

DISPUTE RESOLUTION SERVICE

DRS 11620

Decision of Independent Expert

Friday-Ad Ltd

Complainant

and

CM Brothers

Respondent

1 The Parties

Complainant:	Friday-Ad Limited
Address:	London Road Sayers Common West Sussex
Postcode:	BN6 9HS
Country:	United Kingdom

Respondent:	CM Brothers
Address:	House No. 1141, Sector 2, Street 56, Gulshan Abad, Adyala Rd. Rawalpindi Capital
Postcode:	11222
Country:	Pakistan

2 The Domain name

fridayadbrighton.co.uk (the "Domain Name").

3 Procedural history

10 July 2012 12:39. Dispute received
13 July 2012 11:22. Complaint validated
13 July 2012 11:26. Notification of complaint sent to parties
18 July 2012 14:03. Response received
18 July 2012 14:04. Notification of response sent to parties
23 July 2012 02:30. Reply reminder sent
24 July 2012 16:03. Reply received
26 July 2012 11:50. Notification of reply sent to parties
26 July 2012 11:50. Mediator appointed
8 August 2012 09:59. Mediation started
17 September 2012 09:59. Mediation failed
17 September 2012 10:11. Close of mediation documents sent
27 September 2012 02:30. Complainant full fee reminder sent
1 October 2012 08:51. Expert decision payment received

4 Factual background

- 4.1 The Complainant is a limited company registered in the United Kingdom. According to its website, it was launched in Uckfield, Sussex in 1975 as a four page publication containing classified advertisements. It says that it currently prints over 400,000 copies of *Friday-Ad* each week, and claims over 1 million readers, with over 20,000 businesses advertising their products and services.
- 4.2 It also publishes online with over 362,000 ads each week, "covering everything from motors to jobs, pets to property".
- 4.3 On 9 May 2012 the Respondent registered the Domain Name for a 12 month period.
- 4.4 The Respondent is using the Domain Name on a website called Friday Ad Brighton which, like the Complainant's website at www.friday-ad.co.uk, provides a forum for individuals and businesses to place classified advertisements.

5 Parties' contentions

Complaint

- 5.1 The Complaint is skeletal and includes no evidence in support.
- 5.2 The Complainant asserts that its brand name is "Friday-Ad". It describes itself as "*a classified ad business in the UK and we are strongest in the south-east, predominantly Brighton and surrounding areas*".
- 5.3 As regards abuse of registration, the Complainant asserts that the Respondent is using the Domain Name for "*the sole purpose of fraudulently obtaining money from website users via premium rate telephone numbers*".
- 5.4 It asserts also that the Respondent has deliberately sought to copy the look and feel of the Complainant's website, and has copied classified ads from the Complainant's website and reproduced them on its website, in order to enhance its authenticity.

- 5.5 The Complainant asserts that the Respondent is perpetrating a "scam" on internet users who seek to respond to a classified advertisement and then have to use a premium telephone number to do so. It says it has reported the matter to the police and also to Google.

Response

- 5.6 The Respondent asserts that it is operating *"a free ads website deliver[ing] its users a free ads service"*. It says that it has *"no intention to imply any sort of connection with the Complainant's website/company"*. It says it is not operating the website as a business, *"rather the website is intended to run as a pilot project"*.
- 5.7 The Respondent says that it is willing to change some of the graphics to allay the concerns of the Complainant. It also denies having any intention to commit fraud.
- 5.8 The Respondent says that those posting ads on its website also place the same ads on other websites. The Respondent denies that the telephone numbers on its website are premium numbers and asserts that *"we are not making any money on them"*. It says that *"The numbers displayed on fridayadbrighton.co.uk are the numbers taken from third party website."*
- 5.9 The Respondent refers to content on the website at *www.classifieds.co.uk* which allocates 070 "privacy numbers" to advertisers to enable them to be contacted without publicising their personal numbers. The implication appears to be that advertisers on the Respondent's website are copying and pasting the content of their advertisements from other websites, and that the 070 numbers are being copied over by the advertisers themselves when posting ads on the Respondent's website.
- 5.10 Again, no evidence of any of the above is provided.

