

DISPUTE RESOLUTION SERVICE

D00010617

Decision of Independent Expert

Lavender Hill Studios LLP

and

LARA (London Atelier of Representational Art)

1. The Parties:

Complainant: Lavender Hill Studios LLP
Address: Unit 101
Battersea Business Centre
99-109 Lavender Hill
London
SW11 5QL
Country: United Kingdom

Respondent: LARA (London Atelier of Representational Art)
Address: Unit C69
V22 Building F
Tower Bridge Business Complex (Biscuit Factory)
100 Clement's Road
London
SE16 4DG
Country: United Kingdom

2. The Domain Name(s):

lavenderhillstudios.co.uk ("Domain Name")

3. Procedural History:

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| 2 December 2011 | Dispute received |
| 6 December 2011 | Complaint validated |
| 8 December 2011 | Notification of complaint sent to parties |
| 30 December 2011 | Response received and notification sent to parties |
| 9 January 2012 | Reply received and notification sent to parties |
| 9 January 2012 | Mediator appointed |
| 24 January 2012 | Mediation started |
| 9 February 2012 | Mediation failed |
| 15 February 2012 | Steve Ormand appointed as Expert |

On 12 January 2012 the Respondent sent an email and a letter to the Complainant which the latter forwarded to Nominet.

On 9 February 2012 the Complainant made a non-standard submission pursuant to §13b of the Procedure. After considering the 13b explanatory paragraph provided by the Complainant, the Expert requested that the full non-standard submission be forwarded to him and to the Respondent. The Respondent replied to the non-standard submission by email dated 27 February 2012.

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

4. Factual Background

The Complainant is a limited liability partnership established in the United Kingdom on 9 November 2004 with Companies House registration No. OC309955. The Complainant operates an art education institution in London at an address in Lavender Hill.

The Complainant has a registered UK trade mark (No. 2584358) filed on 13 June 2011 and registered on 30 September 2011 in the name “Lavender Hill Studios” in respect of Class 41: Education.

The Respondent is a company established in the United Kingdom on 16 November 2007 with Companies House registration No. 06428822. The Respondent operates an art education institution in London.

The Respondent registered the Domain Name on 22 November 2010.

5. Parties’ Contentions

The Complaint

The Complainant contends that it has Rights in the name ‘Lavender Hill Studios’ because:

1. Lavender Hill Studios has been trading as a Limited Liability Partnership since its establishment in November 2004.
2. Lavender Hill Studios is a successful Art Education institution.

3. The Complainant owns and manages the website at www.lavenderhillstudios.com.
4. The Complainant can be contacted at lavenderhillstudios@gmail.com.

The Complainant contends that the Respondent's registration and/or use of the Domain Name is an Abusive Registration because:

1. On the 22nd of November 2010 the Respondent acquired the Domain Name and has been using it in an unlawful way.
2. The Respondent operates www.drawpaintsculpt.com and can be contacted at info@drawpaintsculpt.com. This domain name was set up on 16 November 2008, 4 years after the Complainant was established.
3. The Domain Name is a derivation of the Complainant's domain name www.lavenderhillstudios.com with the extension .co.uk at the end.
4. The Respondent used the Complainant's company name, Lavenderhillstudios. as a Keyword search and for several months redirected and pushed www.lavenderhillstudios.co.uk traffic directly to the Respondent's own site at www.drawpaintsculpt.com.
5. The Respondent bought the Domain Name without the Complainant's prior consent or agreement and has been:
 - a. Passing off, which in United Kingdom law is a tort of strict liability, by using the Complainant's mark prior to registration by selling their goods under the pretence that they are the goods of the Complainant.
 - b. Cybersquatting by registering, trafficking in, or using the Domain Name with bad faith intent to profit from the goodwill of a trademark belonging to the Complainant.
 - c. Infringing the Complainant's trademark.
6. The Complainant has never given any third party licence to use a derivation of its domain name www.lavenderhillstudios.com, or its mark "Lavender Hill Studios".

