



DISPUTE RESOLUTION SERVICE

D00009398

Decision of Independent Expert

Shoe Zone Limited

and

Mr Rimvydas Karpavicius

1. The Parties:

Complainant: Shoe Zone Limited
Haramead Business Centre
Humberstone Road
Leicester
Leicestershire
LE1 2LH
United Kingdom

Respondent: Mr Rimvydas Karpavicius
BM Box 1774
London
WC1N 3XX
United Kingdom

2. The Domain Name:

I have been asked to provide a Decision under Nominet's Dispute Resolution Service (**DRS**) Policy in respect of the domain name, shoeexpress.co.uk (the **Domain Name**).

3. Procedural History:

3.1 The Complaint has reached this point with the following procedural history:

- o 14 January 2011 10:23 Dispute received
- o 17 January 2011 09:37 Complaint validated
- o 17 January 2011 09:44 Notification of complaint sent to parties
- o 07 February 2011 08:50 Response received
- o 07 February 2011 10:05 Notification of response sent to parties
- o 10 February 2011 01:30 Reply reminder sent
- o 15 February 2011 11:55 Reply received
- o 15 February 2011 11:56 Notification of reply sent to parties
- o 15 February 2011 11:57 Mediator appointed
- o 18 February 2011 12:07 Mediation started
- o 21 March 2011 11:26 Mediation failed
- o 21 March 2011 11:34 Close of mediation documents sent
- o 31 March 2011 10:14 Expert decision payment received

3.2 I was appointed as Expert on 13 April 2010. I have confirmed to Nominet that I am independent of each of the parties and that I am not aware of any facts or circumstances which might call my independence into question.

3.3 A procedural matter of some significance arises in this case, in that the Respondent has complained that the Complainant has raised a large part of its substantive case in its Reply, which was not properly in reply to the issues in the Response but should have been raised in the original Complaint. This objection is based on paragraph 6b. of the DRS Procedure, which states the following:

“6b. Any reply by the Complainant must be restricted solely to matters which are newly raised in the Respondent’s response and were not raised in the Complainant’s complaint as originally submitted to us. If an Expert is appointed and the reply extends to other matters, the Expert may declare it inadmissible to the extent that it deals with matters going beyond those newly raised in the Respondent’s response. To the extent that the Expert intends to take note of any new material, the Expert should invite the Respondent to file a further submission in response to that material and such further submission shall not exceed 2000 words (not including annexes).”

3.4 As I shall explain further in the Discussion section below, in my assessment, the new material and submissions introduced in the Reply arguably did respond to matters raised in the Response. However, they were of such a nature that one would normally have expected to see them in the initial Complaint.

3.5 Had the content of the Reply taken the case from one that the Complainant would have lost to one which looked as though it may succeed, I would have had to decide between excluding the additional material or admitting it but inviting a further submission from the Respondent. Since this is not the position, and as I have concluded that the Complaint fails, even taking the content of the Reply into account,

I have been able to reach my decision without taking either course. Of course, if the Complainant were to appeal against this decision, it would be open to the Respondent to argue that parts of the Reply should be ignored or that it should be entitled to lodge new submissions or evidence in response to it in the appeal proceedings. I express no view on the merits of such arguments.

4. Factual Background

4.1 The facts set out below, which are agreed or which I find without difficulty to be true, are derived from the Complaint, Response and Reply and their various exhibits. I have not reviewed any websites in connection with the case, but I have checked to see what currently happens when I type the web address that incorporates the domain name, i.e. <www.shoeexpress.co.uk>, into the address field of a web browser. The answer is that nothing can be found at this address.

4.2 The Complainant is a retailer of footwear which *inter alia* operates a chain of stores in the United Kingdom under the name SHOE EXPRESS.

4.3 The Complainant owns the following registered trade marks in respect of the name SHOE EXPRESS (words only):

- (a) UK trade mark no. 2003533, filed on 30 November 1994 and registered in respect of a variety of goods in Classes 14, 18, 21, 25 (including “footwear”) and services in Class 36; and
- (b) Community trade mark no. 5039466, filed on 25 April 2006 and registered in Class 35 in respect of *inter alia* “retail services connected with the sale of footwear”

(the **Trade Marks**).

4.4 The Complainant was first involved with the SHOE EXPRESS brand in 2008 when it acquired the assets, including goodwill, relating to the brand. The extent of the reputation and goodwill associated with the brand during the period relevant to this Complaint is in dispute.

4.5 The Respondent registered the Domain Name on 21 March 2004.

4.6 The Respondent’s business is not specified, though it appears to include the registration, use and sale of domain names. In particular, the Respondent has registered the following domain names on the dates listed:

- o cityexpress.co.uk 16 Apr 2003
- o shopexpress.co.uk 13 Apr 2004
- o shoeexpress.co.uk 21 Mar 2004
- o phoneexpress.co.uk 02 Feb 2005
- o expressdating.co.uk 13 Jan 2005
- o payexpress.co.uk 23 Feb 2005

- o carinsuranceexpress.co.uk 24 Nov 2008
- o expresstravelinsurance.co.uk 24 Nov 2008

- 4.7 The Respondent has been the subject of two previous DRS complaints by unrelated parties – one in relation to the domain name countryproperties.co.uk and the other to airlinewarehouse.co.uk. He successfully defended the former (DRS 6828 – *Greenrose Network (franchise) Limited v Rimvydas Karpavicius*), but lost the latter (DRS 1576 – *Alfendo Limited t/as Airline Warehouse v Rimvydas Karpavicius*).
- 4.8 When the Respondent first registered the Domain Name, he connected it to a parking page provided by a third party provider (Mirago Plc), which generated the display of advertising links at least some of which related to shoes.
- 4.9 On 1 November 2005, the Respondent received an email from Tony Dickinson, Head of IT at Stead & Simpson (the then owner of the SHOE EXPRESS label), entitled “Shoexpress Domain Name”, in the following terms:

Dear Sir

On checking all of our domain name registrations it seems that you have been able to aquire our shoexpress.co.uk domain. We believe this is for the sole intention of cyber squatting and extrating value out of our trademark. If we do not hear anything by 4th November 2005 enabling us to re-register our trademark we will be persuing this through Nominet

- 4.10 The Respondent responded on 30 December 2005, as follows:

Dear Mr Dickinson,

I am sorry for not replying to you message earlier. I do apologise for inconvenience caused. I am bit disappointed that you made conclusions about me, my domain and my affairs. In fact I never heard about your company or about shoexpress trademark. With the way Nominet operates, it does not ask to check trademarks before registering domain name.