Reply

- 5.11 The Complainant's Reply is rather longer, and rather more cogently argued, than its Complaint. It points out that the Respondent has made changes to its website since the Complainant filed a complaint with Nominet, for example changing the colour of its "place an ad free" button from orange to blue and adding a disclaimer in the following terms: *"Fridayadbrighton.co.uk has no association or affiliation with brand name Friday-Ad and domain name www.friday-ad.co.uk."*
- 5.12 However, the Complainant submits that those amendments *"do not go far enough"*, given the Complainant's rights in the Friday-Ad name.
- 5.13 The Complainant says that it is "100% owned" by Friday Media Group Limited, which owns a Community Trade Mark in FRIDAY-AD which was registered on 9 October 2006 in Class 35. It asserts that the Respondent's use of that mark in the Domain Name in relation to services identical to that covered by the specification of the CTM amounts to trade mark infringement.
- 5.14 As regards the question of Abusive Registration, the Complainant describes the content of the Reply as *"unsatisfactory and disingenuous"*. It asserts, moreover, that the Respondent is using the Domain Name in a way which confuses or is likely to confuse people or businesses that the Domain Name is registered to, operated by or connected with the Complainant. No evidence is provided in support of that assertion.
- 5.15 The Complainant says that he has traded by reference to the Friday-Ad name since 1975, initially in Sussex and subsequently nationwide. It asserts that by reason of its location,

Brighton has traditionally been an area of market strength and that the Brighton edition is one of its "*strongest editions with 30,000 copies produced each week*".

- 5.16 The Complainant says that the Respondent's choice of the Domain Name is therefore not coincidental. It points out that it owns a number of Friday-Ad domain names, linked to location, such as *fridayadcrawley.co.uk*, *fridayadeastbourne.co.uk*, *fridayadhastings.co.uk*, *fridayaduckfield.co.uk* and *fridayadworthing.co.uk*.
- 5.17 The Complainant asserts that a Google search for the term "Friday-Ad" returned the Complainant as the first result and the Respondent as the second. It refers to evidence of this in an "accompanying schedule", but no such schedule in fact appears to have been filed with Nominet. Indeed, when the Expert carried out the same Google search, the Respondent's website was not on the first page of results, nor on the second or third page.
- 5.18 In any event, the Complainant relies on this assertion to demonstrate the Respondent's reliance on the Friday-Ad name in which it says it has rights. It says that the "*only explanation*" is that the Respondent is seeking "*to confuse users searching for the genuine Friday-Ad website and to unfairly disrupt the Complainant's business*".

6 Discussions and findings

General

- 6.1 To succeed under the Policy, the Complainant must prove on the balance of probabilities, first, that it has Rights (as defined in the Policy) in respect of a name or mark that is identical or similar to the Domain Name (paragraph 2(a)(i) of the Policy), and secondly, that the Domain Name is an Abusive Registration in the hands of the Respondent (paragraph 2(a)(ii) 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."*

Complainant's rights

- 6.3 Paragraph 2(a)(i) of the Policy requires the Complainant to prove that it "*has Rights in respect of a name or mark which is identical or similar to the Domain Name*". "Rights" means "*rights enforceable by the Complainant, whether under English law or otherwise, and may include rights in descriptive terms which have acquired a secondary meaning*".
- 6.4 The Complainant has been frank in conceding that it does not own the FRIDAY-AD CTM. On its own case, that registered trade mark is owned by its parent company and no suggestion is made, let alone evidence adduced, that it has an exclusive licence to use it.
- 6.5 However, the Complainant would be entitled to rely on any common law rights in the Friday-Ad name. While it has, in effect if not expressly, asserted that it has such common law rights,

no evidence whatsoever is provided to demonstrate any such rights, e.g. its use of the Friday-Ad name, evidence of expenditure on promoting the name, and so forth.

- 6.6 Nonetheless, despite this flaw in the Complainant's case, having considered the Complainant's website, it would probably be unconscionable not to find that the Complainant has such common law rights, and accordingly Rights as defined in the Policy, in the Friday-Ad name.
- 6.7 The next question, therefore, is whether the Friday-Ad name is identical or similar to the Domain Name. It is now well established under the DRS that the inclusion of generic or descriptive words, together with a name or mark in which the Complainant has Rights, does not mean that the Domain Name in question is so dissimilar that it falls outside paragraph 2(a)(i). Accordingly, the addition of the geographically descriptive word "Brighton" does not take the Domain Name outside paragraph 2(a)(i).
- 6.8 Accordingly, the Complainant just about squeaks home under paragraph 2(a)(i) of the Policy, notwithstanding its failure to provide any evidence whatsoever.