The Response

The Respondent contends that its registration and use of the Domain Names is not an Abusive Registration because:

1. On the advice of its website designers it was suggested that it buys as many domains and search words related to art schools as possible to help with its SEO (search engine optimisation) ranking. This approach is used by many companies and, as Lavender Hill Studios is not a registered trademark, the Respondent is not infringing on the Complainant's ownership.
2. When this issue was brought to the Respondent's attention it aimed to remedy the situation as soon as possible. The Respondent sent an email to the Complainant on 19 July 2011 stating that it had acted lawfully but was willing to relinquish control of the Domain Name. The Respondent further stated that it would not renew the Domain Name or that it could transfer the Domain Name for an agreed sum, asking the Complainant how it wanted to proceed.
3. The Respondent is willing to relinquish control of the Domain Name and is awaiting a response from the Complainant. The Complainant can pay an agreed sum, a figure around the market rate for the Domain Name, or wait for the Respondent's ownership to expire on 22 November 2012.
4. The Complainant has not replied to the Respondent's email.

The Reply

The Complainant replied to the Response as follows:

1. The Complainant takes its registered brand “Lavender Hill Studios” very seriously. The “Lavender Hill Studios” brand has been hard won within the market place.
2. A brand is much more than a registered mark. The Intellectual Property Office’s website states *“a brand can also be a ‘promise of an experience’ and conveys to consumers a certain assurance as to the nature of the product or service they will receive and also the standards the supplier or manufacturer seeks to maintain.”*
3. The Respondent is well aware of this and should understand that their domain provider, an ICANN accredited registrar, and its customers are bound by the UDRP. The Complainant believes that the Respondent’s domain provider understand this as they have, shown by the Complainant’s submission of evidence, placed the Domain Name on their *“Sorry! This site is not currently available!”* page, where previously it was simply parked it on the domain name provider’s site.
4. By applying as its keyword search “Lavenderhillstudios”, the Respondent aimed to misdirect and confuse the general public into believing that the Complainant’s and the Respondent’s separate and individual companies were somehow related and sought to hijack business away from the Complainant.
5. The Complainant notes that the Respondent’s statement that *“On the advice of our website designers it was suggested we buy as many domains and search words related to art schools as possible to help with our SEO ranking. We understand this approach is used by many companies”* is mildly worrying and questions whether the Complainant is the only company that the Respondent’s abusive actions have affected.
6. Notwithstanding the legality of these actions, as suggested and used by the Respondent’s web designers, it is like a bee dancing around the ethical and moral implications.
7. It is not up the Respondent to state that it will “relinquish control” of a site whose mark is not the Respondent’s to control in the first place and has never been.
8. As to the Respondent waiting for a reply to its email dated 19 July 2011, this Complaint is it.

Paragraph 13b Non-Standard Submission

The Complainant submitted the following explanatory paragraph in relation to its non-standard submission:

1. The Complainant wishes to put a clear time line on events.
2. On 22 November 2010 the Respondent purchased the Domain Name.
3. The Complainant discovered in June 2011 that the Respondent was using the Domain Name to direct enquiries/traffic to its art school.
4. The Complainant wrote to the Respondent on 11 July 2011 requesting it to desist. The Respondent did not reply but instead pushed the Domain Name to the Complainant’s own site at www.lavenderhillstudios.com, as evidenced by the screen shot (PNG) dated 18 July 2011. The Complainant e-mailed the Respondent on the same day.
5. On 19 July 2011 the Respondent replied by e-mail as evidenced in the Response.
6. The Complainant believed that the Respondent was toying with the Domain Name in this and other ways as the Complainant discovered that by typing in “Lavender Hill Studios” as keywords in the Google Video search box, the Respondent’s advertisement came up.
7. The Complainant contacted both the Respondent’s domain host and Nominet who suggested that the Complainant use the DRS.

8. The Complainant believes that this non-standard submission should be accepted as it clarifies the time line and counters the Respondent's defence that the Complainant never responded to the Respondent's correspondence.

