

DISPUTE RESOLUTION SERVICE

D00013160

Decision of Independent Expert

The Fertility Support Company Ltd

and

Ms Jacqueline Hurst

1. The Parties:

Lead Complainant: The Fertility Support Company Ltd
PO Box 48531
London
NW4 3WX
United Kingdom

Respondent: Ms Jacqueline Hurst
80 Fire Tree Avenue
Tile Hill
Coventry
CV4 9FS
United Kingdom

2. The Domain Name(s):

fertility-support.co.uk

3. Procedural History:

I can confirm 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 a such a nature as to call in to question my independence in the eyes of one or both of the parties.

26 August 2013 17:14
27 August 2013 11:12

Dispute received
Complaint validated

27 August 2013 11:56	Notification of complaint sent to parties
10 September 2013 10:14	Response received
10 September 2013 13:49	Notification of response sent to parties
13 September 2013 02:30	Reply reminder sent
16 September 2013 11:12	Reply received
16 September 2013 12:29	Notification of reply sent to parties
17 September 2013 10:00	Mediator appointed
19 September 2013 10:13	Mediation started
23 October 2013 08:19	Mediation failed
23 October 2013 08:19	Close of mediation documents sent
24 October 2013 09:14	Expert decision payment received

4. Factual Background

The Complainant is the owner of Community Trade Mark THE FERTILITY SUPPORT COMPANY, registration number CTM 005706205 which was registered in 2008.

In March 2006 the Complainant had previously registered the following Internet domain names, all of which resolve to the Complainant's website:

<fertilitysupport.co.uk>, <fertilitysupportcompany.co.uk>, <fertilitysupportcompany.com>, <thefertilitysupportcompany.co.uk>, <thefertilitysupportcompany.com>, <fertilitysupportnetwork.co.uk>, <fertilitysupportnetwork.com>, <fertilitysupportprotocol.co.uk>; <fertilitysupportprotocol.com>, <fertilitysupportsystem.co.uk>; <fertilitysupportsystem.com>, <fertilitysupportcentre.co.uk> and <fertilitysupportcentre.com>.

The Respondent is an acupuncturist and counsellor who claims on her website to operate in the fields covered by the trade mark.

The disputed domain name was registered in November 2012.

5. Parties' Contentions

Complainant

The Complainant submits that it was established in 2006 by its founder who has devoted most of the last 14 years to building her own reputation as an acupuncture practitioner and the last seven years to building the reputation of the Complainant company.

Over that time the Complainant has made substantial investment in advertising its services and has engaged in a sustained PR campaign in 2005-2008 which resulted in coverage in The Guardian, The Sun, Marie Claire, Company Magazine, Natural Health and Parenting.

The Complainant submits that its company name was specifically chosen because its founder was one of relatively few acupuncture practitioners to specifically focus on fertility and gynaecology.

In a conversation on 3 April 2013 the founder of the Complainant company spoke with the Respondent. The Respondent and she claimed not to have heard of the Complainant, its company or its website.

The Complainant submits that it is unlikely to be the case that the Respondent was unaware of the company's founder as she is very well known in the small UK acupuncture community, especially among circa 3,000 members of the British Acupuncture Council, of which both she and the Respondent are members. In 2011-12 she was elected to the British Acupuncture Council's Executive Committee. From 1999 until 2002 the Complainant's founder organised the post-graduate courses for the London College of Traditional Acupuncture through which she met many colleagues as they came to attend courses. During the period of 1999-2005 she regularly wrote in the British Acupuncture Council's journal *The Acupuncturist* and also the journal of the London College of Traditional Acupuncture, *The Dragon's Tale*. The circulation of *The Acupuncturist* is around 4,000-5,000 copies per issue and *The Dragon's Tale* which was circulated to all members of the British Acupuncture Council and the Register of Chinese Herbal Medicine as well as to mainstream retailers has a circulation between 3,000-10,000 copies per month.

The Complainant also submits that at the time the disputed domain name was chosen, it is highly unlikely that the Respondent and/or any professional web site developer engaged by her were unaware of the Complainant's above-listed portfolio of Internet domain names that were registered in 2006. The Complainant submits that the Respondent must also have been aware of the existence of its website and its registered and unregistered trademark rights when the disputed domain name was registered.

The Complainant submits that the Respondent can therefore not claim to be unaware of the potential for initial interest confusion arising from her registration of the disputed domain name and her use of that domain name to advertise an acupuncture practice.

