

DISPUTE RESOLUTION SERVICE

D00009389

Decision of Independent Expert

Mere Marketing

and

Mr Michael Gallagher

1. The Parties:

Lead Complainant: Mere Marketing
Lyncastle Road
Appleton Thorn
Warrington
Cheshire
WA4 4SN
United Kingdom

Respondent: Mr Michael Gallagher
135 Doncaster Rd
Barnsley
South Yorkshire
S70 1UF
United Kingdom

2. The Domain Name(s):

<meremarketing.co.uk> (the “Domain Name”)

3. Procedural History:

On 17 December 2010 the Complaint was received by Nominet, which then notified the Complaint to the Respondent.

On 13 January 2011 the Response was received from the Respondent.

On 18 January 2011 the Reply was received from the Complainant.

On 9 February 2011 Nominet received payment for an Expert decision.

On 14 February 2011 Christopher Gibson was appointed as Expert.

4. Factual Background

The Complainant, Mere Marketing, is a business partnership that supplies bathrooms and has operated under the name of Mere Marketing with the brand name Mere Bathrooms. The Complainant's domain name is <merebathrooms.co.uk>.

The Respondent is an individual, Michael Gallagher, who is connected to a business that supplies bathrooms. The business operates under the name of Nationwide Bathrooms and has a web site under the domain name of <nationwidebathrooms.co.uk>.

The Domain Name was registered on 6 June 2006 at the same time that the Respondent registered the domain name <nationwidebathrooms.co.uk>.

5. Parties' Contentions

Complainant: The Complainant states it has operated its business under the name of Mere Marketing since 1995, selling Mere Bathroom products. The Domain Name is identical to the name of the Complainant's business, which specialises in "Mere Bathrooms." The Complainant has been actively using the name of Mere Marketing in its sales of Mere Bathrooms since 1995. Evidence of this is by way of their business logo, letter head stationery, and marketing information. The oldest exhibit which the Complainant has provided to support continuous use since 1995 is a Product List dated May 1999. The Complainant's buildings have incorporated the Mere Marketing in to the external signage for their premises. The Complainant's website operates under the domain name <merebathrooms.co.uk>, which refers throughout to the established business name of "Mere Marketing." Quotations from this exhibit include the welcome note on the home page:

"Welcome to Mere Marketing...It's reassuring to know that no matter how hectic everyday life so becoming, the team at Mere haven't forgotten the importance of traditional service..."

Also, the Contact Us web page, which provides contact information under the name of Mere Marketing, as follows:

"...contact our sales team...
E: sales@merebathrooms.co.uk...
Mere Marketing

Lynecastle Road
Appleton Thorn
Warrington
WA4 4SN..."

The Complainant alleges the Domain Name is an Abusive Registration. The Complainant has submitted evidence that the Respondent is connected to Nationwide Bathrooms, through a previous application for credit which the Complainant received from the Respondent dated 17 February 2004. The application names Michael Gallagher as the Managing Director of Select Bathrooms.

The Complainant asserts that the Domain Name is a blocking registration used for the purpose of unfairly disrupting the business of the Complainant: The Complainant has entered into both written and verbal correspondence with the Respondent regarding the Domain Name. The first correspondence was by email on 11 May 2009. The Complainant contacted the Respondent again on 26 May 2009 by telephone when the Respondent agreed to "switch it off." The Complainant contacted the Respondent again on 6 August 2009 by telephone when the Respondent agreed to transfer the Domain Name. On 11 August 2009 the Complainant sent a follow-up mail to the Respondent. On 19 August 2009 the Complainant contacted the Respondent again to inform him that the Domain Name was still pointing to the Nationwide Bathrooms web site. The Respondent indicated that he was now reluctant to transfer the name. The Respondent enquired as to receiving a compensation payment. The Complainant offered £100. On 21 August 2009 a representative of the Complainant's called on the Respondent, who repeated his reluctance to part with the Domain Name and indicated that there was "nothing in it for them". The representative informed the Respondent that if no agreement was reached, the Complainant would take legal action. The fact that the Respondent previously has had the Domain Name pointing to his own web site (Nationwide Bathrooms), and his refusal to transfer the Domain Name despite the fact that the Domain Name's web site is now blank, along with the history of correspondence between the two parties, provides evidence that the Respondent intended to block the registration and has unfairly disrupted the business of the Complainant.

The Complainant has also alleged circumstances which indicate that the Respondent is using the Domain Name in a way which has confused people or businesses into believing that the Domain Name is registered to the Complainant. The Complainant has attached copies of correspondence from a business contact that inadvertently sent emails to cameron@meremarketing.co.uk, on the assumption that it was registered to the Complainant and linked to the sale of Mere Bathrooms. The evidence illustrates the frustration and delays that this confusion has caused to the Complainant. In particular, the Complainant refers to an email from the Sales Manager of Dart Office, dated 13 October 2009, which states:

"...I felt compelled to drop you an email, to note how appalled we are at this email saga. Your company is 'Mere Marketing', not 'Mere Bathrooms', so if any of us send an email to any of your team there, we expect it to fall into the hands of the person we intend. We now find out that not only have

you not received our emails, but that they've been opened and read by a totally different company! This not only applies to general business messages, but to some highly-confidential communications...if I had my way, that company would be severely penalised - it's caused us a lot of wasted time, hassle and anxiety. To say "we're trying to get it sorted", is not satisfactory - this needs addressing urgently..."

