

## DISPUTE RESOLUTION SERVICE

*D00011946*

### Decision of Independent Expert

**Gillian Powell**

and

**Damian Crabtree**

#### **1. The Parties:**

- 1.1 The Complainant is Gillian Powell of Ross-On-Wye, Herefordshire, United Kingdom.
- 1.2 The Respondent is Mr Damian Crabtree of Wilmslow, Cheshire, United Kingdom

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

- 2.1 The domain name in dispute is <wyevalleyproperties.co.uk> (the “Domain Name”)

#### **3. Procedural History:**

- 3.1 The procedural timeline in this case is as follows:

24 September 2012 13:21 Dispute received  
25 September 2012 09:46 Complaint validated  
25 September 2012 09:47 Notification of complaint sent to parties  
12 October 2012 02:30 Response reminder sent  
16 October 2012 17:28 Response received  
16 October 2012 17:29 Notification of response sent to parties  
19 October 2012 02:30 Reply reminder sent  
22 October 2012 15:00 Reply received  
22 October 2012 15:01 Notification of reply sent to parties  
22 October 2012 15:02 Mediator appointed  
25 October 2012 09:30 Mediation started

29 October 2012 13:51 Mediation failed  
29 October 2012 13:53 Close of mediation documents sent  
08 November 2012 01:30 Complainant full fee reminder sent  
12 November 2012 11:29 Expert decision payment received

- 3.2 I was appointed as Independent Expert on 16 November 2012 and have confirmed to Nominet that I am independent of the parties and know 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 is an individual who operates an online estate agency. Her website operates from the domain name <wyevalleyproperties.com> and the business would appear to have been founded in or around 2007.
- 4.2 In or about 2010 the Complainant entered into some sort of business relationship with the Respondent. The exact nature of that relationship is unclear (although in the words of the Respondent he was “hired” by the Complainant to “develop her business”). However, it seems clear that for whatever reason that relationship did not work out and the business relationship came to a relatively rapid end.
- 4.3 The Domain Name was registered by the Respondent in October 2011. When exactly a website started to operate from the Domain Name is unclear. However, a website with some form of property related content seems to have been operating from the Domain Name at least from the date that the Complaint was filed herein.
- 4.4 As at the date of this decision the website operating from the Domain Name displays a few paragraphs of text giving (somewhat anodyne) information about the Wye Valley area, and the ability to perform a property search through Zoopla. A page on the website also provides a list of estate agents in that area.
- 4.5 Who is behind the website operating from the Domain Name is not clear from the site itself. The name of the Respondent is not disclosed, and no email address is provided. But there is a contact page that hosts a web form if anyone has a “query or require[s] assistance or would like to advertise on the site”.

#### **5. Parties’ Contentions**

- 5.1 The parties’ contentions cover a large number of issues, and include complaints and assertions about issues that are not particularly relevant to this dispute. What follows is a summary of what appears to be the most relevant of the parties’ contentions.

## The Complaint

- 5.2 The Complainant contends that her business is called “www.wyevalleyproperties.com”. The scale of that business is not disclosed, although she asserts that since the business was founded in 2007 it has built up “a great rapport with [its] clients”. She asserts that she has advertised on the radio and in the press and has used leaflet drops, but the scale of that advertising is not disclosed.
- 5.3 The Complainant also annexes to the Complaint the following:
- (i) a photograph of an estate agent’s FOR SALE sign that incorporates a device being a stylised combination of the letters WVP (the “WVP” device), and the words “Wye Valley Properties”;
  - (ii) photographs of a Smart car decorated in various places with the WVP device and which refers to “WYEVALLEYPROPERTIES.COM” ;
  - (iii) three PowerPoint files each of which when opened show details of properties for sale under the WLP device and the “WYEVALLEYPROPERTY.COM” name in the following form:



Exactly what these files are is not explained, but the file names (i.e. 379772-BEACON 3RD FEB 07”, “379773-BEACON 2nd NOV 08” and “379774-gazette 8th feb 07”) suggest that these are copies of press advertisements.

- 5.4 The Complainant refers to her past dealings with the Respondent. She claims that the Respondent bought the Domain Name at a time that discussions were taking place as to the Respondent’s possible purchase of the Complainant’s business. She reproduces in her Complaint emails recording those discussions in April 2012.
- 5.5 The Complainant claims that the Respondent has used the Domain Name for a website that is “asking for contact for free valuations etc” and offering “exactly the same type of service” as her own. However, copies of the website are not provided.
- 5.6 She alleges that the Respondent’s website is “capitalizing on [her] established name” and is attempting to “steal [her] clients and [her] reputation locally”

## The Response

- 5.7 The Respondent makes the point that the Complainant trades as “WYEVALLEYPROPERTIES.COM” and not “Wye Valley Properties”.

