

**DISPUTE RESOLUTION SERVICE**

**D00012867**

**Decision of Appeal Panel**

**Schools Sports Ltd**

and

**School Website Limited**

**1. The Parties:**

Complainant: Schools Sports Ltd

Registered Office  
53 Water Street  
Birmingham  
West Midlands  
B3 1EP  
United Kingdom

Respondent: School Website Limited

Rowan House  
Field Lane  
Teddington  
Middlesex  
TW11 9BP  
United Kingdom

In this decision the nomenclature of the Expert's decision at first instance will be maintained with the Appellant being referred to as "the Respondent".

## 2. The Domain Name:

<schoolsport.co.uk>

## 3. Procedural History

### First Instance

The Complaint was first received by Nominet on 28 May 2013 and notified to the Respondent. The Respondent's Response was received and notified to the Complainant on 31 May 2013. The Complainant's Reply was received and notified to the Respondent on 5 June 2013. Mediation ensued but failed to result in settlement of the dispute. The Complainant having paid the appropriate fee, on 5 July 2013 the Expert was appointed to provide a full decision. The decision was issued by the Expert and sent to the parties by Nominet on 25 July 2013. The Expert found in favour of the Complainant and directed that the Domain Name be transferred to the Complainant.

### Respondent's Appeal

Nominet received the Respondent's Appeal Notice and notified the Complainant on 3 September 2013. The Complainant's Appeal Response was received by Nominet and notified to the Respondent on 16 September 2013.

On 20 September 2013 David King, Nick Gardner and Phil Roberts (the undersigned, "the Panel") were appointed to the Appeal Panel, each having individually confirmed to the Nominet Dispute Resolution Service that:

*"I am independent of each of the parties. To the best of my knowledge and belief, there are no facts or circumstances, past or present, or that could arise in the foreseeable future, that need be disclosed as they might be of such a nature as to call in to question my independence in the eyes of one or both of the parties."*

This is an Appeal against a Decision at first instance in favour of the Complainant. The Panel was appointed to provide a decision on or before 1 November 2013. This process is governed by version 3 of the *Procedure for the conduct of proceedings under the Dispute Resolution Service* ("the Procedure") and the Decision is made in accordance with version 3 of the *Dispute Resolution Service Policy* ("the Policy"). Both of these documents are available for inspection on the Nominet website (<http://www.nominet.org.uk/disputes/drs>).

#### **4. The Nature of This Appeal**

Article 10a of the Policy provides that: *“the appeal panel will consider appeals on the basis of a full review of the matter and may review procedural matters”*.

The Panel concludes that insofar as an appeal involves matters other than purely procedural complaints the appeal should proceed as a re-determination on the merits.

In addition to the decision under appeal, the Panel has read the Complaint (with attachments), the Response, the Reply, the Appeal Notice and the Appeal Response.

#### **5. Formal and Procedural Issues**

There is one procedural issue which the Panel must consider. In its Appeal Response the Complainant has provided further evidence in support of its position.

Article 18c of the Procedure stipulates that an Appeal Notice should set out detailed grounds and reasons for the appeal but should contain no new evidence or annexes. Similarly Article 18f of the Procedure stipulates that an Appeal Response should set out detailed grounds and reasons why the appeal should be rejected but should contain no new evidence or annexes.

Article 18h of the Procedure provides that the Appeal Panel should not normally take into consideration any new evidence presented by the parties, unless the Panel believes that it is in the interest of justice to do so.

The Panel is unpersuaded that it is in the interests of justice to take the late evidence into consideration. In this case it is the view of the Panel that the Complainant could have and should have provided any further evidence it wished to have considered when it submitted its Complaint to Nominet. Further the Panel is satisfied that (for the reasons set out in section 8 below) the Complaint should be upheld without taking the further evidence into account and therefore it would not have had any material impact on the outcome of this Appeal in any event.

#### **6. The Facts**

The facts in this case were set out in detail in the Expert’s decision of 25 July 2013 and can be summarised as follows.