The Complainant highlights that this evidence refers to emails which have been opened and read. This would suggest that the Respondent has set up an "inbox" to receive the misdirected emails for the "@meremarketing.co.uk" address. The Complainant also refers in particular to the email from Aspen Luxury Bathrooms, dated 13 October 2009. This email relates to an apology regarding a missing order due to the same confusion. The writer of the emails states:

"...We are unsure as to where we obtained the email sales@meremarketing.co.uk, as we have no knowledge of any other company trading under this name and have always referred to yourselves as Mere Marketing, therefore we assumed this e-mail address belonged to you. This has resulted in a number of orders not being processed, not only does this make Aspen look bad, more importantly it lets our customers down..."

The Complainant believes that it has provided sufficient evidence to fulfil the criteria under Nominet's Policy, in that it has established a Right to the Mere Marketing name and that an Abusive Registration exists. The Complainant refers in particular to a leading case on cyber squatting, British Telecommunications Plc v One In A Million, where the court held that an injunction is available where passing off has been established or threatened. To be active passing off, there must be: (i) a misrepresentation; (ii) made by a trader in the course of business; (iii) to prospective customers or ultimate customers of goods or services supplied by him; (iv) which is calculated to injure the business or goodwill of another trader in the sense that it is reasonably foreseeable; and (v) which causes actual damage to the business or goodwill. In this respect, the Complainant believes that the evidence provided illustrates that the intention of the Respondent was to cause confusion and to disrupt goodwill by leading people to his own website and thus enticing customers away. According to the Complainant, the fact that Nationwide Bathrooms stopped this diversion indicates that the Respondent admits liability.

Since payment was discussed (without success) between the parties in relation to transferring the Domain Name to the Complainant, this suggests that an element of the Respondent's purpose in registering the Domain Name was to extract money from the Complainant, in which case, the Domain Name itself becomes an instrument of fraud, which is evidence of passing off. The Complainant has gone to considerable time and cost to resolve the matter, but without success.

The Complainant claims that for the reasons above it has Rights to the Domain Name because it was incorporated into its business activities, and that the registration by the Respondent is an Abusive Registration, which has taken unfair advantage of the Complainant and has caused confusion to people and business associates, who believe that the Domain Name is registered to, operated by, authorised by and connected to the Complainant.

Respondent: The Respondent submits that the Complaint should be rejected on the basis that the Respondent's registration of the Domain Name does not constitute an Abusive Registration as defined under the Policy.

The Respondent acknowledges that he is connected to a business that supplies bathrooms, operating under the name of Nationwide Bathrooms and with a web site using the domain name <nationwidebathrooms.co.uk>. The Respondent also admits that the Domain Name is identical to the name of the Complainant's business, Mere Marketing, which specialises in Mere Bathrooms, but Respondent disputes that the Complainant has actively operated its business under the name Mere Marketing since 1995, as no substantiation of this length of operation has been provided.

The Respondent denies that the registration of the Domain Name constitutes an abusive registration for the purpose of unfairly blocking or disrupting the business of the Complainant. The Respondent contends that the Domain Name was registered with the intention of using it for the purpose of the marketing of the Respondent's own goods. As such, the Respondent's position is that the Domain Name was registered in connection with a genuine offering of the Respondent's goods and for genuine commercial reasons. The Respondent concedes that it has not yet made use of the Domain Name in connection with a website to market the Respondent's goods, but asserts that this was and remains the Respondent's intention.

The Respondent also denies that previously pointing the Domain Name to his own website and the previous refusal to transfer the Domain Name to the Complainant is evidence that the Respondent intended to block the Complainant's registration of the Domain Name. The Respondent's argues that the pointing of the Domain Name to the Respondent's own website was a temporary measure and the Respondent intends to make use of the Domain Name as a marketing tool for the Respondent's goods.

The Respondent denies that the two emails referenced by the Complainant above constitute a disruption to the business of the Complainant. The Respondent observes that, although the two emails are presented as independent emails, they are both dated 13 October 2009. Further, the Respondent asserts that any disruption to the Complainant's business can only be minimal given the lapse of time prior to the commencement of these proceedings. With reference to the email from the Sales Manager of the Dart office referenced above, the Respondent avers that although Complainant has asserted that the email's content suggests that the email correspondence has been opened and read, this is not in itself evidence that the aforementioned emails have indeed been opened and read by the Respondent.

The Respondent refutes that by stopping the redirection of the Domain Name to the Respondent's current website, this is indicative of an admission of liability and avers that this was also intended to be a temporary measure.