Also you have to keep in mind that trademark does not make one an "owner" of that word or combination of words. Trademark only allows one to trade with that name under very specific category of trade. It means – if one has trademark for example: *McDonald's* for restaurant business, it doesn't not mean that someone else can't register trademark *McDonald's* for other line of business. It could be anything, from scuba diving to knitting.

It seems you are head of IT, but you are talking about law here. I am not sure if you qualified to make such comments and judgments. I will believe that you have no intention to insult me. As I mentioned, I never heard about your business and it seems it has very little presence here in UK. As gesture of good will, I have disabled domain name until this mater resolved.

I won't be able to respond to any enquiries before 22 of January, and first part of February, because my travel commitments. Please feel free to speak to my solicitor Adam Taylor; you can get his contact details from website www.adlex.co.uk. Adam is one the top

solicitors in UK (if not in the world) when comes to trademarks. He will be able to answer questions, which you may have.

Best Regards

Max R Karpavicius

4.11 The matter was not pursued further at the time, but the Respondent kept the Domain Name disabled, i.e. not pointing to an active web page, thereafter.

4.12 There was a four year gap. Then, on 20 January 2010, the Respondent received the following email:

We are interested in purchasing the shoeexpress.co.uk domain name that you currently have registered.

Are you interested in selling and if so at what price?

Regards

--

Nigel Humphries

Head of IT

Shoe Zone Ltd & Tyler Ltd t/a Stead and Simpson

4.13 The Respondent replied later the same day, saying:

Hi Nigel,

Feel free to make an offer.

Thanks

Max R Karpavicius

4.14 Instead of the offer that the Respondent might have hoped for, he received a letter before action from the Complainant, signed by its in-house solicitor, Mr Lee Hennell, dated 4 February 2010. This asserted that the Shoe Zone Group of companies was a retailer with a significant share of the UK footwear market and had “a well established reputation across the United Kingdom and the rest of Europe” and the registered trade mark for inter alia “Shoe Express”. The letter expressed concern that the existence of the Respondent’s website may cause confusion to customers, causing them to believe that there was a connection to the Shoe Zone Group and their trade marks. The letter also expressed concern that the advertisement links on the Respondent’s site directed potential customers to Shoe Zone’s competitors and that the Respondent seemed to be deriving an income from those links.

4.15 The letter went on to assert that the Respondent’s use of the name ‘Shoe Express’ amounted to trade mark infringement and took advantage of Shoe Zone’s goodwill and reputation, and to ask the Respondent to give the following undertakings: to cease using the website www.shoeexpress.co.uk and to transfer it to Shoe Zone Limited within 7 days; not to advertise or market himself as ‘Shoe Express’; to provide details of income derived from the website; and to pay legal costs – then calculated as £350 +

VAT. It finished by threatening an application to court for an order against trade mark infringement if the Respondent did not give the requested undertakings within 7 days.

- 4.16 On 19 February 2010, having received no response, Mr Hennell sent a chaser email to the Respondent, attaching a further copy of the 4 February letter, and ending as follows:

In an attempt to resolve this issue without resorting to litigation, I am writing to make a final request for you to assist in the manner set out in my letter within seven days, failing which we feel that you are giving us no option but to make an application to the court. I would reiterate that such an application will include a claim for damages, costs and interest.

- 4.17 The Respondent responded by email on 22 February 2010, stating that he had not received the letter from Mr Hennell and that in January and February, “there was malfunction on my mail box facility” which may have prevented some mail getting to him. Having pointed out that he had registered the Domain Name 6 years previously and that the Complainant was potentially liable for making groundless threats of trade mark infringement, the Respondent stated his surprise that the Complainant had managed to register such a generic and descriptive phrase as “Shoe Express” and asserted that the Complainant was being “hostile and opportunistic”, and gave the following reaction to the Complainant’s claims of use, reputation and likelihood of confusion:

You claim that you have established brand under name of “Shoe Express” across United Kingdom. However I failed to find “Shoe Express” outlet in London and more specifically - Central London, where I live and work. My business catchment area is London. In fact, I haven’t ever seen “Shoe Express” outlet, sign, billboard or ad in national press or on TV. You did not provide evidence to support your claim of “established reputation”.

In your letter you refer to www.shoepress.co.uk website, but you did not provide evidence of such website. I have failed to find website at this address. The domain shoeexpress.co.uk is registered to my name but as far as I’m aware, not pointing to any website. What you seeing could be a website provided by your web browser. You should contact your software vendor with any questions.

You claim that existence of my alleged website may cause confusion to your customers, but you failed to provide any supporting evidence. Your claim is based on assumption therefore not true. I failed to find website under your brand for which allegedly your customer would be looking for.

- 4.18 Mr Hennell responded on 10 March 2010, apologising for mistaking “shoexpress.co.uk” (which he said was registered to a third party based in Malta) for the Respondent’s domain. His email stated:

I note that you registered your domain a few years ago, but the “Shoe Express” brand first appeared on the High Street back in the early 1990’s. By the mid 1990’s there were hundreds of Shoe Express stores nationwide. I can provide you with evidence, if that would assist, but in doing so, costs will increase.

It went on to state Mr Hennell's belief that the Complainant had a very strong case to have the Domain Name transferred to the Shoe Zone Group and invited the Respondent to call him to have a without prejudice conversation about the issue.

- 4.19 The last piece of correspondence among the papers filed with Nominet was an email from the Respondent to Mr Hennell of the Complainant, dated 16 March 2010, stating that he had tried to call Mr Hennell but got no answer, and setting out two phone numbers on which Mr Hennell could contact him.
- 4.20 It is not clear whether any further correspondence took place between the parties, but the matter was clearly not resolved, since this Complaint was filed. In the meantime, the Respondent did nothing active with the Domain Name.

5. Relevant Provisions of the DRS Policy

General

5.1 Paragraphs 2a. and b. of the Policy provide as follows:

- a. *A Respondent must submit to proceedings under the DRS if a Complainant asserts to us, 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 (as defined in paragraph 1 of the Policy).*
- b. *The Complainant is required to prove to the Expert that both elements are present on the balance of probabilities.*

Rights

5.2 Under paragraph 1 of the Policy:

***"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".*

Abusive Registration

5.3 Paragraph 1 of the Policy defines an **"Abusive Registration"** as:

"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 has taken unfair advantage of or has been unfairly detrimental to the Complainant's Rights."

5.4 In reaching their decisions, the Experts have to take into account all relevant facts and circumstances which point to or away from a Domain Name being an Abusive Registration. Some non-exhaustive examples are set out in the Policy.