- 5.8 The Respondent denies that he purchased the Domain Name at the time there were discussions in relation to purchase of the Complainant's business. He contends that the Domain Name was purchased in October 2011, long before those discussions took place.
- 5.9 The Respondent states that when he registered the Domain Name, it was "available for sale on the open market" and that the Complainant had shown no interest in it prior to his registration. He claims it was "purchased to offer goods or services in fair use without any suggestion that there was any connection with the Complainant's business". He further contends that the Domain Name "is generic and specifically descriptive to the offering of the [Respondent's] website as it is a location based business". He claims that the phrases "Wye Valley Properties" and "Wye Valley Property" both attract about 480 searches per month on Google as generic search terms and that these are not "business specific searches".
- 5.10 The Respondent denies that his website operating from the Domain Name has caused, or could cause, any damage to the Complainant's business. He denies that he has ever traded as an estate agent or used the Domain Name for a competing estate agency. Instead, he characterises his use of the Domain Name as for a "marketing portal for sales and lettings only".
- 5.11 He further contends that not all the properties available for sale by the Complainant on her website are in the Wye Valley Area and claims that this means that his Domain Name "could not ... have a significant impact on the [C]omplainant's business".
- 5.12 The Respondent refers to and relies upon a statement on the Complainant's own website that is said to record that in 2011 the website received 38,253 visits. This, it is said, should be contrasted with 154 unique visits to the Respondent's website. The number of visitors is said to show that that "it would be impossible [for the website operating from the Domain Name] to have detrimentally impacted on [the Complainant's] business in any way".
- 5.13 The Respondent also systematically goes through the factors that may be evidence of abusive registration or use as set down in paragraph 3 of the Nominet DRS. So far as paragraph 3(a)(ii) is concerned, the Respondent denies there even could be any confusion. He claims that his website when the claim was raised "was in development and none of the pages were finished and most of the content was from a template that was being re-written". So far as the other factors are concerned, the Respondent claims that the Complainant has offered no evidence that would suggest they apply.
- 5.14 Finally, the Respondent makes reference to websites operating from the domain names <cotswold-properties.co.uk> and <cotswold-properties.com>. These are said to co-exist with one being used by an estate agent, and the other being used as a "resource or advertising portal".

### The Reply

- 5.15 Although a Reply was filed by the Complainant, it for the most part repeats what was alleged in response or addresses issues that are not particularly probative to the issues to be decided in these proceedings.
- 5.16 However, the Complainant claims that the current form of the website operating from the Domain Name has changed “fractionally” from that operating at the time these proceedings were commenced by uploading further pages. She also observes that this website now includes a page that list estate agents for the Wye Valley area but that this “ironically excludes” the Complainant.

## **6. Discussions and Findings**

### General

- 6.1 To succeed under the Policy, the Complainant must prove first, that she 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."*

### Complainant's Rights

- 6.3 The way that the Complaint is compiled suggests that it has not been prepared by someone who is legally qualified or familiar with the Policy. One way in which this manifests itself is that there is no express statement in the Complaint as to the rights upon which the Complainant relies.
- 6.4 Instead, the Complainant refers solely to her trading activities and the name of her business. Therefore, insofar as rights under the Policy are concerned, this appears to be a case where the Complainant claims unregistered rights in its business name, under the English law of passing off.