The Complainant designs and builds online sports fixtures management systems for schools in the UK and operates from its main website [www.schoolssports.com](http://www.schoolssports.com). The Complainant was incorporated in 2006 although its business was carried on before then by its predecessors in title, the business having been originally commenced in 1998. The domain nameschoolssports.com was registered (presumably by the Complainant’s predecessors in title) on 25 February 2001. On the same date the Complainant also registered four other domains incorporating

the term “schoolssports” which all redirect to the main website.

The Respondent is associated with a company called Sitewrights Limited. Sitewrights Limited was incorporated in 2004 and has traded via a number of websites including [www.schoolwebsite.co.uk](http://www.schoolwebsite.co.uk); [www.schoolwebsite.com](http://www.schoolwebsite.com); [www.schoolprospectus.co.uk](http://www.schoolprospectus.co.uk); [www.schoolconsulting.co.uk](http://www.schoolconsulting.co.uk); and [www.schooleditions.co.uk](http://www.schooleditions.co.uk). Its business appears to have originally concerned the development of websites for schools and then expanded into other related areas such as the development of prospectuses, branding, newsletters and so on. It would appear that in September 2012 Sitewrights Limited decided to expand or diversify its business further into the area of online sports fixtures services for schools and it did so via an associated company - the Respondent. In these proceedings both the Complainant and the Respondent have treated Sitewrights Limited and the Respondent as being in effect all part of the same business and the Panel proposes to do the same. The Respondent had been incorporated in 2008 and registered the Domain Name on 16 May 2009. In September 2012 it commenced offering online sports fixtures management services for schools at the website associated with the Domain Name, [www.schoolsport.co.uk](http://www.schoolsport.co.uk). The Complainant became aware of this at some stage in early 2013 and, on 20 May 2013, it sent an email to the Respondent asserting substantial goodwill and reputation in the name “Schools Sports Ltd” and expressing concern that the Respondent’s use of the name [schoolsport.co.uk](http://www.schoolsport.co.uk) was likely to cause confusion. It said this was passing off and asked the Respondent to cease trading as [schoolsport.co.uk](http://www.schoolsport.co.uk).

The Respondent replied on the same day stating “...that we are not trading under ‘schoolsport.co.uk’, and I am not exactly sure how one would be able to trade under a website address in the first instance regardless. Our trading company is SiteWrights Ltd, which has many products associated with it, one of which is a school sports application.....” It went on to say that its product solved the same problems for schools as the Complainant’s product which is actually called “FixturesPro” but that there were substantial differences between the products dating back to a first version more than five years ago. The Respondent said that the Domain Name was purely descriptive of its services, that the website bore no resemblance to the Complainant’s website and that its product was only available to its existing customer base.

The Complainant reasserted its complaint in an email to the Respondent on 21 May 2013 but received no reply. The Complainant then submitted its Complaint to Nominet on 28 May 2013.

## **7. The Parties’ Contentions**

### The Complaint

In its Complaint the Complainant said that it was established in 1998 and

incorporated in 2006 (the Panel infers the Complainant's business was run by an unincorporated predecessor in title before the Complainant came into existence). The Complainant said that throughout this period it had designed and built online sports management systems for hundreds of schools using, since 2001, the trading style [www.schoolssports.com](http://www.schoolssports.com) which was its main website. It had registered domain names incorporating the name "schoolssports" at four other websites which all redirected to the main website.

The Complainant asserted that in 2012 it received 13 million page views and 550,000 unique visitors. It claimed to be recognised by several national governing bodies and organisations and that it had featured in various newspapers and magazines and other national media outlets. As a result the Complainant said it had built a significant reputation and goodwill amongst organisations and state and independent schools in the UK in relation to the design and provision of online sports management systems and solutions. None of this evidence was challenged by the Respondent in its Response (see further below).