The Respondent admits that the Complainant has offered payment to secure an agreement that the Respondent transfer the Domain Name to the Complainant.

The offer made by the Complainant was insufficiently attractive to the Respondent to justify transferring the Domain Name, given that the Respondent intends to make use of it as a marketing vehicle. The Respondent also states that the trading in domain names for profit and the holding a portfolio of domain names is a lawful activity.

Finally, the Respondent highlights that the Complainant has previously brought this claim under this procedure yet seemingly elected not to pay the fee for the Expert's decision as confirmed by the letter sent by Nominet dated 29 November 2010, resulting in the matter being closed.

Reply: The Complainant observes that the Respondent has challenged the Complainant's duration of use of the Mere Marketing name. In particular, the Respondent has denied that the Complainant's business has operated under the name of Mere Marketing since 1995. In response to this challenge, the Complainant has submitted evidence in the form of three documents – an invoice and two utility bills dating from March and May of 1995 – to substantiate that it has been actively operating under the name of Mere Marketing since 1995, and that the Complainant has been actively using the name of Mere Marketing in its sales of Mere Bathroom products since 1995.

6. Discussions and Findings

Paragraph 2.a of the Policy provides that a Respondent must submit to proceedings under the DRS if a Complainant asserts, according to the Procedure, that:

- 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.

Paragraph 2.b of the Policy provides that the Complainant is required to prove to the Expert that both elements are present on the balance of probabilities.

Complainants' Rights

The Complainant has provided evidence of the use of its name, Mere Marketing, for its business since 1995. The Respondent has conceded the Complainant uses this name, but contests only the length of the period of that use and whether it dates from 1995. The Expert finds that the Complainant, through the evidence submitted with its Reply, has substantiated use of the name for its business from 1995, consistent with the Complainant's own statements to this effect. The Complaint also provided evidence of use from 1999. The Complainant's use of the Mere Marketing name for trading in connection with its bathroom business has given rise to Rights in the name for purposes of this Policy.

The Domain Name consists of the word “meremarketing” in combination with the ccTLD extension “.co.uk.” The Expert finds that, for purposes of the Policy, the Domain Name is identical to the Complainant’s name.

The Expert determine, on the evidence, that Complainant has rights in the Mere Marketing name, which is identical to the Domain Name <meremarketing.co.uk>. The Complainant has therefore satisfied the first element in Paragraph 2(a)(i) of the Policy.

Abusive Registration

An Abusive Registration, as defined in paragraph 1 of the Policy, 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 Complainants’ Rights; or
- ii. has been used in a manner which has taken unfair advantage of or has been unfairly detrimental to the Complainants’ Rights.

The Expert finds that the Complainant has satisfied both of the above grounds. On the evidence, the Expert finds that it is beyond coincidence that Respondent would have chosen and registered the Domain Name, which is identical to the Complainant’s Mere Marketing business name and similar to its Mere Bathrooms brand name. The Respondent registered the Domain Name in 2006, more than 10 years after the Complainant commenced using its name. There is evidence that the Respondent was aware of the Complainant and that the Respondent operates a bathroom business in competition with the Complainant. On the same date that the Respondent registered the Domain Name, it also registered the domain name <nationwidebathrooms.co.uk>, which the Respondent acknowledges matches its business name, Nationwide Bathrooms, and which has been used for the Respondent’s own website. This evidence contradicts the Respondent’s assertions that it was planning to use the Domain Name “in connection with a genuine offering of the Respondent’s goods and for genuine commercial reasons.” Instead, the Expert finds that the Respondent was aware of the Complainant’s name and reputation and registered the Domain Name in order to use it to block the Complainant and to take advantage of the Complainant’s goodwill by confusing Internet users and diverting them to Respondent’s website for commercial gain. It follows that the Domain Name was registered in a manner which, at the time when the registration took place, took unfair advantage of the Complainants’ Rights in its Mere Marketing name.

The Expert further finds, on the balance of probabilities, that Respondent has been using the Domain Name in a way which has confused or is likely to confuse third parties into believing that the Domain Name is registered to, operated or authorized by, or otherwise connected with the Complainant. The Respondent pointed the Domain Name to its own website at <nationwidebathrooms.co.uk>. The Expert finds that the Respondent’s explanation for doing this – that it was only a temporary measure and that Respondent intended to use the Domain Name for its own business – is unconvincing. The Respondent has never been

known by the name Mere Marketing. The email communications referenced above indicate that the Respondent was using the Domain Name to disrupt the Complainant's business and extort payment from the Complainant.

For all of the above reasons, this Expert finds that the Domain Name is an Abusive Registration in the hands of the Respondent and that the Complainant, having satisfied the second element of the test in Paragraph 2(a) of the Policy, is entitled to succeed in its application.

7. Decision

For reasons given above, I hereby decide and direct that the Domain Name <meremarketing.co.uk> be transferred to the Complainant.

Signed Chris Gibson

Dated 23 March 2011