

DISPUTE RESOLUTION SERVICE

D00010948

Decision of Independent Expert

Gillingham Football Club Limited

and

Mr Alan Liptrott (Gills Supporters Club)

1. The Parties:

Complainant: Gillingham Football Club Limited
Priestfield Stadium
Redfern Avenue
Gillingham
Kent
ME7 4DD
United Kingdom

Respondent: Mr Alan Liptrott (Gills Supporters Club)
3 The Haven
10 The Riviera
Sandgate
Folkestone
Kent
CT20 3AB
United Kingdom

2. The Domain Name(s):

gillinghamfc.co.uk

3. Procedural History:

21 February 2012 11:51 Dispute received
21 February 2012 12:43 Complaint validated

21 February 2012 13:01 Notification of complaint sent to parties
12 March 2012 08:33 Response received
12 March 2012 08:33 Notification of response sent to parties
22 March 2012 07:32 Reply received
22 March 2012 07:34 Notification of reply sent to parties
28 March 2012 09:08 Mediator appointed
30 March 2012 13:06 Mediation started
03 May 2012 13:58 Mediation failed
03 May 2012 13:59 Close of mediation documents sent
15 May 2012 10:51 Expert decision payment received

4. Factual Background

The Complainant is a well known English football club formed in 1893 and currently placed in seventh position in League Two. The Respondent is a supporter of the Complainant's club and has been operating a website since 1999 concerning the Complainant's club.

5. Parties' Contentions

5.1 *The Complainant's contentions*

The Complainant says that it was formed in 1893 and has since then owned and operated the football club which has been known as Gillingham FC since 1912. The Complainant observes that many football clubs use their name followed by "FC". The Complainant says it is currently 7th in League Two. The Complainant observes that it has generated significant goodwill and reputation, both in the media and with the public, in the name or mark "GILLINGHAM FC" by virtue of its many years in the Football League.

The Complaint also refers to its registered trade mark number 2238271 using its badge and the text "GILLINGHAM FOOTBALL CLUB EST. DOMUS CLAMANTIUM 1893" annexed hereto as "Annex 1".

The Claimant asserts that it also has common law rights in the name or mark "GILLINGHAM FC" which predates the registration of the Domain Name.

The Complainant points to its own website at www.gillinghamfootballclub.com which the Complainant registered on 13 September 1999.

The Complainant says that the Respondent runs a Gillingham FC fan website called "Gills Connect" at www.gillsconnect.com, which he registered on 14 June 2000. The Complainant says that the Respondent had previously registered the Domain Name on 21 February 1999.

The Complainant contends that the Domain Name is an Abusive Registration under the DRS Policy as the Respondent made the registration fully knowing the Complainant's rights.

The Complainant points to a Google search using "Gillingham fc" and "Gillinghamfc" and points out that the website to which the Domain Name resolves allows a person to click on the banner at the top of the webpage and then be directed to the Gills Connect website.

The Complainant says that the Gills Connect website does not identify itself as a fan website, but has a design similar to that of the Complainant.

The Complainant also says that the relations between it and the Respondent are not good, with the Respondent having been banned from attending matches at the Complainant's ground. The Complainant fears that the Respondent is able to air his grievances about the Complainant by means of a website which has the air of being the Complainant's official website. The Complainant further fears that the casual user would not realise the truth, given the words on the webpage to which the Domain Name resolves as well as the similar design of the Gills Connect website.

The Complainant says that the Respondent does not use the Domain Name as a website in itself, but as a "lure" to his own website. The Complainant says that this is use which confuses people or businesses into thinking that the Domain Name is registered to, authorised by or otherwise connected with the Complainant. The Complainant thinks that this use shows that the Respondent is trading on this confusion. The Complainant refers to various advertisements on the Respondent's website showing that he is making commercial use of the website.

The Complainant submits that the Domain Name is an Abusive Registration since it is unfairly detrimental to the Complainant as it diverts traffic from the Complainant's website, has taken an unfair advantage of the Complainant's rights in the name or mark "GILLINGHAM FC" and causes confusion among fans and others following the Complainant.

