific logo, they nevertheless form the predominant element of both of the Complainant’s registered marks.
- 6.6 As to the claim that the Respondent’s use of the term pre-dates the Complainant’s rights, that is not relevant to the assessment under paragraph 2(a)(i) of the Policy (although it can in certain cases be relevant to the assessment as to whether the registration is abusive within the meaning of paragraph 2(a)(ii) of the Policy). In any event, the claim appears to be false at least so far as the Complainant’s UK registered trade mark is concerned.

Abusive Registration

- 6.7 Paragraph 2(a)(ii) of the Policy provides that a Complaint must show either abusive registration or abusive use.
- 6.8 At first sight there would appear to be abusive use in this case. The Complainant has for some time been aware that one of its competitors is using the term “dream doors” as its business name. It does not claim to have used precisely this term (other than in the Domain Name) in its business, and although it does claim to have used these two words (albeit not together) in sales literature, no corroborative evidence of that use has been submitted in these proceedings. Further, on any objective assessment it must be apparent to the Respondent that, whatever its initial intentions, it is now using 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 so as to divert customers internet users to its www.bedroomdoors.co.uk website. Such activity falls prima facie within the scope of paragraph 3(a)(ii) of the Policy.
- 6.9 The fact that there is a disclaimer on the web page to which internet users are taken, does not change that analysis. At that stage the damage has been done. Even if the disclaimer and/or other content on the webpage

¹ This difference is explained at length in *Phones4U Ltd v Phone4u.co.uk Internet Ltd* [2006] EWCA Civ 244

² Presumably by analogy to the reasoning in the UDRP case of *Brisbane City Council v. Warren Bolton Consulting Pty Ltd*, WIPO Case No. D2001-0047.

succeeds in making it clear to a large number of those who reach the site that it is unconnected with the Complainant, the fact is that the Respondent has relied upon confusion to bring those individuals to its site in the first place. This is sufficient under the Policy (see the Appeal Panel decision in *Rayden Engineering Ltd v Diane Charlton* DRS 06284).

- 6.10 Indeed, the use of the disclaimer of itself appears to amount to an acceptance on the part of the Respondent that there is likely to be confusion in this case that may need to be dispelled. I note the Respondent's claim that this disclaimer was added as a result of mediation discussions in the earlier proceedings. But the Respondent does not claim that this formed part of some general settlement agreement between the parties in relation to the use of the Domain Name. It is, therefore, questionable whether it is proper to take any notice of any statement as to what went on in that mediation. However, regardless of whether it would be proper to do so, the Respondent's claim in this respect is difficult to understand or to follow. Why (as appears to be claimed) the addition of this disclaimer might be of use as a temporary expedient whilst the Complainant pondered whether to accept a settlement offer or proceed to the appointment of an expert, is not explained. Even if true, it is clear that this disclaimer has remained in place long after that mediation was over.
- 6.11 Further, I am unconvinced that the defence provided by paragraph 4(a)(ii) of the Policy that the "Domain Name is generic or descriptive and the Respondent is making fair use of it" applies in this case. The term "dream doors" has a potential descriptive use but is not generic or descriptive to the same extent as the words, "kitchen doors", "replacement kitchen doors" or even "kitchen doors of your dreams". If a domain name is entirely descriptive and inherently incapable of ever distinguishing the goods or services in respect of which it is being used, paragraph 4(a)(ii) of the Policy is likely to provide a defence, regardless of the registrants knowledge or intentions. Otherwise the registrant's knowledge and intentions and motives are key.
- 6.12 However, there is a complication in this case. Although, usually it is necessary to show either abusive registration or use, there are cases where the assessment of one can influence the other. Where an entity non-abusively registers and uses a domain name to take advantage of a potential descriptive meaning and merely continues to use that domain name in the same manner as he has always done, that continued use where another person comes along and develops a reputation in that term, even if it knowingly results in confusion, is unlikely to involve abusive use (see the decisions of the Appeal Panel in *Verbatim Ltd -v- Michael Toth* DRS 4331, the Appeal Panel in *MySpace, Inc v Total Web Solutions Limited* DRS 4962³ and the decision in *Oasis Stores Limited v Dale* DRS 6365).

³ See in particular the statement in that decision: "... the registration of domain names is still a first-come-first-served system and the Panel is reluctant to place any duty on a registrant, who has merely had the good fortune (or maybe ill fortune) to register a name in good faith, which subsequently, through no fault of his own, acquires notoriety, provided that he does nothing actively to exploit his position. "

- 6.13 Although the phrase “dream doors” is not so inherently incapable of distinguishing replacement kitchen doors, that paragraph 4(a)(ii) of the Policy provides an absolute defence, it is still a term that might conceivably be registered for its laudatory content and without intent to take advantage of an association with the Complainant’s business and marks. If the Respondent registered the Domain Name for these reasons and the Respondent merely continued to use it after it became aware of the Complainant’s marks, then, in my opinion, such continued use is not abusive. This is so even though (and notwithstanding some interpretations of the *MySpace, Inc* decision that it involved registration before the complainant even had rights) at least one of the Complainant’s trade marks pre-dates the Respondent’s initial registration
- 6.14 This, therefore, raises what is factually the key question in this case; i.e. whether at the time of registration of the Domain Name the Respondent was aware of the Complainant and its use of the “Dream Doors” name. The Respondent’s position in this respect is unequivocal. It claims that in May 2004 it had not heard of the Complainant.
- 6.15 It is an assertion that raises as many questions as it answers. Why did the Respondent choose that particular combination of words when so many other descriptive or laudatory combinations might have been chosen? Is it really credible that the Respondent happened to choose a combination of words that was the same as the name of a potential competitor?
- 6.16 However, ultimately and notwithstanding those questions, I am not prepared to make a finding in the Complainant’s favour on this issue. The issue of the Respondent’s knowledge is not addressed in any convincing manner in the Complaint. There is no description of when the Complainant started business, the size or geographical scope of that business in 2004 or why it should be reasonably inferred from these or other facts that the Respondent is likely to have known of its business at the time the Domain Name was registered. Perhaps the Complainant could not have anticipated that the Respondent might claim in the Response that it had not heard of the Complainant at the time it registered the Domain Name. However, once it received the Response, the Respondent’s position was clear. The Complainant then had an opportunity to address that statement in a Reply if it considered the statement to be false. For reasons best known to itself it chose not to do so.
- 6.17 In the circumstances the Complainant has not made out the requirements of Paragraph 2(a)(ii) of the Policy.
- 6.18 That does not necessarily mean that the Complainant is without any remedy. It appears to have a registered trade mark that pre-dates the Respondent’s use of the term “dream doors” in a domain name. That raises a question as to whether that continued use involves an infringement of its trade mark rights. It is an issue upon which the Complainant may wish to take legal advice. However, it is not a matter for the Policy.

7. Decision

- 7.1 In light of the foregoing, and in particular the Complainant's failure to establish that the Domain Name is an abusive registration, the Complaint is rejected.

Signed: Matthew Harris

Dated 25 November 2010