5.5 Paragraph 3 of the Policy sets out a list of factors which may be evidence that a Domain Name is an Abusive Registration. Those that are brought into play in this case are as follows:

"3a.i. Circumstances indicating that the Respondent has registered or otherwise acquired the Domain Name primarily:

A. for the purposes of selling, renting or otherwise transferring the Domain Name to the Complainant or to a competitor of the Complainant, for valuable consideration in excess of the Respondent's documented out-of-pocket costs directly associated with acquiring or using the Domain Name;

B. as a blocking registration against a name or mark in which the Complainant has Rights; or

C. for the purpose of unfairly disrupting the business of the Complainant;

ii. 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;

iii. The Complainant can demonstrate that the Respondent is engaged in a pattern of registrations where the Respondent is the registrant of domain names (under .uk or otherwise) 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..."

5.6 On the other hand, paragraph 4 of the Policy list some factors which may demonstrate that a Domain Name is not abusive. Those relevant here are as follows:

"4a.iii. The Domain Name is generic or descriptive and the Respondent is making fair use of it;...

4d. Trading in domain names for profit, and holding a large portfolio of domain names, are of themselves lawful activities. The Expert will review each case on its merits.

4e. Sale of traffic (i.e. connecting domain names to parking pages and earning click-per-view revenue) is not of itself objectionable under the Policy. However, the Expert will take into account:

i. the nature of the Domain Name;

ii. the nature of the advertising links on any parking page associated with the Domain Name; and

iii. that the use of the Domain Name is ultimately the Respondent's responsibility."

6. Parties' Contentions

Complaint

- 6.1 The Complaint states that the Complainant has Rights in the Domain Name because it is the registered proprietor of the UK and Community registered Trade Marks (which I have identified in paragraph 4.3 above) for the identical mark. It also asserts that "[t]he Complainant's Trade Marks provide it with a monopoly to exclusively use SHOE EXPRESS in the UK and throughout Europe".
- 6.2 In support of the assertion that the Domain Name is an Abusive Registration, the Complaint first sets out the definition in paragraph 1 of the Policy and then goes through each paragraph 3 factor relied on.
- 6.3 First, the Complainant claims that, contrary to (at least) paragraph 3a.i.A. of the Policy, the registration was primarily registered for the purposes of stopping the Complainant registering it, despite the Complainant's rights in SHOE EXPRESS. Secondly, by reference to the same provision, the Complainant says that the Respondent registered the Domain Name over ten years after the Complainant's UK trade mark no. 2003533 came into existence, and shortly before the Complainant was due to renew that registration. The Complainant asserts that the Domain Name was registered in the hope that the Complainant would fail to renew its trade mark registration.
- 6.4 Thirdly, the Complainant asserts that contrary to (at least) paragraph 3a.i.C. of the Policy, the Domain Name was registered for the purpose of unfairly disrupting the business of the Complainant. It is pointed out that, from its registration date of 21 March 2004 until at least 13 August 2005, the Domain Name was parked at a BeeGoo parking page offering links to competitors of the Complainant. Print-outs are exhibited, which are said to be from the internet archive "Wayback Machine" and to show the use of the Domain Name. (I note that it is not clear from the face of the print-outs that they relate to the Domain Name – and the details in the footer of each page indicate that they relate to 26 February 2006, which is not in the period referred to above.)
- 6.5 The Complaint asserts, fourthly, that the Respondent is using the Domain Name "to primarily sell it to the highest bidder", and in doing so is using a mark which is identical to the Complainant's Trade Marks in the course of a trade in relation to identical goods and services for which the Trade Marks are registered, which both takes unfair advantage and is unfairly detrimental to the Complainant's Rights.
- 6.6 Fifthly, the Complaint claims that, contrary to (at least) paragraph 3a.ii., the circumstances indicate that the Domain Name will confuse people and/or business into believing that the Domain Name is registered to, operated by, or connected to the Complainant. It is asserted that, since the Domain Name is identical to the Complainant's Trade Marks and has been used in relation to identical goods and

services, confusion can be inferred. A visitor to the website at www.shoeexpress.co.uk, would believe that the blank page that was now found there was operated by, connected to, or associated with the Complainant. This is likely to cause damage to the Complainant's reputation, insofar as a brand with a reputation as substantial as the Complainant as one of the largest shoe retailers in the UK, should not have inactive web pages.

- 6.7 Finally, the Complaint claims that, contrary to (at least) paragraph 3a.iii., the Respondent has engaged in a pattern of registrations which correspond to well known names and/or trade marks. At least two previous complaints have been made in relation to domain names registered by the Respondent: www.countryproperties.co.uk and www.airlinewarehouse.co.uk. The Complainant asserts that the facts of these disputes are not dissimilar to the facts of the current Complaint, insofar as the complainants were well known brands and rights holders in their respective fields. The Complainant points out that it would be unusual for the Respondent to have legitimate business interests in airline warehouses in 2009, country properties in 2004, and simultaneously shoes at any time since 2004.
- 6.8 The Complaint ends with a request for a transfer of the Domain Name.

Response

- 6.9 In the Response, the Respondent accepts that the Complainant has rights in the term SHOE EXPRESS, "based purely on its registered trade marks" and that this is identical to the Domain Name. However, it does not admit that the Complainant had established any particular degree of public recognition in the UK in respect of the mark as at the time that the Respondent registered the Domain Name.
- 6.10 The Respondent kicks off its submissions in relation to the question of whether the Domain Name is an Abusive Registration by referring to the appeal panel's decision in DRS 4331 (*verbatim.co.uk*) in which the panel stated:
- "...for this complaint to succeed, the Complainant must satisfy the Panel, as an opener, that the Respondent was aware of the existence of the Complainant or its brand at the date of registration of the Domain Name or at commencement of an objectionable use of the Domain Name."
- 6.11 The Respondent asserts, on the other hand, that he was not aware of the Complainant or its trade mark registrations or its "Shoe Express" business when he registered the Domain Name in 2004. As stated in his email of 22 February 2010 referred to above, he had never seen any outlet of the Complainant in London, where he lives, nor had he seen any other reference to "Shoe Express", whether in advertising or elsewhere. He points out that, not only did the Complainant provide no evidence of its Shoe Express business in response to that email (despite having claimed in its own correspondence that it could do so), but it also failed to do so in the Complaint.
- 6.12 The Respondent pre-empts any attempt by the Complainant to improve its position with evidence at the Reply stage by pointing out that paragraph 6b. of the DRS

Procedure states: “Any reply by the Complainant must be restricted solely to matters which are newly raised in the Respondent’s response and were not raised in the Complainant’s complaint as originally submitted to us.”