The Complainant has offered the Respondent's reasonable costs of transfer but the Respondent has refused the offer.

5.2 *The Respondent's contentions*

The Respondent says that he has been a supporter of Gillingham Football Club since the mid-60's and has acted as chairman of the "Gills Supporters Club".

The Respondent says that he, with other supporters, took advantage of the internet in the 90's; in early 1999, he bought the Domain Name and established it as a non-profit-making organisation.

At that time, the Respondent says that he had a good relationship with the Complainant's chairman and that he offered him the Domain Name and other supporters' services to set up a website for the Complainant. However, the chairman was not interested, according to the Respondent.

Later in 1999, the Respondent says that he joined a network of like-minded supporters and from 1999 used the email address alan@gillinghamfc.co.uk. He also says that "@gillinghamfc.co.uk" is also used for player of the year voting polls.

The Respondent says that the Complainant's chairman began to have problems with the local press and the Complainant's team's manager, and that this started to sour relations between the Respondent and the Complainant. The Respondent says that the Complainant's chairman also made untrue allegations about the Respondent, and demanded that the Respondent transfer the Domain Name. The Respondent says that the Complainant banned him from the ground in consequence of his refusal to make such a transfer. The Respondent says that this ban was lifted in 2007. The Respondent says that he continued to use the Domain Name as a portal for such things as images and videoclips. The Respondent says that he linked the Domain Name to another website, www.gillsconnect.com. The Respondent says that he continued to use the email address as it was useful to stay in contact with other supporters. The Respondent says that a friend designed the website, www.gillsconnect.com, which was launched in August 2009 with no advertising material and had no commercial interest. The website to which the Domain Name resolves still has no advertising material or commercial content. The Respondent says that the forum at www.gillsconnect.com uses the free proboards.com facility and any advertising revenue is directed to it and not to the Respondent.

The Respondent says that the Complainant received the domain name www.gillinghamfc.com from a supporter around 2000, although they never uploaded content to it and the Respondent notes that the Complainant no longer owns this domain name.

The Respondent observes that the Complainant has not registered "GILLINGHAMFC" or "GILLINGHAM F.C." as a trademark.

The Respondent observes that using a search term such as "Gillingham" or "Gillinghamfc" will produce results of many other unofficial fan websites.

The Respondent disputes that the links cause confusion, as such linking is common on the internet and the Respondent says that he has been using it since 1999.

The Respondent says that the issues concerning gillsconnect.com have no foundation and anyway fall outside the remit of Nominet.

Finally, the Respondent says that he receives no funding from any website he manages and expenses are paid by him and his co-publisher.

5.3 *The Complainant's Reply*

The Complainant says that the Respondent has made personal allegations concerning the Complainant's chairman, which are not relevant. The Complainant does not accept the Respondent's version of events.

The Complainant reiterates that it wants transfer of the Domain Name for the reasons set out in the Complaint, in particular, for the confusion it causes. The Complainant refers again to the banner on the website to which the Domain Name resolves and the wording accompanying it.

The Complainant contends that the confusion is the Respondent's aim as he could just use the gillsconnect.com website, and there is no need to use the Domain Name as a portal.

The Complainant notes that the Respondent has not denied that confusion arises.

6. Discussions and Findings

6.1 *Rights*

The Complainant must be able to show that it has "Rights" as defined by the DRS Policy. "Rights" are defined by the DRS Policy (paragraph 1) as meaning, "rights enforceable by the Complainant, whether under English law or otherwise, and may include rights in descriptive terms which have acquired a secondary meaning". By paragraph 2 of the DRS Policy, the Complainant has the burden of proving that it "has rights in respect of a name or mark which is identical to or similar to the Domain Name".

