

DISPUTE RESOLUTION SERVICE

D00010619

Decision of Independent Expert

Canterbury Skin and Laser Clinic Limited

and

Dean Abrahamse t/a labrahamse

1. The Parties

Lead Complainant: Canterbury Skin and Laser Clinic Limited
Address: 26 Castle Street
Canterbury
Kent
CT1 2PX
Country: United Kingdom

Complainant: Dr. Mark Hudson-Peacock
Address: Canterbury Skin and Laser Clinic Ltd
26 Castle Street
Canterbury
Kent
CT1 2PX
Country: United Kingdom

Respondent: Dean Abrahamse t/a labrahamse
Address: 37 Barton Mill Road
Canterbury
Kent
CT11BP
Country: United Kingdom

2. The Domain Name

canterburyskinandlaser.co.uk (“the Domain Name”)

3. Procedural History

3.1 On 4 December 2011, the complaint was received. On 6 December 2011 the complaint was validated and notification of it was sent to the Respondent. On 24 December 2011 the response was received and on 28 December 2011 notification of it was sent to the Complainants. On 31 December 2011 the reply was received and on 3 January 2012 notification of it was sent to the Respondent. On 3 January 2012 the mediator was appointed and on 19 January 2012 the mediation failed. On 26 January 2012 the expert decision payment was received.

- 3.2 On 26 January 2012 Patricia Jones (“the Expert”) confirmed to Nominet that she knew of no reason why she could not properly accept the invitation to act as expert in DRS 10619 and further confirmed that she knew of no matters which ought to be drawn to the attention of the parties which might call into question her independence and/or impartiality.
- 3.3 On 27 January 2012 I was notified that the Complainants had submitted a non-standard submission under paragraph 13b of the Nominet Dispute Resolution Procedure (the “Procedure”). On 31 January 2012 I was notified that the Respondent had submitted a non-standard submission under paragraph 13b of the Procedure. On 2 February 2012 I asked to see the Complainants’ submission, having been satisfied that there was an exceptional need for this submission. The submission consisted of a copy of a Court order bringing to an end proceedings brought by the Respondent against ‘Skin and Laser’ following correspondence from solicitors for Canterbury Skin and Laser Clinic (UK) LLP (“the LLP”) concerning the Domain Name. Under paragraph 20 of the Procedure if legal proceedings relating to a Domain Name are issued in a court of competent jurisdiction before or during the course of proceedings under the DRS which are brought to Nominet’s attention, Nominet will suspend the DRS proceedings pending the outcome of the legal proceedings. I therefore accepted the Complainants’ paragraph 13b submission as I considered there was an exceptional need for it in order to satisfy myself that the proceedings were at an end and that it was appropriate to proceed with this Decision. Having regard to the Respondent’s explanation for its paragraph 13b submission and having regard to the content of the complaint, response and reply, I do not consider that there is an exceptional need for the Respondent’s submission. I have therefore not requested to see it.

4. Factual Background

- 4.1 The Lead Complainant provides consultation and treatment services for skin, hair and nail conditions. It is the private practice of Dr Mark Hudson-Peacock, a consultant dermatologist to East Kent Hospitals University NHS Foundation Trust. Initially, the private practice traded as a partnership, which was known from 2001 as ‘Canterbury Skin and Laser Clinic’. The Lead Complainant was incorporated on 2 October 2002 and since then has traded as ‘Canterbury Skin and Laser Clinic’. The Lead Complainant’s website was established in September 2003 at www.skinandlaser.co.uk¹.
- 4.2 The Lead Complainant provides laser and skin treatments. Typical treatments include laser hair and tattoo removal, laser acne treatment, anti-wrinkle treatments including dermal fillers and botox, laser spider/thread vein removal, scar removal and moles, skin tags and wart treatments.
- 4.3 The Lead Complainant receives referrals from GPs, provides the NHS laser assessment and treatment for skin conditions through the Primary Care Trust for East Kent, provides services to the major private healthcare providers and also receives self-referrals, including through its advertising activities.