The Complainant submits that the disputed domain name is an Abusive Registration because:

1. The disputed domain name is so similar to the Complainant's trade mark and the domain names used for the Complainant's business as to be regarded as identical.
2. The disputed domain name is virtually identical to the Complainant's <fertilitysupport.co.uk> domain name that has been in active use since 2006.
3. The Respondent is a competitor of the Complainant in the field of acupuncture services. The Respondent's use of the disputed domain name is a clear case of "passing off".
4. There is significant risk of initial interest confusion between the Respondent's web site and the Complainant's web site because of the similarity of the disputed domain name. This means that a search engine is

likely to return listings for the Respondent's web site when a user is searching for the Complainant's web site and a consumer arriving at the website is likely to believe that the domain name is registered to, operated or authorised by, or otherwise connected to the Complainant due to:

- a) the similarity of domain names,
- b) the similarity of the activity (e.g. acupuncture) discussed on the websites,
- c) the similarity of logos,
- d) the phrasing of the website content which talks about "Fertility Support" as if it was the name of the Respondent's company,
- e) the inclusion of a photo of a Harley Street road sign even though the Respondent does not work in London whereas the Complainant treats patients in Harley Street.

Furthermore, the Complainant submits that there is a significant risk that "auto-complete" function on web browsers may take users to the Respondent's web site rather than the Complainant's website when the name of the web site is being entered into the browser's address bar. It is inconceivable that the Respondent and/or any professional web site developer that she employed will have registered this domain name and developed her web site without coming across the Complainant's previously registered domain names and website. The Respondent can therefore not claim to be unaware of the Complainant's pre-existing registered and unregistered rights.

The domain name <fertilitysupport.com> was already registered but not in use.

Respondent

The Respondent submits that the disputed domain name <fertility-support.co.uk> has been registered and is being used in good faith to advertise the Respondent's business as an acupuncturist and counsellor specializing in the area of fertility support. She is a qualified acupuncturist and is registered with The British Infertility Counselling Association and accredited Counsellor with the British Association Counselling and Psychotherapy BACP.

In 2007 she became a founder member of a group engaged in fertility treatment that meets a number of times each year for updates and seminars on all of the latest research in infertility treatment, from the perspective of both occidental and Chinese Medicine. She has a very strong professional relationship with her Local Fertility Medical Unit.

Fertility Support has Business Registration Number 2293530 with National Business Register.

The Respondent submits that the wording "fertility support" is a generic term and is not a trademark. The Community Trade Mark relied upon by the Complainant is a figurative trademark and therefore protects the logo only.

The Respondent states that she has never been contacted by anyone who was intending to contact the Complainant. It clearly states on the front page of the Respondent's website that her practice is primarily in Warwickshire. This is also confirmed by the Warwickshire contact telephone number in bold print on her

website. The Respondent submits that it has always been her experience that any potential client would seek treatment nearest to their home. There are hundreds of Acupuncturists offering fertility support all over the country, many of them in London and indeed in Harley Street.

6. Discussions and Findings

Paragraph 2 of the DRS Policy requires the Complainant to prove that

- i. The Complainant has Rights in respect of a name or mark which is identical or similar to the Domain Name; and
- ii. The Domain Name, in the hands of the Respondent, is an Abusive Registration.

The Complainant has established that it has rights in the Community Trade Mark THE FERTILITY SUPPORT COMPANY and this Expert accepts that the disputed domain name is confusingly similar to the Complainant's trademark and many of the similar Internet domain names in the Complainant's portfolio.

The Complainant's trademark is however for a design/device mark, which the Respondent describes as a logo.

The disputed domain name <fertility-support.co.uk> consists of the two English language words "fertility" and "support" which are in combination a descriptive term that cannot be monopolised by the Complainant. Both the Complainant and the Respondent are each engaged in the provision of fertility support services in the acupuncture practices and each are entitled to use the words "fertility" and "support", either separately or in combination to describe the services that they provide.

The Complainant has argued that it is highly improbable that the Respondent was not aware of the Complainant, the reputation of its founder, the Complainant's website and its domain name when the disputed domain name was registered. The Respondent has not directly dealt with this issue in the Response but has argued that the domain name is generic and descriptive and furthermore that the Respondent is not interested in building a practice in London, rather wishing to develop her practice in the Warwickshire area. This Expert finds that in the circumstances of the present case, the intention of the Respondent is not relevant to the central issue that the disputed domain name and the Complainant's trademark are each a descriptive and generic term.

In the circumstances this Expert finds that the disputed domain name is not an Abusive Registration in the hands of the Respondent and the Complainant is not entitled to succeed in this Complaint.

7. Decision

For the above reasons, the Complainant's application is refused and fails.

Signed James Bridgeman

Dated 15 November 2013