

## DISPUTE RESOLUTION SERVICE

D00010863

### Decision of Independent Expert

Skirmish Ltd

and

David Manning

#### 1. The Parties:

Complainant: Skirmish Ltd  
Moorfield Farm  
Ollerton Road, Oxtun  
Nottingham  
Nottinghamshire  
NG15 0RE  
United Kingdom

Respondent: Mr David Manning  
15 Peninsula Road Norton  
Worcester  
Worcestershire  
WR5 2SE  
United Kingdom

#### 2. The Domain Name(s):

2.1 The domain name in issue is <airsoftskirmish.co.uk> (the "Domain Name")

#### 3. Procedural History:

3.1 The procedural timeline in this case is as follows:

01 February 2012 18:08 Dispute received  
02 February 2012 12:47 Complaint validated

07 February 2012 12:15 Notification of complaint sent to parties  
14 February 2012 08:26 Response received  
14 February 2012 08:26 Notification of response sent to parties  
20 February 2012 15:47 Reply received  
20 February 2012 15:48 Notification of reply sent to parties  
20 February 2012 15:48 Mediator appointed  
23 February 2012 09:34 Mediation started  
23 March 2012 12:26 Mediation failed  
23 March 2012 12:29 Close of mediation documents sent  
11 April 2012 10:42 Expert decision payment received

- 3.2 I was appointed as Independent Expert as of 24 April 2012 and confirmed to Nominet that I was independent of the parties and knew of no facts or circumstances that might call into question my independence in the eyes of the parties.

#### **4. Factual Background**

- 4.1 The Complainant operates paint balling sites and organises paint balling games around the United Kingdom. It is the owner of the following registered trade marks:

- (i) UK registered trade mark no 1335530 filed on 20 August 2010 for the word mark SKIRMISH, in class 41 in respect of the “organisation of, and provision of the services for adventure game services”; and
- (ii) UK registered trade mark no 1244855 filed on 26 June 1985 for the word mark SKIRMISH, in class 28 in respect of “games (other than ordinary playing cards)”.

- 4.2 The UK register in relation to the class 28 trade mark suggests that this trade mark was assigned to the Complainant in or about October 2000.

- 4.3 The Respondent appears to be an individual.

- 4.4 The Domain Name was registered on 6 December 2006. As at the date of this decision no website appears to be operating from the Domain Name.

#### **5. Parties’ Contentions**

- 5.1 All the parties’ contentions in this case are very short.

##### The Complaint

- 5.2 The Complainant refers to its registered trade marks and claims to have “contacted Mr Manning without success to refrain from using the domain”. A copy of an unsigned letter in Word format dated 18 February 2011 is enclosed with the Complaint and presumably the Complainant contends that the Respondent was contacted in a letter that took this form.

- 5.3 The Complainant's contentions as to why the Domain Name is an abusive registration are to be found in a single paragraph in the Complaint. It reads as follows:

“[The Respondent] is clearly breaching our tra[d]emark by using the domain and could be confused with our company of which he has no relation. We have previous written to Mr Manning to ask him to desist from the use of the domain only to rec[ei]ve an abusive phone call and temporary change of the content which has now reverted back to its original”.

- 5.4 There is no explanation in the Complaint as to what form the website operating from the Domain Name ever took. However, the unsigned letter of February 2011, asserts as follows:

“It has come to our attention that you are using the SKIRMISH trade mark in relation to the provision of paintball and/or other adventure games such as airsoft. We enclose a copy of a page from your web site with examples of your use of the SKIRMISH name. Particularly use of the domain name [www.airsoftskirmish.co.uk](http://www.airsoftskirmish.co.uk) which clearly shows you are the registrant of the domain.”

- 5.5 The copy website page referred to in this letter is not provided. In the Complaint, in response to the question: “Are there any web pages that support this dispute?”, the Complainant refers to [www.airsoftskirmish.co.uk](http://www.airsoftskirmish.co.uk), but again that page is not provided.

#### The Response

- 5.6 The Response includes the following statements:

“The word Skirmish which they claim “Trademark” on does not have a style and cannot be trademarked as it is a word in general use in the English language used to convey the meaning as per the Oxford English Dictionary. The name of our website is indented as the name of our company which trades in Airsoft Equipment. We also have a private site where the equipment can be tried and tested during the course of simulated Skirmishing within the strict meaning of the word as defined in the Oxford English Dictionary.