¹ Paragraphs 4.1 to 4.5 are subject to my comments at Paragraph 4.6 that it appears that since June 2010, the LLP has provided skin and laser treatment services under ‘Canterbury Skin and Laser’ rather than the Lead Complainant.

- 4.4 The Lead Complainant has advertised its services under 'Canterbury Skin and Laser Clinic' since 2003 including in Yellow Pages (principally Canterbury and Maidstone), on yell.com and in a variety of local press. The Lead Complainant also features in website directories for treatment clinics (such as consultingroom.com and cosmeticsurgerycentres.co.uk). The Lead Complainant has been a corporate sponsor of the local Canterbury theatre and of the Canterbury Choral Society.
- 4.5 The Lead Complainant sees about 150-170 people each week. The Lead Complainant's turnover has grown from £770k in 2004 to around £1 million by 2009.
- 4.6 On 2 August 2011, the LLP was granted a UK registered trade mark for 'Canterbury Skin and Laser Clinic' in respect of medical services and beauty care for human beings and medical analysis for the diagnosis and treatment of persons. The owner of the trade mark is a limited liability partnership which was incorporated on 3 June 2010 and which has the Lead Complainant and Hudson-Peacock LLP as registered members. Hudson-Peacock LLP is a limited liability partnership which was incorporated on 2 June 2010 and which has the Lead Complainant, Dr Mark Hudson-Peacock and Dr Alice Hudson-Peacock as registered members. Dr Mark Hudson-Peacock and Dr Alice Hudson-Peacock are also directors of the Lead Complainant. There is some suggestion in the evidence that after its incorporation, the LLP provided skin and laser treatment under 'Canterbury Skin and Laser' rather than the Lead Complainant.
- 4.7 The Respondent registered the Domain Name on 17 July 2010. On 23 July 2011, the Domain Name resolved to a website headed 'Welcome to Canterbury Skin and Laser' and with content 'Welcome to Canterbury Skin and Laser Clinic'. This website advertised various skin and laser hair removal treatments and gave a contact number for further information. The reference to 'Canterbury Skin and Laser Clinic' has since been removed from the site. Although there have been some other changes to the site content, the website at the Domain Name has always been used in connection with skin and laser treatments by 'Canterbury Skin and Laser'. These treatments include laser hair removal, skin rejuvenation, age spot removal and acne treatment. One version of the site states that 'Canterbury Skin and Laser' also offer advanced cosmetic procedures, various massage treatments, manicures and pedicures and has a hair salon.
- 4.8 On 22 July and 26 July 2011 the LLP wrote to Louise at 'Antoniou Hair and Beauty' concerning the Domain Name. On 29 July 2011 the Respondent issued proceedings against 'Skin and Laser' which were subsequently struck out. On 17 November 2011 the solicitors for the LLP wrote to the Respondent concerning the Domain Name. On 21 November 2011 the Respondent issued proceedings against 'Skin and Laser'. Those proceedings are now at an end (see paragraph 3.3 above).

5. Parties' Contentions

- 5.1 Both parties' submissions are lengthy. I set out below a summary of what I regard to be their main contentions.