- 6.13 The Respondent states that, when he registered the Domain Name on 21 March 2004, he had become aware that it was on a list of domains which were about to “drop” and assumed that the previous owner no longer wanted it. He thought it a potentially attractive domain name to have because it was an obvious generic term relating to the shoe industry, namely a combination of “shoe” and “express”. This was one of a number of similar generic domains consisting of the word “express” plus another generic term, most of which the Respondent registered in 2003-2005. (I have already identified these in Section 4.)
- 6.14 The Respondent says that, when he registered the Domain Name, he had in mind to profit from advertising links relating to shoes and ultimately to sell the domain name at some point to someone with an appropriate interest, probably in the shoe industry.
- 6.15 In response to the Complainant’s suggestion that the Respondent registered the Domain Name in the hope that the Complainant would fail to renew its trade mark registration (due on 30 November 2004), the Respondent states that it is difficult to see how such an oversight by the Complainant would have benefitted the Respondent, if (as asserted by the Complainant) he had been nonetheless aware that the Complainant was in fact trading under the name.
- 6.16 In relation to paragraph 3a.i.A. of the Policy, the Respondent states that, since he was unaware of the Complainant, he could not have acquired the Domain Name for the purpose of sale to the Complainant. There is no evidence of any unsolicited offer by the Respondent to do this, and it was in fact the Complainant which first mooted purchase of the Domain Name in its email of 20 January 2010, some six years after the Respondent registered it. He accepts that on registration he had in mind an ultimate sale of the Domain Name to whoever might be interested in buying it, but this was not directed at the Complainant in any way, since he was not aware of the Complainant and the Domain Name was on the face of it descriptive/generic.
- 6.17 Similarly, because of his lack of knowledge, the Respondent rejects the suggestion that he could have registered the Domain Name as a blocking registration, under paragraph 3a.i.B. of the Policy.
- 6.18 Turning to the suggestion that, contrary to paragraph 3a.i.C., the Domain Name was registered for the purpose of unfairly disrupting the Complainant’s business, the Respondent again relies on his lack of awareness. He readily admits that, on registration of the Domain Name on 21 March 2004, the Respondent connected it to a parking page provided by a third party provider (Mirago Plc), but points out that – as he stated he would do in his email of 30 December 2005 – he disabled the Domain Name pending resolution of the matter, after receiving the first approach by the Complainant’s predecessor.

6.19 The Respondent explains that it is unsurprising that a parking page at a domain name comprising the term “shoe express” returns results relevant to the sale of shoes, regardless of the knowledge or intent of the domain name registrant, since, as is well known, parking pages use sophisticated automated systems to place sponsored links on a page. As observed by the DRS appeal panel in DRS 4962 (*myspace.co.uk*):

“The sponsored links on these parking pages do not remain static. The automated nature of their generation, based on search engine activity, means that they vary according to the usage made of search engines by internet users. It is not surprising therefore that following the rise in awareness of the existence of the Complainant (i.e. after the publicity in July 2005), the sponsored links on the webpage connected to the Domain Name will have related more and more to the activity of the Complainant and others engaged in the same field.”

6.20 The Respondent notes that the archive parking pages exhibited by the Complainant include no reference to any website of the Complainant. Indeed, so far as the Respondent can tell, the Complainant does not and has not operated a website under a “shoexpress” domain name; its main website appears to be shoezone.com.

6.21 On the subject of confusion under paragraph 3a.ii. of the Policy, the Respondent relies on paragraph 4e. of the Policy, which states that sale of traffic (i.e. connecting domain names to parking pages and earning click-per-view revenue) is not of itself objectionable. The Expert is to take into account, inter alia, use of the domain name and the nature of the advertising links.

6.22 The Respondent highlights the following facts: (i) the Complainant has established no goodwill at all associated with the name “Shoe Express”; (ii) the name is descriptive/generic; (iii) the Domain Name was registered without knowledge of the Complainant; and (iv) since being notified of the Complainant’s interest, the Registrant has done nothing actively to exploit his position (in fact he removed the parking page that was originally linked to the Domain Name). The Respondent relies on various DRS decisions in support of his contention that these facts negate any suggestion of abuse based on any initial interest confusion that might at first have been caused.

6.23 In response to the allegation under paragraph 3a.iii. of the Policy, that the Respondent is engaged in a pattern of registrations corresponding to well known names or trade marks in which he has no apparent rights (including registering the domain names *countryproperties.co.uk* and *airlinewarehouse.co.uk*), the Respondent points out that: (i) it has not been shown that the Domain Name corresponds to a well-known name or trade mark; (ii) the Respondent was not aware of the Complainant when he registered the Domain Name; (iii) neither *countryproperties.co.uk* nor *airlinewarehouse.co.uk* corresponded to well-known names; (iv) neither of the experts in those cases found that the domain names concerned were part of a pattern under paragraph 3a.iii. (in fact the expert in *countryproperties.co.uk* expressly held that it was not); (v) the Respondent won the *countryproperties.co.uk* case; and (vi) the Domain Name is on the face of it known as much for its ordinary English meaning as anything else and is part

of an entirely different legitimate pattern of generic “express” related domain names. The Respondent cites previous DRS decisions in support.

- 6.24 The Respondent points out that the Complainant originally approached him, asserting trade mark rights, on 1 November 2005. The Respondent wrote on 30 December 2005 rejecting these assertions. The Complainant then did nothing for some five years before again writing (openly) to the Respondent, on 20 January 2010, but this time not asserting or even reserving a legal position, but simply asking if the domain name was for sale. The Respondent sees this as an admission that the Complainant had no case against the Respondent for Abusive Registration, notwithstanding the Complainant’s claim in its email of 19 February 2010 that it had a policy of rigorously enforcing its trade marks.
- 6.25 The Response ends with a reference to DRS 8347 (*5alive.co.uk*), where a six year time lapse in taking action was fatal to the complaint in circumstances where the complainant failed to supply any details of alleged reputation and goodwill and based its case largely on mere assertion. The Respondent sees this as a similar case.