Skirmish Ltd does not even trade paintball services under this name, they have franchised paintball sites using the word “Skirmish Paintball”. They do not have this registered as a trade mark only the word “Skirmish”! We have been advised by the Intellectual Property Office that they cannot just add words before and after their trademark name of “Skirmish” and be the treated as the same trademark. We have also had the papers now drawn up to challenge their claim to the word skirmish as advised by the Intellectual Property Office directly. They do not own any other trademark relating to the word skirmish and no logo registered to that

trademark. Our Logo is completely different and the services that we offer are completely different to the paintball games that Skirmish claim to run.”

- 5.7 The Respondent also quotes the following text which is said to be on the Respondent website:

“We follow the rules as laid out in the Violent Crime Reduction Act 2007 (As published by the Home Office :- “skirmish”\*)

\* this term is quoted from the Home Office document.

Airsoft Skirmish has nothing to do with Skirmish Ltd, their trade mark, or any other person, or company using the afore said word or abbreviations.”

- 5.8 The “Home Office document” to which the Respondent refers is not provided or identified.

#### The Reply

- 5.9 The Complainant has filed a Reply. It for the most part simply repeats the contentions made in the Complainant, although on this occasion there is the assertion that the “Respondent changed his web site to divert customers to a new domain”. What form that change took is not explained and no material is provided to support this assertion.
- 5.10 The Reply also contains a statement that seeks to address the question of whether the language used by the Respondent during a telephone conversation with the Complainant was abusive. However, the competing contentions of the parties in this respect are not particularly relevant to any issue in these proceedings and it is, therefore, not necessary to record them in this decision.

## **6. Discussions and Findings**

### General

- 6.1 To succeed under the Policy, the Complainant must prove first, that it has Rights in respect of a "name or mark" that is identical or similar to the Domain Name (paragraph 2(a)(i) of the Policy) and second, that the Domain Name is an Abusive Registration in the hands of the Respondent (paragraph 2(a)(ii) of the Policy). The Complainant must prove to the Expert that both elements are present on the balance of probabilities (paragraph 2(b) of the Policy).
- 6.2 Abusive Registration is defined in paragraph 1 of the Policy in the following terms:

*"Abusive Registration means a Domain Name which either:*

*(i) was registered or otherwise acquired in a manner which, at the time when the registration or acquisition took place, took unfair advantage of or was unfairly detrimental to the Complainant's Rights:*

*OR*

*(ii) has been used in a manner which took unfair advantage of or was unfairly detrimental to the Complainant's Rights."*

### Complainants' Rights

- 6.3 The Complainant is clearly the owner of two word marks for the term "Skirmish" and that term is reproduced in its entirety in the Domain Name. The Domain Name can be most sensibly read as the terms "Airsoft" (or "Air" and "Soft") and "Skirmish" in combination. The significance and nature of the "Airsoft" element of the Domain Name is not really addressed by either of the parties, but there is a suggestion that "Airsoft" may be a name used in respect of certain "equipment" sold by the Respondent.
- 6.4 Whatever the meaning or significance of the term "Airsoft", its inclusion in the Domain Name does not so detract from the term "Skirmish" as to prevent a finding of similarity between the Complainant's marks and the Domain Name (see paragraph 2.3 of the Dispute Resolution Service – Experts' Overview).
- 6.5 There is a suggestion in the Response that the Respondent intends to challenge the validity of the trade marks. However, as far as I can tell there is nothing publicly available on the IPO website that suggests that any challenge has been filed. Further, even had such material been available, this is unlikely to have made any difference to the determination of similarity. An expert under the Policy is not best placed to second guess proceedings before the IPO or any other trade mark registry
- 6.6 In the circumstances the Complainant has made out the requirements of paragraph 2(a)(i) of the Policy.

### Abusive Registration

- 6.7 The Complainant's case is that the Respondent is infringing its trade marks. However, there are a number of difficulties with this position.
- 6.8 First, there is a lack of clarity of argument or evidence to support this claim. In particular, the Complainant has failed to properly describe or evidence what the Respondent is said to be doing in this case. There is nothing in the Complaint itself in this respect. Although there is a claim in a letter enclosed with the Complaint that the Respondent is using the Domain Name "in relation to the provision of paintball and/or other adventure games such as airsoft", that letter is over a year old and is unsigned. More importantly, no further material or other evidence is provided to support the claims set out in that letter.