The Complainant has produced evidence of a UK trade mark which I have annexed as "Annex 1". The words registered are all those which appear in connection with two graphics representing crests. If written, the words make no sense, as they are "GILLINGHAM FOOTBALL CLUB EST. DOMUS CLAMANTIUM 1893". It makes sense when you look at the trade mark registration itself and you see that there is a

crest: you then appreciate that “Gillingham Football Club” appears at the head of the crest formed by a shield, with the remaining words in a ribbon underneath the shield. An important difference between the registered trade mark and the Domain Name is that the club’s name is written out in full, whereas the Domain Name uses the abbreviation, “FC”. I accept the Complainant’s submissions that “FC” is a common abbreviation for “football club”, especially when it follows a town’s name as it does here. Most people would, I think, recognise it as such. I do not accept that it would readily be confused, as the Respondent suggests, with Gillingham fishing club, flower club or fans club.

In any case, the Complainant does not have to show that the Rights he is asserting are completely identical with the Domain Name. Paragraph 2(a)(i) of the DRS Policy requires that the Rights can be “similar” to the Domain Name.

One issue relating to the Complainant’s trade mark is that it actually postdates the Domain Name’s registration: the copy trade mark registration starting at page 4 of the Complaint shows that registration took place on 6 April 2001 after having been filed on 5 July 2000, whereas the Domain Name was registered on 21 February 1999. I will consider this below.

However, the Complainant has also asserted that it “self-evidently” has over the many years of its existence generated goodwill and reputation sufficient to establish common law rights. Little is provided in the Complaint by way of evidence to support this. There is some evidence in the history of the Complainant’s club starting at page 1 of the annex to the Complaint. I have also looked at the Complainant’s website, which provides further evidence of the way in which the Complainant uses its trading style. The existence of common law rights is potentially important, as the trade mark on which the Complainant relies postdates the Domain Name. It is important, therefore, to be satisfied that common law rights have vested in the Complainant.

Despite the relatively little evidence submitted by the Complainant to support its common law rights, I am prepared to accept that it has common law rights by virtue of its operation of a football team known as “Gillingham Football Club” or Gillingham FC” for what is a considerable period of time (since 1912, according to the Complainant’s evidence). I accept the Complainant’s evidence that its trading style is effectively the same as the name of the football club it operates.

Establishing “Rights” is a relatively low threshold for the Complainant to cross under the DRS Policy. While the Complainant might have problems with reliance on the trade mark alone given the fact that it postdates the Domain Name’s registration, it is able to rely on its common law rights as sufficient to constitute “Rights” as required by

the DRS Policy. Those “Rights” are sufficiently similar to the Domain Name.

6.2 Abusive Registration

The DRS Policy (paragraph 1) 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”

Paragraph 3 of the DRS Policy sets out a non-exhaustive list of factors which can be evidence of an Abusive Registration. The Complainant has put its case on the basis that visitors to the website to which the Domain Name resolves will be confused. The relevant parts of paragraph 3 are therefore, paragraphs 3(a)(i)(C) and 3(a)(ii). The Complainant has produced no actual evidence of confusion or shown that its business has been disrupted in any way. However, paragraph 3(a)(ii) says that the evidence can be such as 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”.

In this regard, the Complainant points to several features. It refers to the fact that the webpage to which the Domain Name resolves is not itself a website, but only has a banner and accompanying words which suggest that it is indeed somehow an “official” website. However, the banner itself contains the text, “Gills Connect”. (I take it that “Gills” is the colloquial name for the Complainant’s club.) The Complainant also points out the similarity in design between the Respondent’s “Gills Connect” website and the Complainant’s, principally that there are blue borders on either side of the text in the middle of the page.

I have looked at the Complainant’s website and also the Respondent’s websites. The Respondent has, for present purposes, the webpage to which the Domain Name resolves as well as the his separate “Gills Connect” website. The webpage to which the Domain Name resolves itself has a link to that separate “Gills Connect” website.