The non-standard submission comprised copies of screenshots and emails between the Parties in evidence of the above statements.

Respondent's Response to the Non-Standard Submission

The Respondent submitted the following response to the Complainant's non-standard submission:

1. In regard to the Domain Name, the Respondent's website designer suggested it bought numerous domains relating to art and art schools. Once the Respondent realised how these domains were being used it endeavoured to rectify this as quickly as possible.
2. To resolve the situation and avoid any ill feeling the Respondent pointed the Domain Name to www.lavenderhillstudios.com and informed the Complainant that it was possible to transfer the Domain Name to the Complainant's account.
3. Following this, the Complainant requested the Respondent to point the Domain Name to GoDaddy and proceeded to take matters further by involving Nominet. The Respondent believes it has done all it can to remedy the situation and has no desire to contest the Domain Name, but wants it to be known it did not act unlawfully.
4. As to the Complainant choosing to take this dispute to an Expert Determination that is its choosing. The Respondent can only presume that the Complainant is willing to spend the money in order make a point.
5. The Respondent's only concern is, due to the nature of the determination, that a public notification may be made and gauging the behaviour of the Complainant we fear this will be used in a defamatory way.
6. The Respondent understands this decision might be made from a moral perspective rather than a legal one, but if the Respondent acted in a lawful manner it does not see why it should possibly suffer.

6. Discussions and Findings

General

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

1. *The Complainant has Rights in respect of a name or mark which is identical or similar to the Domain Name; and*
2. *The Domain Name, in the hands of the Respondent, is an Abusive Registration.*

Complainant's Rights

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

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

The Complainant has evidenced registered rights in the mark “Lavender Hill Studios” which post-date the registration of the Domain Name. However, I am satisfied on the papers before me that the Complainant had established unregistered rights and/or goodwill arising from its use of the name “Lavender Hill Studios”, and trading as the Lavender Hill Studios, which pre-date the registration of the Domain Name. Furthermore, the Respondent has confirmed in the Response that the Complainant had already established itself as an art school when the Respondent acquired the Domain Name by confirming that, on the advice of its website designers, it bought “*as many domains ... related to art schools as possible*”.

Accordingly, I find that the Complainant has Rights in a mark which is identical to the Domain Name, save for the addition of the generic suffix, and which predate the Respondent’s registration of the Domain Name.

Abusive Registration

Abusive Registration is defined in §1 of the Policy as a Domain Name which either:

1. *was registered or otherwise acquired in a manner which, at the time when the registration or acquisition took place, took unfair advantage of or was unfairly detrimental to the Complainant’s Rights; or*
2. *has been used in a manner which has taken unfair advantage of or has been unfairly detrimental to the Complainant’s Rights.*

A non-exhaustive list of factors which may be evidence that a domain name is an Abusive Registration is set out in §3 of the Policy.

The Complainant’s principal allegation of Abusive Registration is that in 2010 the Respondent acquired the Domain Name and pointed it to its website at www.drawpaintsculpt.com for the purposes of directing internet traffic to that website and to confuse the general public into believing that the Domain Name is registered to, operated or authorised by, or otherwise connected with the Complainant.

The Complainant has raised passing off and trade mark infringement as further grounds for Abusive Registration. It is not for the DRS to deal with such allegations and accordingly I do not deal with them any further.

The Respondent does not deny the allegation of confusion. The Respondent confirms that its intention in acquiring the Domain Name was to help with the SEO ranking following the advice of its website designers and admits that once it realised how the Domain Name was being used, to direct traffic from the Complainant to its own website, it attempted to rectify the situation as soon as possible.

However, deliberately selecting for one’s domain name the name of another entity and using it for a reason having nothing to do with that entity, but solely for the purpose of improving one’s own commercial position can rarely be regarded as anything other than a bad faith use.

Accordingly I find that the Respondent registered and used the Domain Name in a manner which has taken unfair advantage of or has been unfairly detrimental to the Complainant's Rights.

7. Decision

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

Signed: Steve Ormand

Dated: 11th March 2012