- 6.9 The Complaint refers to the website operating from the Domain Name, but pages from that site are not provided and no site is operating from the Domain Name at the date of the decision.
- 6.10 The Respondent also seems to be denying what the Complainant contends. In particular, it asserts that it sells “Airsoft Equipment” and that the “services that [it] offer[s] are completely different to the paintball games that Skirmish claim to run”. There is no explanation of what “Airsoft Equipment” comprises and what services, if any, the Respondent provides are also not explained. Therefore, these claims, like those of the Complainant, are little more than assertion. However, ultimately the burden of proof is on the Complainant and in the absence of further material, I am not in a position to determine whose claims are correct.
- 6.11 Second, there is a more fundamental problem with the Complainant’s claims of infringement. The questions of abusive registration and trade mark infringement often overlap but they are not the same. In *Seiko UK Limited v. Designer Time/Wanderweb* DRS 00248 the Appeal Panel stated as follows:

“The Panel considers that parties and Experts should not be overly concerned with whether or not an allegedly abusive registration also constitutes an infringement of registered trade mark. The question of trade mark infringement is, as both parties (and the Expert) agree, one for the courts to decide. The question of abusiveness is for the Expert to decide. The two jurisdictions co-exist alongside each other, and no doubt there will be considerable overlap. However there may well be factual scenarios in which an abusive registration under the Policy would not be an infringement of trade mark under the 1994 Act, and where an infringement of trade mark under the 1994 Act would not be an abusive registration under the Policy. The safest course for parties and Experts is simply to address the terms of the Policy.”

- 6.12 The Appeal Panel in *Comité Interprofessionnel du Vin de Champagne v Steven Terence Jackson*, DRS 4479 also quoted this aspect of the *Seiko* decision with approval. Further, more recently in *Furniture Village Limited v. Furnitureland.co.uk Ltd.* DRS9674 the Appeal Panel (at paragraph 8.21) swiftly dismissed a complaint that the original Expert in that case had given insufficient weight to claims of trade mark infringement with the words:

“... the question of whether the Respondent’s activities amount to trade mark infringement is a matter to be determined elsewhere ...”

- 6.13 Trade mark law cases are referred to in the Experts’ Overview. However, the reasons for this are set out in the introduction to that Overview as follows:

“Disputes are decided by reference to the terms of the Policy, not the law, so the fact that a domain name registration and/or the

registrant's use of it may constitute trade mark infringement, for example, will not necessarily lead to a finding of Abusive Registration under the DRS Policy. Nonetheless, if the DRS Policy and the Law are too far apart, the DRS Policy will inevitably lose some of its value. Rights owners or domain name registrants (depending upon the nature of dispute) may prefer the expense of litigation to the likely result under the DRS Policy.

Accordingly, it is important that all concerned are aware of relevant legal developments and it is for this reason that in this Overview there are references to UK court decisions, most if not all of which are to be found in full text form on the Nominet web site."

- 6.14 In short, for a complainant to put forward a case of abuse based solely on trade mark infringement is to say the least problematic. In the opinion of this Expert such claims are at best secondary and more often than not an unnecessary distraction from the issues of abusive registration that an Expert has to decide. When it comes to abuse, a complainant should address the specific requirements of the Policy. The Complainant has failed to do this in this case.
- 6.15 Further, there is insufficient evidence in the submissions filed by the parties to justify a finding of abuse in this case.
- 6.16 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. Ordinarily, one would expect a complainant to assert that one or a number of these factors apply and to provide evidence in support of that assertion. Usually, that would involve assertions and evidence that the complainant's use of the relevant term is well known (or at least known to the respondent) and that the respondent is trying to take some unfair advantage of the associations of that term with the complainant. The Complainant has done none of this.
- 6.17 Sometimes such argument or evidence is unnecessary because the term relied upon is so unusual that the only sensible inference to be drawn from the inclusion of that term in a domain name is that the respondent registered the domain name with the complainant's mark in mind (see, for example, the analysis in this respect in *Chivas Brothers Limited v David William Plenderleith* DRS 658). However, in the present proceedings the Complainant has complained about the use in the Domain Name of an ordinary English word in combination with another term in which the Complainant claims no rights.
- 6.18 This does not mean that the term "Skirmish" cannot have been properly registered by the Complainant as a trade mark. It also does not mean that the Respondent's activities do not constitute trade mark infringement. However, the Complainant has simply failed to carry the burden of proof when it comes to showing abusive registration or use.

## **7. Decision**

- 7.1 In light of the foregoing, and in particular the Complainant's failure to establish abusive registration or use, the Complaint is rejected.

**Signed Matthew Harris**

**Dated 26 April 2012**