The Complainant said that it became aware at the beginning of May 2013 that the Respondent (or Sitewrights Limited) was offering similar online sports management systems services. The Complainant established that these services were being offered under the name "School Sport" or "School Sports" using the Domain Name and the website [www.schoolsport.com](http://www.schoolsport.com) which directed to the Respondent's (or Sitewright Limited's) main website [www.schoolwebsite.co.uk](http://www.schoolwebsite.co.uk); that, whilst not identical to the Complainant's, the website at the Domain Name would give anyone the impression that they have landed on the "Schools Sports" website by the use of two capital SSs in the logo, similar terminology and schools sports images and that there was no reference to School Website Limited or Sitewrights Limited on the home page.

The Complainant said it appreciated that it might not be able to prevent the marketing of a product called "School Sports" or "School Sport" but that the close alignment and marketing of the product by means of the website at the Domain Name was its main concern and the reason for lodging the Complaint.

Screen shots of the [www.schoolsport.co.uk](http://www.schoolsport.co.uk) website were provided. The home page had no reference to the Respondent or Sitewrights Limited which the Complainant believed was causing confusion. It said that, on the login screen, there was reference to School Website in the footer but, despite this, it had received several reports that month where the Complainant's users had accidentally tried to login at the Respondent's website (no further evidence of this was provided). The Complainant pointed out that the "learn more" page depicted the crests of several schools including two who were clients of the Complainant; it said that at worst this was illegal and at best illustrated the confusion being caused.

The Complainant said use of the name "School Sports" or "School Sport" by means of the Domain Name website was causing confusion in the minds of the public and was likely to cause substantial damage to the Complainant's reputation.

The Complainant referred to its email of 20 May 2013 to the Respondent and requested transfer of the Domain Name.

### The Response

The Respondent said that Sitewrights Limited was incorporated in November 2004 and has traded as “Schoolwebsite” for over eight years during which time it has created websites for over 1,000 schools ranging from local primary schools to some of the top private schools in the UK, Europe and the Middle East. It said its range of products has expanded to offer different services (e.g. “schoolprospectus”), which it has marketed using different domain names all incorporating the word “school” including the Domain Name.

The Respondent questioned why, if the Complainant was concerned that use of the name “schoolsport” by another company might cause confusion, it did not register the Domain Name when it had the opportunity to do so. It said the Complainant’s actual product was called “FixturePro”, that this was clear from the Complainant’s website and that the Respondent had no products that remotely resembled the name of the Complainant’s product.

The Respondent denied that the Domain Name website resembles the Complainant’s website and pointed out differences in the logos being used. It said it would be difficult not to use the same terminology when describing a similar product. The product was currently being offered to existing clients as an additional service and it was therefore unnecessary to refer to the fact that the Respondent was the same trading entity as Sitewrights Limited. However, it said this would be made clear when it marketed to new customers who might choose to use the product as stand-alone service.

As regards the two school crests referred to in the Complaint, the Respondent said it had acted legitimately and with the full knowledge of both clients.

Its various product names including the word “school” were distinct trading names clearly describing the products offered and were not intended to threaten or take away from what the Respondent referred to as “*the substantial goodwill and reputation of SchoolsSports*”. The Respondent’s brand was well known and the Respondent wanted to build on its own name and reputation. It was not its intention to cause confusion but to carve out its own niche by offering superior products and services and it was sure that “*SchoolsSports will be continuing to do same for their customers*”.

### Reply

The Complainant took issue with a product called “School Sport” or “School Sports” branded with two SSs and where the name was almost identical to its registered mark and the name of its company and being marketed via a website similar to its

own. It said it understood that it might not be able to prevent the Respondent or Sitewrights Limited marketing the product via its main website if it used a different name and different trade mark to the two SSs. Having a branded theme of several website names did not give the Respondent automatic rights to have a domain name that so closely matched the Complainant's.

The Respondent's other websites were clearly branded as part of the overall collection of "School Website" products but, in the case of the Domain Name, there was no association with the Respondent or Sitewrights Limited on the home or learn more pages when the Complaint was made. The home page had since been changed but the very existence of the Domain Name was sufficient to cause confusion.