Having looked at all these websites, I have come to the view that a casual internet visitor would be confused and might well believe that, by coming to the Respondent’s “Gills Connect” website, he had come to the Complainant’s website. I note that there is nothing on the webpage to which the Domain Name resolves to say that the site is not “official” or in some way not authorised by the Complainant. The same

could be said of the Respondent's "Gills Connect" website. I should stress that I do accept the Respondent's point that his "Gills Connect" website is a separate entity, and not subject to the DRS Policy. My decision is based on what I see and read when I visit the webpage to which the Domain Name resolves. I also take account of the function served by the link on the webpage to which the Domain Name resolves.

The Complainant also says that the Respondent is earning money from his "Gills Connect" website, and therefore indirectly from the Domain Name as the latter links to the "Gills Connect" website, since the "Gills Connect" website contains advertisements. The Respondent denies this, saying that all advertising revenue is taken by the provider of the forum. Having looked at the Respondent's "Gills Connect" website, I accept what the Respondent says on this subject: there is no advertising other than on pages where there is a forum and I accept that the forum provider is taking all the advertising revenue. In any case, the "Gills Connect" website is a separate, ".com" website and not subject to the DRS Policy.

Another point is that neither the website to which the Domain Name resolves nor the Respondent's "Gills Connect" website seems to provide for the sale of any merchandise such as football clubs are wont to offer (clothing bearing the football team's colours or logo and so on). I therefore accept that the Respondent's activities do not fall within paragraph 3(a)(i)(C) of the DRS Policy as there is no evidence that the Respondent is disrupting the Complainant's business at all.

Before coming to a conclusion on these issues, it is important to note that paragraph 4 of the DRS Policy provides a non-exhaustive list of factors which may be evidence that the Domain Name is not an Abusive Registration. Paragraphs 4(a)(ii) and 4(b) seem especially relevant. They provide that it can be evidence that a Domain Name is not an Abusive Registration if "the Domain Name is generic or descriptive and the Respondent is making fair use of it" and "fair use may include sites operated solely in tribute to or in criticism of a person or business".

The Complainant says that the Respondent is using the Domain Name effectively as a conduit, leading people to his "Gills Connect" website where he "airs grievances about the club". Of course, it is not unknown for football club supporters to have criticisms of their club or its management and for them to air these grievances very publicly. Indeed, in a free country, there is no objection to their doing so as such. Indeed, after looking through the Respondent's "Gills Connect" website, it seems to be an ordinary fan website, without overtly negative or unjustified criticisms of the Complainant or its football club and, as far as I can tell, contains such comments, favourable or otherwise, as a football club supporter could be expected to make about his favourite club.

There is some evidence provided by both parties of a long history of differences between them since the registration of the Domain Name. I consciously use a neutral term (“differences”): while each of the Complainant and the Respondent has provided some explanation of the bad history between them, the Complainant has not really addressed this in any detail and has simply chosen to say in its Reply that the Respondent’s history is not correct. It is strange that the Complainant has apparently done nothing since 1999 to make a formal complaint about the Domain Name, but there is no doctrine of laches or other similar doctrine which prevents reliance on the DRS Policy as a result of inaction over an extended period.

It does, as I say, seem strange that the Complainant has done little or nothing to assert its rights as against the Domain Name since 1999. Delay was considered in DRS00008347 <5alive.co.uk> where the Expert in that Decision held that a delay of 6 years was sufficient to enable him to decide that there was no Abusive Registration. The Expert said that “[h]ad the proceedings been brought closer to the date of registration the balance may easily have been tilted the other way, but at this late remove, the Expert considers that the balance favours the status quo”.

In that case, the Expert found it “hard to credit” that the complainant (The Coca-Cola Company), being a large international organisation, did not monitor the use and registration of domain names. I think there is a world of difference between a company like The Coca-Cola Company and a Division 2 football club, which I would not expect to monitor domain names with anything like the same assiduity as a large international organisation.

Again, the Expert in that case thought that the complainant might possibly have ignored domain names other than “Coca-Cola” and adopted a policy whereby it “passively tolerated” other domain names such as the domain name in that case. The evidence here does not show “passive tolerance”. There plainly has been bad blood between the parties at some extended points in their relationship. I do not think that the Respondent could have deduced that the Complainant was permitting the status quo to continue without reservation.