- 6.5 It has long been the case that “unregistered trade mark rights” under the English law of passing off provide sufficient rights for the purposes of the Policy. However, a claim based upon these sorts of rights is not as straight forward as one based upon a registered right.
- 6.6 The reason for this is that in the case of a registered trade mark, whether the right exists is an objective fact that can be very simply verified by a review of the relevant register. The question of whether there is infringement of that right is then logically distinct.
- 6.7 The law of passing off works somewhat differently. It is frequently said that goodwill in a name or term which is used in a business can provide an “unregistered trade mark”. But the concept of a distinct self-contained right is less meaningful. The question under the law of passing off is whether in a particular set of circumstances particular acts constitute an infringement.
- 6.8 For example, it is often said that for an unregistered mark to be protected under the law of passing off, it must be distinctive of the trade source of the goods. But the question of distinctiveness is one of degree. Marks of low inherent distinctiveness may be protected against precise copying but not against slight variation. The frequently cited case in this regard is *Office Cleaning Services v Westminster Window and General Cleaners* [1946] 63 RPC 39 in which the plaintiff claimed rights in the term “Office Cleaning Services”. The use of that exact name for a cleaning business might have involved passing off, but minor variations in that name were sufficient to defeat a claim in passing off.
- 6.9 However, the Policy requires the question of rights to be assessed in isolation and without consideration of whether the Respondent’s acts are infringing. Does this mean that what are only very limited “rights” under the law of passing off (and which would only justify an infringement claim in a very limited range of circumstances) could be said to provide sufficient rights for the purposes of the Policy regardless of whether those acts are infringing?
- 6.9 It has been said in various cases under the Policy, and paragraph 2.3 of the Dispute Resolution Service Experts’ Overview (the “Overview”) records, that the first limb of the Policy is intended to set a relatively low level threshold test. Given this, in my opinion, a limited “right” for the purpose of the Policy may well exist in respect of a relatively generic term. That is not to say that the generic nature of the term is irrelevant to the outcome of the case. It may be highly relevant to the assessment of abuse under the second limb of the Policy. It is simply that it need not be an absolute bar to the existence of rights under the first limb of the Policy.
- 6.10 Nevertheless, the fact that it is a low level test, does not absolve a complainant from providing evidence to support that claim and as a matter of common sense the more generic the term in which rights are claimed,

the more compelling that evidence should be. As is recorded in paragraph 2.2 of the Overview:

“If the right is an unregistered trade mark right, evidence needs to be put before the Expert to demonstrate the existence of the right. This will ordinarily include evidence to show that (a) the Complainant has used the name or mark in question for a not insignificant period and to a not insignificant degree (e.g. by way of sales figures, company accounts etc) and (b) the name or mark in question is recognised by the purchasing trade/public as indicating the goods or services of the Complainant (e.g. by way of advertisements and advertising and promotional expenditure, correspondence/orders/invoices from third parties and third party editorial matter such as press cuttings and search engine results).”

- 6.11 With this in mind, I turn to the specific question of rights in this case. The first question is in what term the Complainant actually claims rights. One possibility is that the name relied upon is simply the term “Wye Valley Properties”. But this term is in large part descriptive of the properties that the Complainant deals in as an estate agent. Further although the term seems to have appeared on at least some FOR SALE signs, the extent and timing of that use is unclear. I am therefore not convinced that there are any substantive rights in this term alone. This is so notwithstanding the assertion by the Respondent that some of the properties in respect of which the Complainant offers estate agency services are outside the Wye Valley area.
- 6.12 In any event, the Claimant does not claim that her business is known as “Wye Valley Properties”. Instead she refers to it as “www.wyevalleyproperties.com”. It seems likely she actually means is “wyevalleyproperties.com”. This is the term that appears on her website and certain marketing materials. Indeed, the Respondent understands this to be the case as is apparent from the statement in his Response that the Complainant “[t]rades as wyevalleyproperties.com in their advertising not Wye Valley Properties”.
- 6.13 Although the level of activity under that name is not disclosed (the Complainant gives no description of size of the business or the extent of her advertising is not disclosed), there appears to be no real dispute that the Claimant’s business has operated under that name for approximately 5 years. Further, the Respondent’s appears to accept that there has been advertising under that name and his own evidence is that the level of traffic to the Complainant’s website in the last year has amounted to 38,253 visits. Ultimately, this is sufficient material for me to conclude that the Claimant has rights in the term “wyevalleyproperties.com” for the purposes of the Policy.
- 6.14 Once rights are established a Complainant must show that the mark or name in which it has rights is similar to the domain name said to be abusive. Here it might well be argued that the only common feature that exists between the relevant mark and the Domain Name is the letter string

“wevalleyproperties”. As the natural way in which that string would be read is as the words “Wye Valley Properties” and given that (for reasons I have already explained) the Complainant has not shown or claimed any rights in those words, these words (so the argument goes) should be disregarded for the purposes of the similarity assessment.

- 6.15 However, I do not think this is correct. The name of the Claimant’s business would clearly be read as a domain name, and as a domain name that except for the “.co.uk” and “.com” suffixes are identical. Further, there is some similarity between the “.co.uk” and “.com” suffixes. They share two of the same letters and it is not uncommon for internet users to confuse equivalent “.co.uk” and “.com” domain names.
- 6.16 In the circumstances, and in light of the low threshold test that is usually applied to the question of similarity (as to which see once again paragraph 2.3 of the Dispute Resolution Service – Experts’ Overview), I find that there is similarity between the mark used by the Complainant and the Domain Name and that the Claimant has made out the requirements of the first limb of the Policy.