The Complainant pointed out that Respondent has acknowledged "*the substantial goodwill and reputation of SchoolsSports*" and must have been aware of the Complainant and its operation when it launched its product via the Domain Name as recently as September 2012. This reinforced the Complainant's view that the Respondent was passing off and causing confusion.

The Complainant claimed that the Respondent was marketing the website as an additional service to its existing clients, and that this indicated that it intended to market its product to many of the Complainant's existing clients. The Respondent's intention to use the Domain Name to market to new customers would only exacerbate the situation and increase the confusion which already existed. It would increase the instances of customers logging in accidentally to the wrong website and would damage the Complainant's reputation and goodwill further.

### Appeal Notice

The Appeal Notice was filed by solicitors on behalf of the Respondent who had not acted in relation to the original Response. The submissions made in the Appeal Notice can be summarised as follows:

The Complaint failed to identify precisely what Rights were being asserted and it was wrongly assumed that Rights were claimed in one or more of the following words/phrases ("Word Marks") : SCHOOL SPORTS; SCHOOLSPO RTS; SCHOOLS SPORTS; SCHOOLSPO RTS.

The Complainant claimed significant reputation and goodwill but did not specify any particular distinctive indicia or badges of goodwill by which its goodwill/reputation could be recognised/distinguished in the marketplace. It is clear from the Complaint and the Reply that the Complainant did not believe or allege that it could prohibit use of any of the Word Marks alone.

The Word Marks lack distinctive character being highly descriptive of the parties' services. In reality the Complainant's goodwill is no doubt

distinguished/recognised not by the Word Mark alone but by a combination of multiple indicia including its general overall get-up. No such indicia were identified in the Complaint or alleged to be similar to the Domain Name.

It was wrong to conclude that the Respondent admitted the existence of Rights in any mark(s) similar to the Domain Name. The existence of Rights (as opposed to mere goodwill/reputation) was contested. The crucial question was not whether goodwill/reputation existed but whether any mark/sign similar to the Domain Name was claimed as a distinctive distinguishing feature such that the use of the Domain Name would inevitably involve significant likelihood of deception. No such allegation was made by the Complainant or admitted by the Respondent.

As regards the burden of proof (on the balance of probabilities) in establishing Rights, the Expert's Overview correctly suggests that bare assertions should rarely suffice and recognises that some allegations (such as that a highly descriptive name has achieved secondary meaning) are inherently less probable than others and require considerable and convincing evidence to establish. There was no supporting evidence at all (let alone "convincing evidence") and the existence of relevant Rights was upheld on the mistaken basis that the Respondent had admitted them when it had not.

As regards Abusive Registration, insufficient account was taken of the descriptiveness of the assumed Rights. In such a case the evidence of abusiveness must be "*very persuasive*".

The key factors in the Expert's finding appeared to be (a) the similarity between the assumed Rights and the Domain Name, (b) the Respondent's prior knowledge of the Complainant, (c) the Respondent's modification of its website following the Complaint and (d) the assumed likelihood of "initial interest confusion".

Insufficient weight was placed upon the descriptiveness/non-distinctiveness of the assumed Rights, particularly in relation to the finding of the likelihood of "initial interest confusion". That doctrine presupposes use by the defendant of a sign *distinctive* of the claimant; otherwise use of a pure descriptor ("soap" for soap) could be alleged to be actionable initial interest confusion which must be wrong.

The modification of the website was wrongly assumed to be evidence of abusiveness when it was actually evidence of the desire to minimise any possibility of confusion.

### Appeal Response

In its Response the Complainant has sought to introduce further submissions and evidence in support of its position. This comprises links to recent press articles, a link to competitions and sporting events the Complainant supports, an allegation that it has received communications recently regarding confusion, reference to a new mobile site launched by the Respondent with a screenshot of the site and an



email sent by the Respondent to the Complainant on 17 August 2011. For the reasons set out by the Panel in section 5 above the Panel has not taken these submissions or evidence into account and will not make any further reference to them in its summary of the Appeal Response below or later in this Decision.