The Complainants' complaint²

- 5.2 The Complainants say that the Domain Name is almost identical to the Lead Complainant's trading name and the website at the Domain Name offers competing skin and laser treatments. The Complainants contend that Internet users visit websites either by way of search engines or by guessing the relevant URL. The Complainants consider there is a severe risk that a search engine request for the Lead Complainant will include the Respondent high up on the search results or that a user guessing the URL for the Lead Complainant will find the Respondent. Accordingly the Complainants contend that there will be initial interest confusion.
- 5.3 The Complainants allege that the Domain Name was chosen by the Respondent because of its similarity to the Lead Complainant's established trade name. The Complainants say anyone seeing 'Canterbury Skin and Laser' may believe that it is referring to 'Canterbury Skin and Laser Clinic'. The Complainants assert that the registration of the Domain Name makes a false representation that the Respondent is connected with the Lead Complainant, constitutes passing off and damages the Lead Complainant's business and reputation. The Lead Complainant says that it is a busy established skin and laser clinic whereas the Respondent is a salon within a hairdresser.
- 5.4 The Complainants allege that after the Lead Complainant's website was updated in July 2011 the Respondent subsequently changed its website at the Domain Name to include a photograph of a woman identical to that on the Lead Complainant's updated site. The Complainants allege that this was done deliberately to confuse potential customers into believing the Lead Complainant is part of the Respondent's business.
- 5.5 The Complainants say that the statement on the Respondent's website that it has been in Canterbury for more than 15 years is confusing. The Complainants say that they were unaware of 'Canterbury Skin and Laser' until after registration of the Domain Name. The Lead Complainant says that it and its predecessor (the private practice partnership) have been providing laser treatments in Canterbury for more than 15 years and accordingly the Respondent's statement is a source of confusion.
- 5.6 The Complainants allege that the Respondent is offering IPL (intense pulse light) treatments and that the claim on the website at the Domain Name to be a laser clinic is false and deliberately confusing.
- 5.7 The Complainants are concerned that patients are being misdirected to the Respondent under the impression that they will receive medical assessment and treatment. The Complainants say that if there were misdiagnosis, for example a brown spot that is misdiagnosed as an age spot rather than a malignant melanoma and treated with IPL, this could damage the Complainants' reputation if the Respondent was believed to be associated with the Lead Complainant.
- 5.8 The Complainants say that some of the Lead Complainant's patients refer to the Lead Complainant as 'Canterbury Skin and Laser'. The Complainants also say that when GPs make referrals to the Lead Complainant, the Lead Complainant may

² This summary is subject to my comments at Paragraph 4.6 above regarding the potential involvement of the LLP in the provision of services under 'Canterbury Skin and Laser' after June 2010.

simply be referred to as 'Canterbury skin and laser' or 'the skin and laser clinic in Canterbury'. The Complainants say that often GPs do not give the Lead Complainant's telephone number or write a referral letter. The Complainants give the example of a patient looking for the Lead Complainant who found the Respondent through a web search, visited the Respondent's premises and after considering it unusual for a medical clinic to be in a hair salon only then located the Lead Complainant. The Complainants give another example of a customer looking for the Lead Complainant who obtained the Respondent's telephone number from the Respondent's website but realised it was incorrect when the customer tried to make an appointment with the Lead Complainant.

- 5.9 The Complainants also refer to a recording of a telephone conversation that took place with a receptionist at the Respondent's premises on 15 August 2011. When the caller asked for Louise of 'Canterbury Skin and Laser' (the contact name on the Respondent's site) the receptionist thought the caller had the wrong number, said that the caller was the third person who had phoned recently asking for 'Canterbury Skin and Laser', that the caller had phoned Antoniou Hair and Beauty and gave the Lead Complainant's address. The Lead Complainant says that it also receives enquiries for Louise, when it does not have any staff by that name.

The Respondent's response

- 5.10 The Respondent contends that 'Canterbury Skin and Laser' is a generic term and is descriptive of the Respondent's services, namely the provision of skin and laser services from Canterbury.
- 5.11 The Respondent says that the registered trade mark is for 'Canterbury Skin and Laser Clinic', which is not distinctive but is descriptive and generic.
- 5.12 The Respondent contends that it has a legitimate interest in the Domain Name as it needs to include the location (Canterbury) and the goods/services which it is selling (skin and laser).
- 5.13 The Respondent asserts that if the Lead Complainant had exclusive rights to 'Canterbury Skin and Laser' this would prevent the Respondent from operating in Canterbury selling skin and laser services and would prevent any other company from doing so. The Respondent says the Lead Complainant has not taken action against other companies which have skin and laser in their domain names but has taken action against the Respondent to prevent competition. The Respondent says that if the Domain Name is transferred, this will allow the Lead Complainant exclusive rights to 'Canterbury Skin and Laser' which would be contrary to European competition law.
- 5.14 The Respondent says the site at the Domain Name uses 'Canterbury Skin and Laser at Antoniou' and offers laser IPL treatment. The Respondent asserts that there are differences between IPL and laser hair removal but says that the general population would not know these differences.
- 5.15 The Respondent considers the accusation that the Domain Name is causing confusion can only be for potential customers searching for a skin and laser clinic in Canterbury or Kent. The Respondent says that once a potential client has seen the