Reply

- 6.26 The Reply is a considerably longer document than the Complaint. It introduces new material concerning the extent of the Complainant’s business and the resultant reputation and goodwill, of the sort that one would normally expect to see in the Complaint. This is discussed further below.
- 6.27 The Complainant admits that it contacted the Respondent on 20 January 2010, and states that this was to give the Respondent an opportunity to bring the matter to a conclusion on a commercial basis without the need for dispute resolution and/or litigation. It denies that this action can be interpreted as an admission of any sort and reserves its rights in relation to bringing legal action against the Respondent.
- 6.28 The Complainant explains that it was not responsible for the approach made to the Respondent in 2005, which had been made by “an entirely different economic undertaking” some three years prior to the Complainant acquiring some of its assets, including the brand “Stead and Simpson”, the SHOE EXPRESS trade marks and the related goodwill. The Reply asserts that there is no link between the Complainant and this earlier correspondence and that it is therefore not true that “the Complainant did nothing for five years”. At most, the Complainant’s “delay” was 11 months.
- 6.29 Purportedly in reply to the Respondent’s claims of lack of knowledge of the Complainant and its “challenge to the Complainant’s rights”, the Complainant states the following:

7. SHOE EXPRESS is a very significant national brand, which had up to 400 stores nationwide prior to 2008 when the Complainant acquired the assets, including the goodwill relating to this brand.

8. Between 1996 and the date of the Complainant's acquisition on 28 January 2008, this number was reduced to around 100 stores nationwide. A list of some of these stores is exhibited at Exhibit 1. It is clear from this list that the Respondent's assertion in paragraph 2.5 that "The Respondent said that he has never seen any outlet of the Complainant in London" is disingenuous as it is clear from this exhibit that SHOE EXPRESS branded stores, were trading in London locations such as Paddington, Harlesden and Greenford, all of which are not only in Greater London, but existed in 2004. For the Expert's information, Exhibit 2 encloses further evidence of the presence of the stores, including examples of shop fascias showing the branding of SHOE EXPRESS across the country. The Complainant and its predecessors in title have invested very significant sums in the marketing and promotion of SHOE EXPRESS, due to the nature of the acquisition of these assets it is not possible to set out historical advertising and marketing figures, however, examples of marketing material used recently are exhibited at Exhibit 3.

9. In addition to the above, until recently, but in covering the 2004 year, the Complainant had a range of SHOE EXPRESS branded delivery lorries. These delivery lorries delivered to all stores operated by the Complainant throughout the country, whether branded as SHOE EXPRESS or otherwise. Between the date of the acquisition of these SHOE EXPRESS branded delivery lorries (which was prior to 2004) and the date of their subsequent decommissioning, these delivery lorries drove a collective three million eight hundred thousand (3,800,000) miles around the United Kingdom prominently displaying the SHOE EXPRESS brand as depicted at Exhibit 4. The vehicle at Exhibit 4 is still in use today and represents the smallest of this fleet of delivery lorries. Due to the extensive mileage covered by these vehicles throughout the United Kingdom, it is clear and undisputable that when this is coupled alongside the extensive network of branded stores, notwithstanding the goods sold at those stores, that the Complainant has an undisputable nationwide reputation and did so on the date on which the domain name was registered.

10. We trust that the above and exhibited will be sufficient, when viewed alongside the Complainant's trade mark registrations, to establish beyond doubt that, at the time of the registration, that there existed a very substantial nationwide reputation in the SHOE EXPRESS brand....

- 6.30 The Reply goes on to explain why the Complainant should be permitted to rely on the above material by way of reply, contrary to the Respondent's assertion that this is inadmissible new material. This will be covered in the Discussion section below.
- 6.31 The Complainant asserts that, with the existence of nationwide goodwill and reputation stemming from at least over 100 stores and up to 400 stores at the time of the registration of the disputed domain name, the Respondent knew or ought to have known about the Complainant's rights, especially when viewed in light of the fact that the registered trade mark database is a public record for all to view free of charge. As the Trade Mark Register is a public document, a simple Internet search would have indicated the existence of rights in the SHOE EXPRESS mark. Further, had the Respondent chosen to take the time, it would have been apparent from even a "Yellow Pages" or similar directory enquiries that rights existed in this particular mark in London and throughout the country.

- 6.32 On this basis, the Reply asserts that the Respondent has “obvious knowledge, constructive or otherwise” of the Complainant’s rights in the SHOE EXPRESS mark and that he “clearly knew or ought to have known about the existence of rights in the SHOE EXPRESS mark” when he registered the Domain Name.
- 6.33 The Complainant rejects the suggestion that the mark SHOE EXPRESS is descriptive or generic, even on a prima facie review, asserting that it would not have been accepted for registration as a trade mark if that were the case. And, even if it were the case originally, the mark would have acquired distinctiveness over time as a result of the extensive goodwill and reputation attached to it.
- 6.34 The Reply ends with the following concluding paragraph:

16. For the above reasons, it is clear that the Respondent’s introduction of argument relating to the Complainant’s reputation, is nothing more than a disingenuous attempt to circumvent the fact that the Registration is Abusive. It is clear that a very established nationwide reputation exists in the SHOE EXPRESS mark and that it was in existence at the time that the Registration was made and, as such, the Respondent knew, or at least ought to have known, of the mark and the associated reputation within it. From this fact, intent is clear, and nevertheless could be implied. As such, for a range of grounds, the Registration is clearly Abusive.

7. Discussions and Findings

Rights

- 7.1 The Respondent has admitted that the Complainant has Rights in the name SHOE EXPRESS, based on – but only based on – its ownership of the Trade Marks in respect of the name. This was in fact the only basis on which Rights were claimed in the Complaint (viz. “The Complainant has Rights in the Domain Name **because it is the registered proprietor of two Registered Trade Marks** for an identical mark to the Domain Name, ...” (emphasis added)).
- 7.2 The only reference in the Complaint which might be capable of being construed as a claim of Rights that go beyond the Trade Mark registrations is found in the section where the Complainant complains about the fact that an internet user would find a blank page at the web address for the Domain Name, and says: “This is likely to cause damage to the Complainant’s reputation, insofar as a brand with a reputation as substantial as the Complainant as one of the largest shoe retailers in the UK, should not have inactive web pages.”
- 7.3 Without any evidence to support these indirect assertions of having a substantial reputation or being one of the largest shoe retailers in the UK, this statement does not help the Complainant. The Complaint contained no other submissions or evidence about the use or reputation of the SHOE EXPRESS name or the goodwill in an associated business, and did not exhibit any material from which such matters could be deduced or inferred.