The Complainant refers to the definition of Rights in the Policy, in particular that Rights "*may* (Complainant's emphasis) *include rights in descriptive terms which have acquired a secondary meaning*".

It says it has enforceable rights under English Law being an action for "passing off" the principle of which is to prevent misrepresentation in the course of trade with the public. It asserts that it has the requisite requirements identified in **Reckitt and Coleman Products Ltd v Borden Inc [1990] 1 All ER 873** being goodwill, misrepresentation and damage (or likely damage) to the Complainant's goodwill or reputation.

The reputation and goodwill of the Complainant is a collective of individual elements including name, "SSs", client database and number of years trading.

It received 13 million page views with 550,000 unique visitors in 2012. The evidence to support this is commercially sensitive and the reason why it was not disclosed.

While the Respondent is now denying that it admitted the existence of the Rights claimed by the Complainant, the Complainant points out that the Respondent had expressly acknowledged in the Response the existence of "*an enviable client base and reputation for many years*" and that it was "*not intending to threaten or take away the substantial goodwill and reputation of the Complainant*". These statements were a clear acceptance that the Complainant has "*substantial goodwill and reputation*".

In the absence of sufficient evidence by either party it was correct to conclude on the balance of probabilities that the Complainant has established relevant Rights. With further reference to the burden of proof the Complainant repeats the quotes in the preceding paragraph which were a key consideration in establishing its Rights.

As regards Abusive Registration, the Respondent uses the Domain Name in a manner that leads to confusion of the Complainant's clients and their employees. Potential clients or interested parties are unlikely to write out in full the entire address of the Complainant's website and will ultimately remember "schools sport". This increases the probability that any interested party will arrive unwittingly at the Respondent's website believing it to be that of the Complainant.

In support of its position, the Complainant refers to the length of time the Respondent has traded under the Domain Name i.e. September 2012. It submits

that the similarity of the relevant Rights and the Domain Name are comparable. It does not concur with the Respondent's submission regarding the modification of the website but recognises that the Respondent admits there is likely to be confusion when it refers to the "*desire to minimise any possibility of confusion*".

## 8. Discussion and Findings

### General

To succeed in this Complaint the Complainant has to satisfy the Appeal Panel pursuant to paragraph 2 of the Policy on the balance of probabilities, first, that it has "Rights" (as defined in paragraph 1 of the Policy) in respect of a name or mark identical or similar to the Domain Name and, secondly, that the Domain Name, in the hands of the Respondent, is an "Abusive Registration" (as defined in paragraph 1 of the Policy).

### First Element (Rights)

Paragraph 1 of the Policy requires the Complainant to establish that it "*has Rights in respect of a name or mark which is identical or similar to the Domain Name*"; and defines rights 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*".

Accordingly the first question is whether, on the balance of probabilities, the Complainant has such Rights. In this context the question is whether the Complainant has those rights in the unregistered words "schools sport" either as separate words used next to each other, or in conjoined form. The Panel notes that the Complainant has in its Reply mentioned that its logo is a registered trade mark. The Complainant has provided no further details as to this registered mark, which was not mentioned in the Complaint. Searches made by the Panel at the Intellectual Property Office on-line database reveal only one trade mark of likely relevance - a device mark registration (UK trade mark registration number 3008252) for stylized letters SS in combination with the words "schoolssport.com". Even assuming that this is the mark the Complainant is referencing, the registration in question was applied for on 2 June 2013 which post-dates the filing of the Complaint. On any view it is irrelevant to this dispute and the Panel will not consider it further.