#### Abusive Registration

- 6.17 At its heart the dispute in this case can be very simply put. The Complainant maintains that the Respondent chose and is using the Domain Name to take unfair advantage of the association of the Domain Name with her business. The Respondent denies this, claiming that he is engaged in a fair use of the Domain Name taking advantage of its purely descriptive content.
- 6.18 Given the past business dealings of the parties, it is clear that the Domain Name was registered by the Respondent with knowledge of the Complainant’s business. But knowledge alone on the part of a respondent is insufficient for success under the Policy. It will usually also be necessary for a complainant to show some intent to take advantage of the complainant’s rights.
- 6.19 Some experts have suggested that there can be abusive registration or use without that the need to show subjective intent if the registrant is objectively assessed to have taken significant advantage of the confusion that has arisen as a result of the choice of domain name. The issue is explored in some detail in paragraph 2.4 of the Overview. However, I am personally sceptical as to whether abuse can be found without subjective intent. Certainly in a case such as this I believe intent is essential if there is to be a finding of abuse.
- 6.20 If the question is one of intent, many of the submissions of the Respondent in this case are of limited relevance or assistance. For example, it may well be that equivalent “.co.uk” and “.com” domain names can to some degree “co-exist”, but if the reality is that one was registered and is being used to take advantage of trade mark in the other, then the registration is likely to be abusive.



- 6.21 Similarly, the Respondent claims that it has only attracted 154 unique visits to his website (in contrast to 38,253 visits to the Complainant's site) is interesting but not determinative. The existence of, or lack of, confusion may well provide evidence of why a domain name was registered, but ultimately it is no more than that. If a domain name was registered with the intent of taking advantage of the rights of others, it is no answer to say that in practice the advantage gained is limited.
- 6.22 There are also factors that are suggestive of abusive intent in this case. First, there is the fact that on the Respondent's own case it took him a year from registration to complete the website operating from that Domain Name, and what appears to have spurred him into doing this was the commencement of these proceedings. This raises a question as to how genuine is the Respondent's claim to have registered the Domain Name to trade off of its descriptive meaning.
- 6.23 Second, and perhaps more persuasive is the fact that there is now a list of estate agents on the Respondent's website and that list does not include the Complainant. That exclusion looks petty and does not present the Respondent in the best of lights. But more significantly, the inclusion of the estate agent's list makes it clear that the Respondent's assertion that he has not used the Domain Name for a competing estate agency is simply wrong. Of course, what the Respondent means by this assertion is that he has not used the Domain Name for a competing estate agency in which he is directly involved. Nevertheless, he has clearly been using the Domain Name to promote estate agency services which he obviously knows compete with those of the Complainant.
- 6.24 But none of these factors are overwhelmingly compelling. First, there was some sort of property related website in place prior to the issue of the Complaint. In short, this is not a case where on the evidence before me I can disregard the existence of the site as a mere a sham. Second, there is no evidence before me that the Domain Name has been used at any time for a purpose unrelated to the descriptive meaning of the term "Wye Valley Properties". Although the Respondent is promoting estate agents that compete with the Complainant, nevertheless as far as I am aware these are competing "Wye Valley properties" related services.
- 6.25 Further, there is little in the timing of the registration that would suggest opportunistic registration with the Complainant's business specifically in mind. If the Domain Name had been registered either during the parties' relationship or immediately after it came to an end, or had been registered during negotiations as to the purchase of the Complainant's business, that would be highly suspicious. But the Domain Name was registered at least a year after that relationship had come to an end, and sometime before there was any negotiation as to sale.
- 6.26 This has been a finally balanced case that I have not found easy to decide. But ultimately it is the Complainant that bears the burden of proof of establishing that the Domain Name was registered or used in an abusive

manner. Given the descriptive nature of the Domain Name the Complainant has not borne that burden in this case.

- 6.27 In the circumstances, the Complainant has not made out the second requirement of the Policy.
- 6.28 Obviously, if the contents of the website were to change so as to suggest that the Domain Name was not being used solely because of its descriptive meaning but in order to trade off the reputation of the Complainant's business, that would change matters somewhat. The change in use might constitute a "material difference that justifies a rehearing" within the meaning of paragraph 10(f) of the Policy.

## **7. Decision**

- 7.1 I find that the Complainant has Rights in a trade mark, which is similar to the Domain Name, but that the Domain Name, in the hands of the Respondent, is not an Abusive Registration.
- 7.2 I, therefore, determine that there be no action on the Complaint.

**Signed Matthew Harris**

**Dated 27<sup>th</sup> November 2012**