- 7.4 The Complainant has pointed out that the “Rights Test” means establishing a proper interest in the complaint, and that this test is not a particularly high threshold. This is correct. And, based on the Complaint document alone (even without the Respondent’s admission), I would have no hesitation in concluding that the Complainant has Rights in respect of the name SHOE EXPRESS, which for the purposes of the DRS is to be considered identical to the Domain Name.
- 7.5 However, I would limit that finding to the existence of the two Trade Marks for the name SHOE EXPRESS, without imputing any particular reputation or distinctiveness to the Trade Marks or finding any additional unregistered rights to factor in when assessing the question of whether the Domain Name is an Abusive Registration. I would also comment that the name SHOE EXPRESS was rather descriptive of an outlet where shoes could be purchased speedily, though I would accept that one should proceed on the basis that the Trade Marks are valid. Further, I would note that the Complainant’s Community trade mark had not been filed when the Respondent registered the Domain Name and used it to point to a parking page and so this element of the Rights was only relevant to the question of whether the ‘post-parking’ use of the Domain Name makes it Abusive.
- 7.6 In its Reply, the Complainant introduced material aimed at establishing that SHOE EXPRESS is “a very significant national brand” with “nationwide goodwill and reputation” and that it already was well established and had a strong presence on the high street when the Respondent registered the Domain Name.
- 7.7 The Respondent pre-empted the possibility that the Complainant might try to improve its case in this way, by objecting in advance, arguing that to do so would be contrary to paragraph 6b. of the DRS Procedure referred to above. The question thus arises whether paragraphs 7 to 10 of the Reply (reproduced above) and the exhibits in support properly respond to matters raised in the Response or raise additional points which should have been raised in the original Complaint.
- 7.8 The Complainant opens this section of the Reply with the words, “We now turn to paragraphs 2.5 - 2.8”. These were the paragraphs of the Response which asserted that the Respondent had no knowledge of the Complainant and pointed out that the Complainant had not provided any evidence of its reputation. Paragraph 12 of the Reply then states that the new material submitted is “in reply to the challenge to the Complainant’s rights raised in the Response”.
- 7.9 Insofar as the latter assertion is concerned, as explained above, the Respondent did not in fact challenge, but admitted, the Complainant’s claim to own Rights in the term SHOE EXPRESS, by virtue of the Trade Marks. However, although the Complainant had not made any express claim in relation to the strength of those Rights, the Respondent went on – under the heading “RIGHTS” – by stating that he did not admit that the Complainant had established any particular degree of public recognition in the UK in respect of the SHOE EXPRESS mark as at the registration date of the Domain Name.

- 7.10 It seems to me that this ‘non-admission’ can only have been intended to put the Complainant to proof if it wished to establish that the Trade Marks had gained recognition on the market and had thus acquired enhanced distinctiveness through use. The fact that this was included in the “Rights” section of the Response demonstrates the Respondent’s understanding that not just the existence, but also the strength, of the Rights relied on was in issue in the case. This may well have been because of his earlier correspondence with the Complainant and its predecessor, rather than directly in response to the “Rights” claims made in the Complaint, but (ignoring strict rules of ‘pleading’ a case through court documents, which do not apply to the DRS) it was an open invitation to the Complainant to put forward evidence that the Trade Marks comprised strong Rights.
- 7.11 While in my view it would have been preferable if the Complainant had put its best evidence forward in relation to the strength of its Rights in the Complaint, I would not exclude that material from the Reply in this case because it did reply to comments made by the Respondent in the Response. Indeed, arguably – as asserted by the Complainant – the new matter not only responded to the Respondent’s challenge to the Complainant’s Rights, but it was also relevant to the issue of the Respondent’s knowledge, which is dealt with further below.
- 7.12 Having said that, the evidence put in by way of Reply was so new and specific in content that, if I had thought it would enable the Complainant to prove that the Domain Name was an Abusive Registration, I would have given the Respondent the opportunity to respond to it by way of additional submission.
- 7.13 I should be clear that I believe that the Complainant’s new evidence in the Reply can only properly be treated as being in reply in relation to the Complainant’s “Rights” insofar as it seeks to establish enhanced distinctiveness and strength of the Trade Marks. If and to the extent that the Complainant was also seeking to establish parallel unregistered rights in passing off, I would not be prepared to make any finding in this regard without inviting a further submission from the Respondent.
- 7.14 I have already reproduced the paragraphs of the Reply concerning the use of the mark SHOE EXPRESS. Exhibits 1 to 4, submitted in support of these claims, can be summarised as follows:
- (1) Exhibit 1 is a list of 78 addresses, said to be some of the SHOE EXPRESS stores. It is unclear how these 78 have been chosen, and nothing is said by the Complainant or on the face of the document about the date of the list, though there is a suggestion that these may be a subset of the 100 plus stores that were in existence when the Complainant acquired the brand on 28 January 2008.
 - (2) Exhibit 2 comprises: (i) a letter dated 17 June 2004 from a firm of retail surveyors to the “Property Director” of Stead & Simpson Ltd entitled, “44 The Broadway, Greenford – Rent Review 29.09.03”, followed by a photograph of a shop premises at that address, bearing the name “Shoe Express”; (ii) a letter dated 31 May 2006 from “Above All” to Stead & Simpson Ltd concerning work done on the suspended

ceilings in the Shoe Express premises in Unit 5, Asda Mall, Chalfont Way, Lower Early, Reading; (iii) a chartered surveyors' advertisement in relation to a SHOE EXPRESS branded outlet at 11/13 Arndale Shopping Centre in Wandsworth, which presumably was due to close (I note from the "0171" telephone area code that this advertisement must have been placed between about April 1995 (before which the code was 071) and April 2000 (after which the code changed to 020)); (iv) an undated document entitled "Survey for Asbestos Containing Materials", showing a "Shoe Express" shop front (the telephone area code of 01276 showing only that the document post-dated April 1995); (v) photographs of two SHOE EXPRESS branded outlets with manuscript notes saying "Reading 25/6/98" and "Fulham 29/7/98"; and (v) a letter dated 1 October 2004 from a real estate agent to the Estates Director of Stead & Simpson Limited, concerning the rent review of a SHOE EXPRESS store in Harlesden.

- (3) Exhibit 3 comprises copies of what appear to be promotional flyers (or possibly front covers of leaflets or magazines) for SHOE EXPRESS (sometimes written SHOE XPRESS), one said to be February 2007, another May 2007 and the others undated; and an undated photograph of a sign for three shopping outlets, including "SHOE EXPRESS". I note that the latter sign has the word SHOE written in much smaller writing than EXPRESS. I also note that the shoes depicted in the photographs have the name "XPRESS" stamped inside the shoe.
- (4) Exhibit 4 comprises photographs of a Stead & Simpson lorry bearing the name "SHOE EXPRESS" on the back (with SHOE written in much smaller text than EXPRESS) and then "XPRESS" on the side.

7.15 Based on the evidence presented by the Complainant in the Reply, and taking into account the difficulties that it has had in obtaining archive material, I am prepared to proceed on the basis that as at 21 March 2004:

- (1) there were more than 100 retail shoe stores in the UK branded SHOE EXPRESS, including stores in Paddington, Harlesden and Greenford in London;
- (2) some marketing and promotional material was distributed in relation to the SHOE EXPRESS brand, though there is no evidence of where or to whom this was distributed;
- (3) a number of delivery lorries bearing the SHOE EXPRESS name delivered shoes to the stores around the country;
- (4) all of these activities were conducted by the entity from which the Complainant purchased various assets in connection with the SHOE EXPRESS business in 2008.