So far as unregistered Rights are concerned the Panel takes account of the following:

- The Complainant and its predecessors in title have traded since 1998.
- The Complainant's name is Schools Sports Limited and it trades under and

- by reference to that name.
- The Complainant and its predecessors in title have used the domain name schoolssports.com since 2001.
  - The Complainant's description of its business and reputation has not been disputed by the Respondent and specifically its assertion that it received in 2012 13 million page views and 550,000 unique visitors to its website has not been challenged.
  - The Respondent in its original Response acknowledged "*the substantial goodwill and reputation of SchoolsSports*" and expressly stated that "*It is clear that SchoolsSports have built an enviable client base and reputation over many years and as such their brand should be well established*"

The Panel has little difficulty in concluding on the evidence before it that the Complainant has Rights in the terms "School Sports" both as two separate words used together and in conjoined form as "schoolssports". The Panel acknowledges that these are ordinary English words, either separately or in conjoined form, and that they do not have a particularly high degree of inherent distinctive character when used in relation to the parties' respective services. The Panel does not, however, consider that these words are necessarily entirely descriptive of the Complainant's business which is the provision of an online sports management system for schools. The Panel can envisage a number of different business uses associated with schools and sport for which the words would be equally suitable (for example the supply of sports equipment to schools) but in any event it is a term which is clearly capable of acquiring distinctiveness and/or a secondary meaning through use. In the Panel's views the evidence of use over 12 years establishes on the balance of probabilities that it has done so. Such rights are capable of protection as a matter of English law by an action for the tort of passing off.

The Panel is confirmed in this view by what it considers to be clear admissions made by the Respondent in its Response. In this regard the Panel is not persuaded by the attempts made in the Appeal Notice to re-cast the Respondent's case and retreat from the admissions made in the Response.

In the Appeal Notice the Respondent submits that the Complainant has failed to identify precisely what Rights were being asserted and has failed to identify any particular badges of goodwill. It is clear to the Panel, as it was to the Expert, that the Complainant was claiming Rights in the name of "Schools Sports" and/or the term "schoolssports" as its trading name and that it considered it had substantial goodwill and reputation in the term which could be enforced in a passing off action. In its email of 20 May 2013 to the Respondent the Complainant wrote from its main "schoolssports.com" address and the subject of the email was "*Passing off Schools Sports Ltd*". The Respondent clearly understood this to be the case. In its Response the Respondent said that "*It is clear that Schoolssports have built an enviable client base and reputation over many years and as such their brand should be well established*". The Respondent went on to say that its products were "*not intended to threaten or take away the substantial goodwill and*

*reputation of SchoolsSports*". There cannot in the Panel's view be any real doubt that the Complainant was asserting Rights in the words schools sports and/or the term schoolssports, and the Respondent understood this was the case. For the reasons set out above the Panel is satisfied that the Respondent did have 'Rights' within the meaning of paragraph 2 of the Policy in these words and in this term.

For the purposes of assessing identity/similarity under this head of the Policy it is well established that the Panel should ignore the '.co.uk' top level domain identifier. In this case the other component of the Domain Name is "schoolsport". The Complainant trades under the name "Schools Sports" or "schoolssports" as it appears in the Complainant's main website address. The Panel finds that these words/term and the Domain Name are very similar, the only relevant difference being the additional "s"s in the middle and at the end of the term "schoolssports" and the space between the words when used separately.

Accordingly the Panel concludes that the Complainant has established it has Rights in a name which is similar to the Domain Name.

The Complainant has therefore succeeded in establishing that the first element of the Policy applies.

#### Second Element (Abusive Registration)

***"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 has taken unfair advantage of or has been unfairly detrimental to the Complainant's Rights;" [Paragraph 1 of the Policy]*

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.

The Complainant has not specifically referred to any of these factors but it is clear that its Complaint centres on alleged confusion or likely confusion between its trading name and the Domain Name. One of the factors under paragraph 3(a) is *"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"*. [Paragraph 3(a) (ii) of the Policy]

The Complainant states that it has received several reports of users accidentally trying to login to the Domain Name instead of the Complainant's website but no evidence

of these reports has been produced. The Complainant also alleges that the Respondent was aware of the Complainant and its business when it registered the Domain Name and, effectively, that it did so with its eyes open and/or with the intention of passing itself off as the Complainant. In response to this allegation concerning its knowledge at the time, the Respondent does not explain exactly how or why it chose the Domain Name and is silent as to the extent to which (if at all) it knew of the Complainant and its business when it registered the Domain Name. No positive defence of innocent adoption is advanced.