websites of the Lead Complainant and Respondent then it would be appreciated that there are two different salons, offering different services from different locations within the same geographical area.

- 5.16 The Respondent says that it owns and operates over 100 domain names several of which include a 'location' and a 'generic term' such as pizzacanterbury.co.uk, plumbersjohannesburg.com, hotelhythe.co.uk, beautysalonscantebury.co.uk, financialadviserskent.co.uk, judokent.co.uk and financialadvisorkent.co.uk.
- 5.17 The Respondent alleges that the Complainants are reverse domain hijacking by registering a trade mark for a generic name and using this to force the handover of the Domain Name which the Respondent registered on a 'first come first served' basis prior to the trade mark registration. The Respondent queries why the Lead Complainant uses skinandlaser.co.uk for its business. The Respondent says that canterburyskinandlaserclinic.co.uk is available for registration.
- 5.18 In response to the Complainants' concern about patients being misdirected to the Respondent under the impression that they will receive medical assessment and treatment, the Respondent states that its business uses trained beauty specialists.

The Complainants' reply

- 5.19 The Lead Complainant says that it registered skinandlaser.co.uk as this describes its services, and when this domain name was registered there were no other skin and laser clinics in Kent and much of the UK. The Complainants state that they are not complaining about the use of the generic term 'skin and laser' but about the use of the location Canterbury with this term, as this identifies the Lead Complainant's business. For that reason, the Complainants say that they are not concerned with skin and laser clinics in other areas.
- 5.20 The Complainants say that they have no issues with local competition. In close proximity to the Lead Complainant are Canterbury Cosmedics and Evolution Skin Services which provide skin and laser services.
- 5.21 The Complainants assert that the Respondent's statement that the general population does not understand the differences between laser and IPL treatment is supportive of its claim of potential confusion. The Complainants say that the Respondent's statement that the accusation of confusion can only be for potential customers searching for skin and laser clinics in Canterbury and Kent is an acknowledgment that the 'initial interest confusion' is referring to potential customers.
- 5.22 The Complainants reject the Respondent's allegations of Reverse Domain Hijacking. The Complainants state that the trademark registration was obtained to reinforce the rights in 'Canterbury Skin and Laser Clinic'.

6. Discussions and Findings

- 6.1 Paragraph 2 of the Nominet Dispute Resolution Policy ("the Policy") sets out that for a Complainant's complaint to succeed it must prove to the Expert 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.
- 6.2 The Complainant is required to prove to the Expert that both elements are present on the balance of probabilities.