7.16 While I appreciate that the Complainant did not operate the business back in 2004, one would expect it – as purchaser of the assets of the business in 2008 – to have some knowledge of the sales levels and marketing investment. In the absence of any such information, I am unable to make any further findings as to the extent of sales or

the scope of marketing and advertising activities in relation to the SHOE EXPRESS brand.

- 7.17 Based on the findings that I have been able to make in the Complainant's favour, I am prepared to proceed on the basis that by 21 March 2004 the SHOE EXPRESS name had acquired a higher level of distinctiveness than it would have had without any use, and indeed that a significant proportion of the public would have recognised it as a retail brand for shoes.
- 7.18 I also proceed on the basis that this state of affairs continued up until the Complaint was filed.
- 7.19 On this basis, I conclude that the Complainant not only passes the threshold test of ownership of relevant "Rights", but that it does so easily because its underlying Trade Marks have enhanced distinctiveness as a result of use and recognition in the UK. So far as the position in 2004 is concerned, only the UK Trade Mark is relevant because the Community trade mark was only filed in 2006.

Respondent's awareness of the SHOE EXPRESS brand

- 7.20 I was a member of the appeal panel in DRS 4331 (*verbatim.co.uk*) in which we made the remark relied on by the Respondent to the effect that the Complainant had to satisfy the panel that the Respondent was aware of the existence of the Complainant or its brand at the date of registration or objectionable use of the domain name in issue in that case for it to be found to be abusive. This decision has since been reviewed by the group of experts and commented on in the "Experts' Overview" of the DRS, which is published on Nominet's website, as follows (at section 2.4):

The body of expert decisions under the Policy is developing and certain principles are emerging. The section of the Appeal decision in DRS 04331 (*verbatim.co.uk*) dealing with 'knowledge' and 'intent' sets out one panel's views on that topic. However, new domainer practices (e.g. automated bulk transfers of domain names) are becoming commonplace and to the extent that the *Verbatim* decision suggests that for a finding of Abusive Registration, the Respondent must have had knowledge of the Complainant and/or its Rights at the relevant time, it is now thought by some Experts that that might overstate the position.

A particular area of current debate among the panel of Experts is the extent to which the concepts of unfair advantage and unfair detriment as set out in the definition of Abusive Registration [paragraph 1 of the Policy] embrace a subjective element. The members of the Appeal panel in the *Verbatim* case took the view that for a registration to be labelled "Abusive" there had to be something morally reprehensible about the Respondent's behaviour, a view more recently adopted in DRS 07066 (*whistleblower.co.uk*). Others have expressed the view that what is or is not fair can be judged wholly objectively and that to gain or cause damage by way of trade mark infringement is necessarily unfair irrespective of the motives of the Respondent.

- 7.21 In this case, notwithstanding the slight shift in approach since the *Verbatim* case, I do believe that the Respondent's state of knowledge is an important one because:

- (1) the Complainant relies on it heavily as a basis for arguing that the Domain Name is an Abusive Registration;
- (2) the name SHOE EXPRESS is inherently rather descriptive and, although it has been shown to have acquired a degree of recognition and distinctiveness, it has not been demonstrated to be a brand which would inevitably be recognised by the vast majority of members of the public (i.e. giving rise to doubt if someone says they have not heard of it);
- (3) while the Complainant has reserved its right to bring an action for trade mark infringement, the case has not been run on the basis that the Respondent's use of the Domain Name amounts to infringement, regardless of knowledge or intent; and
- (4) the Respondent disabled the Domain Name in response to the first notification of the Complainant's predecessor's alleged rights and has since made no further use of it.

7.22 The Complainant makes various allegations in relation to the Respondent's awareness or knowledge of its rights in SHOE EXPRESS. These include asserting that he did know of the rights, that he should have known of them, and that he had constructive knowledge of them because he could have found out about them if he had bothered to do some checks. I deal with each of these in turn. Having set out the parties' submissions in some detail above, I will not reiterate all of the points made, but will focus on those that I see as particularly persuasive. I have nevertheless taken all of the submissions into account.

Actual knowledge

7.23 So far as the Respondent's actual knowledge is concerned, there is nothing in the Complainant's evidence that persuades me that he was aware of the SHOE EXPRESS business. The evidence of use and recognition is not sufficient for me to conclude that he must have known about it.

7.24 The Respondent has clearly and repeatedly stated that he had not heard of the SHOE EXPRESS brand before he was approached by its previous owner in November 2005. He stated this in his original response to that approach, on 30 December 2005; he reiterated it in his email to the Complainant of 22 February 2010, stating that he had never seen a "Shoe Express" outlet, sign, billboard or advertisement, and pointing out that he could not find a website relating to the brand; and he repeated his position in the Response to the Complaint.

7.25 Further, there is nothing in the behaviour of the Respondent from which I feel able to draw the inference that he did in fact know of the SHOE EXPRESS brand. He gives a perfectly plausible explanation of why he registered the Domain Name and what he used it for before being notified of the existence of the brand. The fact that he

registered a number of other descriptive domain names that include the word “express” during the same period supports this explanation.

Constructive knowledge

- 7.26 The Complainant argues that the Respondent ought to have known of its Rights because he could have found out about them by checking the Register of trade marks and/or by checking *Yellow Pages* or by making similar directory enquiries.
- 7.27 As the Respondent notes in one of his exhibited emails, Nominet does not require domain name registrants to check the trade marks Register before acquiring a domain name. Nor does Nominet conduct its own checks. The system is a first-come first-served automated system.
- 7.28 Even if a trade mark check were to show the existence of a registration for a name that is identical or similar to a domain name which someone was thinking of registering, it would not necessarily be a reason for refraining from registering the domain name. The ability of a trade mark owner to prevent the registration and use of a domain name by way of an infringement action depends on many things including the scope of the specification, the extent of use of the mark and the way in which the defendant is using the domain name.
- 7.29 Similarly, there has never been any duty on domain name registrants to conduct ‘common law’ checks of publications such as *Yellow Pages* or trade directories or to perform internet searches to see whether anyone might have rights in a name similar to the domain name. To suggest that the Respondent should have done so in this case is to impose a burden that is contrary to the way in which domain name registration practice has developed to date. While there may be specific circumstances in which one might conclude that it would have been prudent to conduct such checks (for example, if a registrant had noticed a thriving business conducted under a name that he wanted to register as a domain name, but chose to turn a blind eye), that is not the situation here. On the contrary, the name concerned was a descriptive one in which people would not necessarily assume that rights could be acquired and, on the evidence, the Respondent had not seen it in use.