On the basis of the following evidence, and in the absence of an explanation from the Respondent, the Panel concludes on the basis of probabilities that the Respondent was aware of the Complainant when it registered the Domain Name.

By the time the Domain Name was registered in 2009 the Complainant and its predecessors in title had been trading by reference to the [www.schoolssports.co.uk](http://www.schoolssports.co.uk) website for 8 years and the product the Respondent subsequently launched was of a similar nature to the Complainant's product, in what is clearly a very specialised market. The Respondent does say that all of its product offerings start with the word school and go on to describe the specific product that it provides to the school. The Panel is not however persuaded that this is really the case in relation to "schoolsport" – the product the Respondent provides is not sport, but a sports fixtures management service. It would have been more natural and consistent with the Respondent's stated branding strategy for it to have adopted a name such as "schoolfixtures".

It is also clear from the filed evidence that when the Respondent originally launched its service its home page contained no details of who the Respondent was, and adopted logos (in particular two stylised capital "S" letters) that bore a degree of similarity to the Complainant's website's home page. The Respondent disputes the degree of similarity involved but at no point does it dispute having been aware of the Complainant or its website when it adopted this approach. It subsequently changed these elements of its webpage. Taking all of this into account the Panel concludes that the Respondent started offering a competing product in September 2012 with knowledge of the Complainant and its established business. It could easily and readily have adopted a name more in keeping with its existing branding strategy (e.g. 'schoolfixture.co.uk') but instead selected a domain name which was visually, aurally and phonetically very similar to the Complainant's existing name. It was also a name which might easily be entered by existing customers of the Complainant with imperfect recollection of the exact spelling used by the Complainant in its name. The Panel concludes that the Respondent's registration and use of the Domain Name in this way was likely to confuse people into thinking the Domain Name was in some way associated with the Complainant and was within paragraph 3(a) of the Policy.

It may be true that subsequent to the Complaint being filed the Respondent has taken some steps to reduce the likelihood of confusion occurring, specifically removing the stylized double S logos that were present on its website and introducing more details of its identity on its home page. How successful these are at removing possible confusion to visitors to the site is not something on which the

Panel has received any real evidence. The Panel does however consider that the ongoing similarity between the Domain Name and the Complainant's name and trading style will continue to result in what is commonly called "initial interest confusion". As the Experts' Overview document explains this in relation to the Policy:

*"Commonly, Internet users will visit web sites 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 web site 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 web site will use the domain name for that purpose.*

*In such cases, the speculative visitor to the registrant's web site will be visiting it in the hope and expectation that the web site is a web site "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 web site 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 an unauthorised tribute or criticism site (usually the latter) devoted to the Complainant; or a commercial web site, 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."*

The Panel concludes that such is the case here, and that the ongoing use of the Domain Name by the Respondent remains likely to confuse users on this basis, given the history of the Complainant's use of Schools Sports and schoolssports as trading styles, and the extent of its reputation in those words and term, as described above. This is a paradigm example of unfair detriment.

The Panel has given consideration to the potential applicability of the factors referred to in paragraph 4 of the Policy, which are predicated variously upon the condition(s) that the Respondent's use is innocent (paragraph 4(a)(i)) or constitutes fair use of a descriptive name (paragraph 4(a)(ii)). In the light of the Panel's conclusions recorded above in relation to the issues of secondary meaning and knowledge, the Panel has concluded that considerations of the nature set out in paragraph 4 are of no avail to the Respondent.

The Panel concludes that the Domain Name is, in the hands of the Respondent, an Abusive Registration. It was registered and has been used in a manner which takes unfair advantage of and is unfairly detrimental to the Complainant's Rights.

## **9. Decision**

The Panel dismisses the Appeal and upholds the Expert's direction that the Domain Name be transferred to the Complainant.

**David King**

**Nick Gardner**

**Philip Roberts**

**Dated 9 October 2013**