In any case, I do not have a complete history of how the Domain Name has been used over the whole period. It may well be that, for a considerable period, the Domain Name was not being actively used in a way objectionable to the Complainant: I just do not know. I do, however, note the Respondent’s evidence that his new “Gills Connect” website was launched as recently as August 2009: the use to which the Complainant objects is therefore very recent. However, I do not think I have to come to a conclusion about the history of the relations between the parties. The complaint is not about the original registration: it is about the use of the Domain Name at this point in time. An allegation of

Abusive Registration can relate to the original act of registration or it can relate to later use of the domain name in question. If the latter, the history going over several years is not always relevant. It might be relevant if the Complainant's inaction had led the Respondent to believe that current use was permitted or if there was some sort of licence that could be constructed out of the parties' words or actions. That is not so here. The evidence points to a situation where there was nothing like an agreement between the parties, express or implied, that the Respondent could continue to use the Domain Name in any way he chose with impunity. Equally, there does not appear to have been some sort of express or implied permission arising from the Complainant's acquiescence to the effect that the Respondent could freely use the Domain Name as he chose.

I come back to the fact that, as the Complainant has observed, the webpage to which the Domain Name resolves is not itself a website as such, rather it operates as a mere link to a separate website which contains the material of a supporter's website. I accept the Complainant's point that the words underneath the banner on the webpage to which the Domain Name resolves suggest (without actually saying) that the visitor to that page is being directed to a new and "official" website belonging to the Complainant. While not directly relevant to disputes under the DRS Policy concerning the Domain Name, the Respondent's "Gills Connect" website is very similar in overall style to the Complainant's website. The use of the blue coloured border may be something to do with blue being the Complainant's team's colours (I note that the Complainant's trade mark claims the colours blue, white and black as an element of the second mark in the series). However, one cannot avoid the feeling that, given the factual material presented on the "Gills Connect" website, many people would think they were on the Complainant's official website rather than a supporter's website. It may be that they would come to realise their mistake after looking at the contents of the "Gills Connect" website and might do so quickly. Nevertheless, there is a distinct possibility that there could be what has come to be known as an "initial interest confusion" created in the minds of many users visiting the webpage to which the Domain Name resolves and then being invited to click on the link to the "Gills Connect" website.

Paragraph 4(a)(ii) does provide for where a Respondent is making fair use of a Domain Name which is descriptive or generic, but the Domain Name here is descriptive, not of a supporter's fan club, but of the football team itself. It is hard to escape the conclusion that the principal – perhaps the only – rationale for the Domain Name's use at present is to capture the attention of those searching for the Complainant or its football team and then direct them to a separate website not authorised in any way by the Complainant. The current use of the Domain Name does not, in my opinion, constitute fair use of the Domain Name. If the Domain Name were to be transferred to the Complainant, it would make no difference to the Respondent's "Gills Connect" website, which

would still exist. The Complainant might have other complaints about that other website, but they would have nothing to do with any decision about this particular Domain Name in this particular dispute.

The Complainant has stated that it has made various offers to the Respondent for the transfer of the Domain Name. There is little evidence of this but, in view of my conclusion, it is not necessary to consider this further.

In conclusion, therefore, I have decided that this case falls within the grounds set out in paragraph 3(a)(ii) of the DRS Policy, because the Respondent is using the "Domain Name in a way which ... is likely to confuse people ... into believing that the Domain Name is registered to, operated or authorised by, or otherwise connected with the Complainant." For that reason, I accept that the Domain Name is an Abusive Registration and there are no grounds within paragraph 4 of the DRS Policy or otherwise which apply to prevent that conclusion.

7. Decision

I direct that the Domain Name should be transferred to the Complainant.