The Lead Complainant's Rights

- 6.3 Under Paragraph 1 of the Policy, Rights is defined 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.” It is well accepted that the question of Rights falls to be considered at the time the Complainant makes its complaint and is a test with a low threshold to overcome.
- 6.4 The Respondent alleges that ‘Canterbury Skin and Laser Clinic’ is descriptive of the Lead Complainant’s business being a laser and skin clinic in Canterbury. However, by reason of the grant of the UK trade mark there are enforceable rights in the term ‘Canterbury Skin and Laser Clinic’, given that the registration confers on the trade mark proprietor the exclusive right to use the mark in relation to the services for which the mark is registered, being medical services and beauty care for human beings and the medical analysis for the diagnosis and treatment of persons. Accordingly, on the face of it, the Lead Complainant would have Rights by virtue of the granted trade mark.
- 6.5 However, it is the LLP, not either of the Complainants, that is the owner of the registered trade mark. The Lead Complainant and Hudson-Peacock LLP are registered members of the LLP and the Lead Complainant, the Complainant and Dr Alice Hudson-Peacock are registered members of Hudson-Peacock LLP. The Complainant and Dr Alice Hudson-Peacock are directors of the Lead Complainant. It is therefore clear that the Lead Complainant has a beneficial interest in the trade mark and that the trade mark is owned by a related entity to the Lead Complainant. I consider it can also be implied that the Lead Complainant has the consent of the trade mark owner to use the trade mark. On that basis I am satisfied the Complainant has Rights under the Policy by virtue of the UK trade mark which protects ‘Canterbury Skin and Laser Clinic’.
- 6.6 Further, the Lead Complainant has submitted extensive evidence of its use of ‘Canterbury Skin and Laser Clinic’ since 2003 in the Canterbury area, including accounts, sales figures, advertising and promotional expenditure and press cuttings. I am satisfied that the Lead Complainant has established that from 2003 to June 2010 (the month of incorporation of the LLP) ‘Canterbury Skin and Laser Clinic’ was recognised by medical professionals and the public in the Canterbury area as indicating the services of the Lead Complainant. There is some suggestion in the evidence that since June 2010 the LLP, rather than the First Complainant, has provided skin and laser treatment services under ‘Canterbury Skin and Laser Clinic’. However, I consider nothing turns on this. The Lead Complainant had unregistered Rights through use in ‘Canterbury Skin and Laser Clinic’ up until incorporation of the LLP in June 2010. Since June 2010, the evidence suggests (although the position is not clear) that a related entity to the Lead Complainant (the LLP) has continued the

provision of skin and laser treatment services under 'Canterbury Skin and Laser Clinic' from the same premises in central Canterbury. Accordingly, the term 'Canterbury Skin and Laser Clinic' through use is recognised by medical professionals and the public in the Canterbury area as indicating the services of the Lead Complainant or an entity related to it. On that basis I find that the Lead Complainant has unregistered rights through use in 'Canterbury Skin and Laser Clinic'.

6.7 I regard the term 'Canterbury Skin and Laser Clinic' to be identical or similar to the Domain Name (disregarding the .co.uk suffix). In this respect, they both have the common element 'Canterbury Skin and Laser'. In my view the addition of 'Clinic' does not make any significant difference and does not distinguish the mark from the Domain Name. I am supported in this conclusion by the Complainant's evidence that patients and work referrers refer to 'Canterbury Skin and Laser Clinic' as 'Canterbury Skin and Laser', which is indicative that this is the main element of the mark.

6.8 I therefore find that the Lead Complainant has Rights in a name or mark 'Canterbury Skin and Laser Clinic' which is identical or similar to the Domain Name.

Abusive Registration

6.9 It now has to be considered whether the Domain Name, in the hands of the Respondent, is an Abusive Registration. Paragraph 1 of the Policy defines 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.

6.10 It is sufficient to satisfy either of the limbs for there to be a finding of an Abusive Registration.

Abusive Registration under Paragraph 1(i) of the Policy

6.11 Paragraph 3(a) of the Policy sets out a non-exhaustive list of factors which may be evidence that the Domain Name is an Abusive Registration under Paragraph 1(i) of the Policy as follows:

- 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.