Evidence of abusive registration

- 6.9 In its Complaint, the Complainant alleges that the Respondent has been using the Domain Name for the purposes of committing a fraud or a scam. This is denied by the Respondent, and that denial is not challenged in the Reply. In those circumstances, and in the absence of any evidence in support of the Complainant's allegation, the Complainant has failed, on the balance of probabilities, to prove such fraud or scam on the part of the Respondent.
- 6.10 As set out at paragraphs 5.15 and 5.19 above, in its Reply the Complainant for the first time contends that the Respondent's use of the Domain Name falls within paragraph 3(a)(i)(C) and/or paragraph 3(a)(ii) of the Policy, i.e. circumstances indicating that the Respondent has registered or otherwise acquired the Domain Name primarily for the purpose of unfairly disrupting the business of the Complainant and/or that the Respondent is using 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.
- 6.11 The complaint is essentially that the Respondent is free-riding on the Complainant's brand name.
- 6.12 The Expert accepts that the registration of the Domain Name is highly unlikely to have been pure coincidence, given that the Respondent's "pilot project" appears to be very similar to the Complainant's business, the Complainant's operations in and around Brighton and in Sussex generally, and also that it has mimicked the structure of other domain names registered by the Complainant relating to other Sussex coastal towns, i.e. *fridayadeastbourne.co.uk*, *fridayadhastings.co.uk* and *fridayadworthing.co.uk*.
- 6.13 While the Complainant has not adduced any direct evidence of confusion or likelihood of confusion, useful guidance in this regard is to be found in the DRS Expert Overview document, in particular in paragraph 3.3, which comments on paragraph 3(a)(ii) of the Policy in the following terms:

"The 'confusion' referred to in this paragraph of the Policy is confusion as to the identity of the person/entity behind the domain name. Will an internet user seeing the domain name or the site to which it is connected believe or be likely to believe that "the domain name is registered to, operated or authorised by, or otherwise connected with the Complainant"?...."

Commonly, internet users will visit websites either by way of search engines or by guessing the relevant URL. If the domain name in dispute is identical to the name of the Complainant and that name cannot sensibly refer to anyone else, there is bound to be a severe risk that a search engine, which is being asked for the Complainant, will produce high up on its list the URL for the website connected to the domain name in issue. Similarly, there is bound to be a severe risk that an internet user guessing the URL for the complainant's website will use the domain name for that purpose.

In such cases, the speculative visitor to the registrant's website will be visiting it in the hope and expectation that the website is a website "operated or authorised by, or otherwise connected with the complainant." This is what is known as 'initial interest confusion' and the overwhelming majority of Experts view it as a possible basis for a finding of Abusive Registration, the vice being that even if it is immediately apparent to the visitor to the website that the site is not in any way connected with the Complainant, the visitor has been deceived. Having drawn the visitor to the site, the visitor may well be faced with ... a commercial website, which may or may not advertise goods or services similar to those produced by the complainant. Either way, the visitor will have been sucked in/deceived by the domain name.

Findings of Abusive Registration in this context are most likely to be made where the domain name in issue is identical to the name or mark of the Complainant and without any adornment ... The activities of typosquatters are generally condemned ... as are those people who attach as appendages to the Complainant's name or mark a word appropriate to the Complainant's field of activity. See for example the Appeal decision in DRS 00248 (Seiko-shop.co.uk)."

- 6.14 The addition of the word Brighton to the Complainant's brand name is in this regard no different, notwithstanding that it is a geographic descriptor rather than a field of activity. The Respondent's use and registration of the Domain Name has enabled it to exploit the trading goodwill and business reputation of the Complainant for its own financial benefit.
- 6.15 Accordingly, for the reasons set out above, the Expert is satisfied, on the balance of probabilities, that the Domain Name was registered and/or has been used in a manner which took unfair advantage of the Complainant's Rights in the Mark and/or was unfairly detrimental to those rights.

7 Decision

- 7.1 The Expert finds that the Complainant has Rights in a name or mark which is identical or similar to the Domain Name and that the Domain Name, in the hands of the Respondent, is an Abusive Registration.
- 7.2 It is therefore determined that the Domain Name be transferred to the Complainant.

Signed: **David Engel**

Dated 6 November 2012