Signed Richard Stephens

Dated 8 June 2012

ANNEX 1

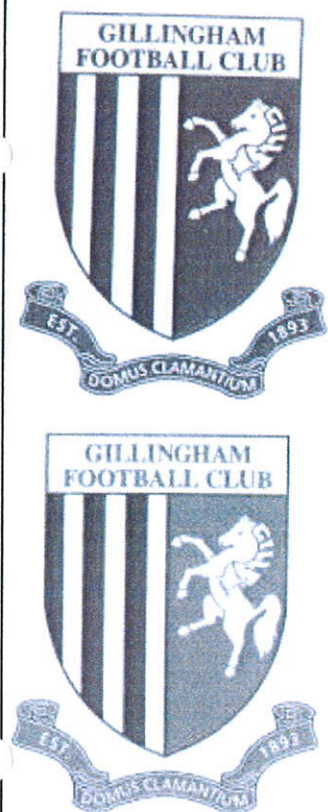


Case details for Trade Mark 2238271

[Explanation of terms](#) used on this page

[Case history](#) including, where available, licensee details

Mark

**Mark text:**

GILLINGHAM FOOTBALL CLUB EST. DOMUS CLAMANTIUM 1893

Mark claim/limit:

The applicant claims the colours blue, white and black as an element of the second mark in the series.

Series of:

2

Status

Status:

Registered

Classes:

4 09, 16, 18, 25, 28, 35, 41

State before death:

Relevant dates

Filing date: 05 July 2000
Next renewal date: 05 July 2020
Registration date: 06 April 2001
Progress stopped: 06 July 2010

Publication in Trade Marks Journal

First advert:

Journal: 6359
Page: 22532
Publication date: 20 December
 2000

Registration:

Journal: 6378
Publication date: 09 May 2001

Renewal:

Journal: 6845
Publication date: 23 July 2010

Expiry:

Journal: 6844
Publication date: 16 July 2010

List of goods or services

Class 09:

Audio and video cassettes, computers, computer software, credit cards, telephones, phone cards.

Class 16: Cardboard, cardboard articles, plastic bags, pencils and wrapping materials, books, printed matter, newspapers, periodical publications, calendars, photographs, stationery, ordinary playing cards, pens and rulers, match day programmes, diaries, stationery holders.

Class 18: Articles made from leather or from imitation leather; trunks, shoulder bags, waist bags, duffle bags, garment bags for travel, ruck sacks, all-purpose sports bags, vanity cases, overnight bags, travelling bags, wallets and purses, umbrellas and parasols, programme holders, key cases.

Class 25: Clothing, headgear, footwear, sports clothing, football boots, bathrobes, jackets, jerseys, overalls, shirts, shorts, T-shirts, shell suits, sweatshirts, sweaters, track suits, waterproof clothing, waistcoats; ties; scarves; replica football strip; socks, stockings, hosiery; hats and caps; dressing gowns; pyjamas; underwear; baby clothing; wrist bands; fleeces.

Class 28: Games, toys and playthings; sporting articles; rugby balls, sports balls, gymnastic apparatus, body building apparatus, shin guards, gloves for games.

Class 35: Advertising, marketing, publicity and promotion services, business information services; procurement of goods; advisory, consultancy and information relating to the sale and purchase of goods and services; e-commerce services, all provided also on line from a computer database, or the internet.

Class 41: Sporting services, organisation of sporting events and activities, recreational services, publishing services, arranging and conducting of seminars, club services, physical education, training (practical demonstrations), sport camp services, education relating to sports and leisure, organisation of sporting events and competitions, organisation of exhibitions, film production, production of video tapes, production of radio and television programmes, provision of exhibition and museum facilities, live performances and audience participation events; theatrical performances, concerts, provision of stadium, conference and exhibition services, rental of stadium facilities and sports apparatus; provision of lottery services and ticket issuing facilities.

Names and addresses

~~Bill~~ ~~Football Club~~ plc

Priestfield Stadium, Redfern Avenue, Gillingham, Kent, ME7 4DD, England

Incorporated country: Great Britain

Residence country: Great Britain

Customer's ref: ALAN MCBRAY / 743339

ADP number: 0790230001

Service: Hallmark IP Limited
1 Pemberton Row, London, EC4A 3BG

ADP number: 0004069001

Earlier rights notification

Opted in for notifications

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