- 6.12 Whilst the Complainants do not expressly make a complaint under paragraph 1(i) of the Policy, they do allege that there is a risk of users being initially confused into visiting the Respondent's site when they are looking for the Lead Complainant. If the Respondent registered the Domain Name for the purpose of unfairly disrupting the business of the Lead Complainant, by attracting users to the Respondent's site who were looking for the Lead Complainant and once there potentially diverting users into placing business with the Respondent, then this may be an Abusive Registration under paragraph 1(i) of the Policy.
- 6.13 However, it is important to bear in mind when considering paragraph 3(a)(i) of the Policy that it relates to the Respondent's motives at the time of registration of the Domain Name. It is an intrinsic part of this that, for there to be an Abusive Registration under paragraph 1(i) of the Policy, it must be established that the Respondent had knowledge of the Lead Complainant and/or its rights at the time of registration of the Domain Name. The evidence in this matter does not expressly deal with the Respondent's knowledge of the Lead Complainant and/or its rights at the time of registration of the Domain Name on 17 July 2010 (just after incorporation of the LLP and when almost of all of the trade up until that date had been carried out by the Lead Complainant under 'Canterbury Skin and Laser Clinic'). However, as I consider further below, there is evidence which is indicative of the Respondent's knowledge
- 6.14 The Respondent provides the services of 'Canterbury Skin and Laser' from a hair and beauty salon called Antoniou. The Respondent's website (various versions of it) states that it has been in the centre of Canterbury for more than 15 years and that it is the oldest hair and beauty salon in Canterbury. The Lead Complainant has also been based since 2003 in the centre of Canterbury (the LLP is also based there). The Complainants say that they were unaware of 'Canterbury Skin and Laser' until after registration of the Domain Name.
- 6.15 Taking the above into consideration, I find that the Respondent only commenced its services under 'Canterbury Skin and Laser' after registration of the Domain Name and that prior to this it provided hair and beauty services at its salon. However, I consider that the Respondent must have been aware of the Lead Complainant at the time of registration of the Domain Name. In this respect, both the Lead Complainant and the Respondent have premises in central Canterbury. It would therefore be expected that the Respondent would know of the Lead Complainant. Further, as I have referred to at paragraph 6.6 above, since 2003 the Lead Complainant has advertised its services extensively under 'Canterbury Skin and Laser Clinic' in the local Canterbury area. During this time the Respondent was operating a similar business to that of the Lead Complainant, a beauty salon, and it would therefore be expected that the Respondent would have become aware of the Lead Complainant through such advertising. In this respect, the Complainants have included in their evidence a page from Yellow pages 2011/12 for 'Beauty Salons and Consultants'. This features an advertisement for 'Canterbury Skin and Laser Clinic' in close proximity to an advertisement for 'Antoniou Hair and Beauty'. Whilst this extract from Yellow Pages is after registration of the Domain Name, it is strongly suggestive that the Respondent would have become aware prior to registration of the Domain Name of the Lead Complainant through the parties' advertising activities. Indeed the Complainant's evidence shows that 'Canterbury Skin and Laser Clinic' has advertised

under 'Beauty Salons and Consultants' in the Canterbury Yellow Pages since 2003. Accordingly, I find that the Respondent was aware of the Lead Complainant when it registered the Domain Name. It therefore has to be considered whether such registration was for the purpose of unfairly disrupting the business of 'Canterbury Skin and Laser Clinic' in order for there to be an Abusive Registration under paragraph 1(i) of the Policy.