Intent to sell

- 7.30 The Respondent’s lack of knowledge of the Complainant’s Rights is an answer to the Complainant’s reliance on paragraph 3a.i.A. of the Policy, since it means that the Respondent cannot have been targeting the Complainant or its competitors when it acquired the Domain Name.
- 7.31 The Respondent admits that, when he registered the Domain Name, he thought that he would ultimately sell it to someone with an appropriate interest. But this was a general plan to sell to anyone who came along at the appropriate time; not one aimed at extracting money from the Complainant or a competitor, which took advantage of

the Complainant's Rights. As stated in paragraph 4d. of the Policy, it is legitimate to trade in domain names for profit, and that is what the Respondent planned to do.

7.32 This is a similar situation to that in DRS 359 (*parmaham.co.uk*) in which the appeal panel said:

9.12 Even if the Respondent did register the Domain Names for the purpose of sale, it did not do so primarily to sell the Domain Names to the Complainant – it did so to make them available for sale to the world at large.

and concluded that the registration was not abusive.

Intent to block or disrupt business

7.33 The suggestion that the Respondent acquired the Domain Name or used it to block the Complainant or to disrupt its business similarly fails for lack of knowledge. Without knowledge, the Respondent cannot have intended to block or disrupt the Complainant or its business.

7.34 I do not agree with the suggestion that the Respondent must have been hoping that the Complainant would fail to renew its UK Trade Mark registration, which was due later that year. Surely, if the Respondent had been aware of the registration but expected it not to be renewed, that would suggest that he was unaware that the Trade Mark was of any importance to the Complainant, since one would normally expect the proprietor of a trade mark that is in use to renew it automatically.

7.35 The fact that the parking pages to which the Domain Name originally pointed included links relevant to shoes has been explained by the Respondent. I agree with the explanation given in DRS 4962 (*myspace.co.uk*), quoted above, as to how this will have arisen without intervention by the Respondent.

7.36 It is not even evident that any disruption has in fact been caused to the Complainant's business as a result of the registration or use of the Domain Name, regardless of whether there was any intent to cause this. As the Respondent points out, the Complainant does not appear to operate a SHOE EXPRESS branded website, which one would expect it to be able to do through an alternative "shoeexpress" domain name. Therefore, it is hard to see how the Respondent's ownership and use of the Domain Name can have had any blocking or disruptive effect.

Confusion

7.37 The issue of confusion is less dependent on the Respondent's state of awareness of the Complainant's Rights than the above grounds. Paragraph 3a.ii. of the Policy focuses on whether the Domain Name has been (or is threatened to be) used in a way which has in fact confused or is likely to confuse people into believing that there is a connection with the Complainant.

- 7.38 There is no evidence of actual confusion, whether from the time that the Domain Name was used to point at a parking page or from the subsequent period when internet users who typed in the web address www.shoeexpress.co.uk would have found nothing there.
- 7.39 Given my findings in relation to the reputation and distinctiveness of the Trade Marks, it is possible that internet users who were aware of the SHOE EXPRESS brand might type www.shoeexpress.co.uk into the address field of a browser in the hope of finding a website relating to the brand. However, this would be guesswork on their part. If they chose to search by web address, they could instead have chosen www.shoeexpress.com, for example, about which there is no evidence in the case.
- 7.40 There is no evidence that someone who typed SHOE EXPRESS into the search field of a web browser would have been led to the parking page to which the Domain Name pointed.
- 7.41 It is not clear what an internet user would have seen on arriving at the Respondent's parking page back in 2004. As I have explained previously, I am not sure that they would have seen what appears on the sample archived pages that are exhibited to the Complaint. And even if this was what they saw, I would expect an internet user who was aware of the Complainant's brand to have realised that this was not the Complainant's site.
- 7.42 Even if an internet user was to have been led to the Respondent's parking page when they were actually looking for the Complainant's SHOE EXPRESS website, I believe that this is the sort of low level "initial interest confusion" which the Complainant would have to live with, given its choice of a descriptive brand. In circumstances where there is no evidence that the Complainant itself had a SHOE EXPRESS website that the internet user could look for, the risk of damage caused by any such confusion seems to me to be very low.
- 7.43 I do not believe that there is any merit in the Complainant's suggestion that its reputation would be damaged by the discovery of inactive web pages at the www.shoeexpress.co.uk address. I would expect people to be more likely to be adversely affected by the total absence of a SHOE EXPRESS website (regardless of web address).
- 7.44 In circumstances where there is no evidence of intent on the part of the Respondent, and where he took down the parking page as soon as he was notified of the Complainant's claim to have relevant rights, I do not believe that the possible low level of "initial interest confusion" which could arguably occur is sufficient to support a finding of Abusive Registration in this case.

Pattern of registrations

- 7.45 Given my conclusions so far, it will be evident that I do not see the Respondent's registration of the Domain Name as being part of a pattern of registrations relating to

well known names or trade marks under paragraph 3a.iii. of the Policy. Not only is the evidence insufficient to persuade me that SHOE EXPRESS is a well known name, but the countryproperties.co.uk and airlinewarehouse.co.uk domain names relied on by the Complainant were also not found to relate to well known names. As the Respondent points out, the expert in the former case (DRS 6828) expressly held that the domain name countryproperties.co.uk was not part of a pattern and the Respondent won the case.

7.46 If there is a pattern to be identified in the Respondent's domain names, it is in the group of domain names comprising the word "express" along with another descriptive word or words. Such a pattern is not indicative of any one of these names being an Abusive Registration.

Delay

7.47 In view of my conclusions above, I do not need to consider the Respondent's additional point that the Complainant should be shut out from bringing this Complaint because of the delay since the then owner of the SHOE EXPRESS brand approached the Respondent in November 2004. Suffice to say that I did not think that this was a strong enough argument to enable me to rule the Complaint out altogether without considering its substantive merits.

Conclusion

7.48 In the light of all the submissions and evidence of the parties, I am unable to find that either the registration or the use of the Domain Name by the Respondent took unfair advantage of or was unfairly detrimental to the Complainant's Rights.

8. Decision

8.1 I find that the Complainant has Rights in respect of a name and mark which is identical to the Domain Name, but that the Domain Name, in the hands of the Respondent, is not an Abusive Registration.

8.2 I therefore make no order for transfer.

Signed: Anna Carboni

Dated: 31 May 2011