- 6.16 Given that the Domain Name and the Lead Complainant's trading name both include 'Canterbury Skin and Laser' and given that I would expect 'Canterbury Skin and Laser' to be a common search term for the Lead Complainant and the LLP (as I have referred to above there is evidence that 'Canterbury Skin and Laser Clinic' is shortened to 'Canterbury Skin and Laser') I consider there is a risk of users visiting the Respondent's site in response to a search engine request looking for the Lead Complainant (or the LLP). Indeed, the Complainant has adduced evidence of a Google search for 'canterbury skin and laser' which lists the Respondent second in the search results after 'Canterbury Skin and Laser Clinic'. The Respondent is described in the search results as follows: heading '*Canterbury Skin and Laser*' followed by the Domain Name and the text '*Canterbury Skin and Laser – x4 Times As Many Options, 50% First Time Discount + FREE body & skin analysis, face mapping and also includes a FREE cleanser*'. This search result reinforces my view that there is a real risk of users visiting the Respondent's site in response to a search engine request looking for the Lead Complainant (or the LLP). Indeed the Complainants have provided evidence of a user who found the Respondent through an Internet search when the user had been looking for 'Canterbury Skin and Laser Clinic'. Further, there is also a real risk that Internet users guessing the URL of 'Canterbury Skin and Laser Clinic' will use the Domain Name and thereby visit the Respondent's site.
- 6.17 Once at the Respondent's site users will find 'Canterbury Skin and Laser' which offers competing services to that of the Lead Complainant (and the LLP). Whilst there has been some discussion between the parties as to whether the Respondent is entitled to say that it offers laser services, the key point is that the Respondent's site states that it offers 'laser hair removal' and skin treatments, which are clearly competing services to those of the Lead Complainant (and the LLP). There is therefore a risk that users who find the Respondent's site when looking for the Lead Complainant (or the LLP) will be diverted to the Respondent.
- 6.18 Notwithstanding this risk of confusion and diversion of custom to the Respondent, I must also bear in mind Paragraph 4 (a)(ii) of the Policy that a domain name may not be an Abusive Registration where the domain name is generic or descriptive and the Respondent is making fair use of it. The Respondent says that the Domain Name is one of several domain names it owns comprising of a 'location' and 'generic' term. By a simple check on the Nominet website, I have ascertained that several of the domain names alleged to be owned by the Respondent are not currently registered (beautysalonscantebury.co.uk, financialadviserskent.co.uk, hotelhythe.co.uk, financialadvisorkent.co.uk), one domain name was registered by the Respondent before the Domain Name (judokent.co.uk on 20 March 2010) and another domain name was registered by the Respondent after the Domain Name (pizzacanterbury.co.uk on 8 September 2011). Nevertheless, it has to be considered whether the Domain Name is generic or descriptive as the Respondent asserts.
- 6.19 I have already set out above that I regard 'Canterbury Skin and Laser Clinic' to be distinctive of the Lead Complainant's (and of the LLP's) services in the Canterbury area. The Lead Complainant has shown that through extensive use of this mark in a

concentrated geographical area over a period of time 'Canterbury Skin and Laser Clinic' has acquired a meaning as being distinctive of the Lead Complainant's (and of the LLP's) services. I also regard 'Canterbury Skin and Laser' to be distinctive of the Lead Complainant's (and of the LLP's) services in the Canterbury area. As I have set out above I consider 'Canterbury Skin and Laser' to be the dominant element of 'Canterbury Skin and Laser Clinic'. The Complainants have also shown that it is a name by which the Lead Complainant (and the LLP) is known. I consider that, whilst 'Canterbury Skin and Laser' could potentially be descriptive, in this case it has acquired a secondary meaning of being distinctive of the Lead Complainant's (and of the LLP's) services in the Canterbury area. This explains the confusion which the Complainants have shown is occurring in the Canterbury area through the Respondent's use of the Domain Name.

- 6.20 In my view this case can be distinguished from the Appeal Panel Decision in DRS04889 (Wise Insurance Services Limited and Tagnames Limited) where it was said:

"The Expert was exercised as to the risk of confusion if the Respondent continued to use the Domain Name to connect it to a parking page. However in the Panel's view, the limitations of the goodwill associated with the Complainant's use of its name, makes the likelihood of such confusion very low indeed, and given that the Complainant has adopted a descriptive name for its business it cannot, without more extensive rights, complain about the use of the same descriptive name by a third party".

- 6.21 In this case, the Lead Complainant (and the LLP) has built up through use rights in 'Canterbury Skin and Laser Clinic' and 'Canterbury Skin and Laser'. These terms have become distinctive of their business in the Canterbury area such that there is a real risk of confusion through the Respondent's use of the Domain Name. In my view, the Respondent registered the Domain Name with knowledge of the Lead Complainant and its rights, for the purposes of setting up a site which would attract Internet users looking for the Lead Complainant (and the LLP) and to potentially divert those users to the Respondent.

- 6.22 I am supported in this conclusion by the fact that the Respondent's business at the time of registration of the Domain Name was called 'Antoniou'. Given the Respondent's knowledge of the Lead Complainant, there appears to be no legitimate reason why the Respondent chose the Domain Name for its laser and skin services. Indeed, the beauty salon from which the Respondent offers its laser and skin treatments continues to be called 'Antoniou'. In this respect, I do not agree that recognising that the Lead Complainant has rights in 'Canterbury Skin and Laser Clinic' and 'Canterbury Skin and Laser' prevents the Respondent from operating a competing business. The Respondent could have legitimately chosen another domain name for its business, for example one based on 'Antoniou Skin and Laser'. Further, the earliest version of the Respondent's website that I have seen (screen shot dated 23 July 2011) says 'Welcome to Canterbury Skin and Laser Clinic' (this statement also appeared at this time on the site of 'Canterbury Skin and Laser Clinic'). This is indicative that the Respondent's motive when registering the Domain Name was to unfairly benefit from the Lead Complainant's reputation and thereby unfairly disrupt the business of the Lead Complainant and of any successor.

6.23 I therefore find that the Domain Name, in the hands of the Respondent, is an Abusive Registration under paragraph 1(i) of the Policy as the Respondent registered the Domain Name for the purpose of unfairly benefitting from the Lead Complainant's business and that of any successor and thereby unfairly disrupting the business of the Lead Complainant and of its successor.

Abusive Registration under Paragraph 1(ii) of the Policy

6.24 Whilst I do not need to go further than my finding above, I also find that the Domain Name, in the hands of the Respondent, is an Abusive Registration under paragraph 1(ii) of the Policy.

6.25 In this respect paragraph 3(a)(ii) of the Policy sets out one of the factors which may be evidence that the Domain Name is an Abusive Registration, namely 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. As set out at paragraphs 6.16 and 6.17 above I consider that there is a likelihood of Internet users being initially confused into visiting the Respondent's website in the expectation of finding 'Canterbury Skin and Laser Clinic' and of potentially being diverted to the Respondent.

6.26 Whilst the Respondent has made certain changes to its site, for example to add 'at Antoniou' after 'Canterbury Skin and Laser', the latter still remains the dominant mark as 'at Antoniou' is in much smaller script. There are also other points of similarity with the website of 'Canterbury Skin and Laser Clinic'. For example 'Canterbury Skin and Laser Clinic' uses 'Canterbury' in italics with 'Skin and Laser' below, as does the Respondent and the Respondent uses the same image of a women's face on its website as that on the 'Canterbury Skin and Laser Clinic' site. However, even if users appreciate that they have not found 'Canterbury Skin and Laser Clinic' when they reach the Respondent's site, the Respondent has still used the Domain Name in a way to cause initial interest confusion that the Domain Name is registered to, operated or authorised by or otherwise connected with the Lead Complainant (or its successor).

6.27 I therefore find that the Domain Name, in the hands of the Respondent, is an Abusive Registration under paragraph 1(ii) of the Policy.

6.28 By reason of my findings that the Domain Name in the hands of the Respondent is an Abusive Registration I do not find that there is Reverse Domain Name Hijacking, that is the Complainants have not used the Nominet Dispute Resolution Service in bad faith in an attempt to deprive the Respondent of the Domain Name.

7 Decision

7.1 I find that the Lead Complainant has Rights in a name or mark which is identical or similar to the Domain Name.

7.2 For the reasons set out above I find that the Domain Name, in the hands of the Respondent, is an Abusive Registration.

7.3 I direct that the Domain Name be transferred to the Lead Complainant.

Dr Patricia Jones

20 February 2012