

DISPUTE RESOLUTION SERVICE

D00013206

Decision of Independent Expert

The Super Cycles Group

and

Giant Games Ltd

1. The Parties

Complainant: Michael and Susan Poyzer
t/a The Super Cycles Group
2 Lowdham Street
Nottingham
Nottinghamshire
NG3 2DP
United Kingdom

Respondent: Giant Games Ltd
19 Half Moon Lane
Herne Hill
London
SE24 9JU
United Kingdom

2. The Domain Name

<tensile.co.uk> ("the Disputed Domain Name")

3. Procedural History

The Complaint was filed with Nominet on 15 August 2013. Nominet validated the Complaint on the same day and notified the Respondent by post and by email, stating that the Response had to be received on or before 6 September 2013. The Respondent filed a Response on 6 September 2013 and Nominet notified the Complainant that a Reply had to be received on or before 16 September 2013. The Complainant filed a Reply on 16 September 2013.

The Informal Mediation procedure failed to produce an acceptable solution for the parties and so on 7 October 2013 Nominet informed the Complainant that it had until 21 October

2013 to pay the fee for the decision of an Expert pursuant to paragraph 7 of the Nominet Dispute Resolution Service Policy ("the Policy"). The Complainant did not pay the fee and so on 22 October 2013 Nominet informed both parties that the Respondent had until 5 November to pay the fee instead. The Respondent paid Nominet the required fee on the due date.

On 8 November 2013 the undersigned, Jane Seager ("the Expert"), confirmed to Nominet that she was independent of each of the parties and that, to the best of her knowledge and belief, there were no facts or circumstances, past or present (or that could arise in the foreseeable future) that needed to be disclosed as they might be of a such a nature as to call in to question her independence in the eyes of one or both of the parties.

4. Factual Background

The Complaint has been filed by husband and wife Susan and Michael Poyzer, who trade as The Super Cycle Group. The Complainant sells and distributes bicycles and bicycle parts and components both from its shop in Nottingham and also via various online websites.

The Complainant owns the following trade marks in the term TENSILE:

- UK trade mark number 2324407 registered on 21 February 2003;
- Australian trade mark number 994247 registered on 20 March 2004;
- Community Trade Mark number 003710886 registered on 7 June 2005;
- Japanese trade mark number 856442 registered on 10 June 2005;
- Canadian trade mark number TMA646217 registered on 19 August 2005;
- New Zealand trade mark number 727960 registered on 13 October 2005; and
- United States trade mark number 3287788 registered on 4 September 2007.

The Complainant also registered the domain name <tensile.net> on 22 April 2008 and uses it to point to the www.tensile.net website which sells TENSILE branded bicycle components.

The Respondent is a UK registered company trading as Giraffe.co.uk. According to its website its main business is developing generic domain names, buying domain name portfolios, selling and leasing domain names. It registered the Disputed Domain Name on 1 September 1999.

The Disputed Domain Name is currently pointing to a Giraffe.co.uk branded website showing the Disputed Domain Name and the phrase "*This domain name is available for sale or lease. If you are interested in Tensile.co.uk, please click here to find out more*". The link leads to a page listing various reasons for purchasing the Disputed Domain Name, namely:

*"- A memorable domain name such as Tensile.co.uk will generate visits to your website
- a great domain name says positive things about your organisation (such as bbc.co.uk)
- a strong, short name will make it easier for people to email you correctly
- you will be paying a one-off fee for a name that will be useful for many years to come
- SEO - if your domain name matches what people search Google will give more prominence to your website
Put another way, owning Tensile.co.uk will help build a brand and earn you more money"*

There is also a graph illustrating the trends in search interest for the string <tensile> in the United Kingdom in recent years and then the words "*We generally sell domain names like this for upwards of £3,000 + VAT on a first come, first served basis. If you are interested in this domain name, please contact us using the form below.*"

5. Parties' Contentions

Complaint

Complainant's Rights

The Complainant states that it has worldwide interests in the distribution of bicycles and components and owns several registered trade marks. It asserts that one of its most significant brands is TENSILE and lists the trade marks detailed in Section 4 above. It also attaches the relevant trade mark certificates.

The Complainant states that it has used the TENSILE brand since 1996 and, as far as it is aware, it is the only business or organisation operating under this name in the world. It first registered its UK Trade Mark in 2003 (now in its second ten year term) and this was followed over the next few years by its other registrations.

The Complainant points out that it costs a lot of money to register and maintain its trade marks and ensure they are not compromised in any way and states that it feels that the registration of the Disputed Domain Name represents a threat to its continued livelihood.

The Complainant asserts that it manufactures and produces a large range of bicycle parts and components under the TENSILE brand which it distributes throughout the world and which account for a six figure sum in its annual turnover.

The Complainant points out that it operates a website at www.tensile.net which gives a clear indication of the breadth and depth of its range of products. It states that it wanted to register <tensile.com> and the Disputed Domain Name at the time but they were both taken. According to the Complainant, <tensile.com> is used legitimately by a company involved in tensile testing, and so it does not have any claim over that domain name.

However the Complainant asserts that the Respondent makes no use of the Disputed Domain Name and argues that the Complainant is the rightful user as it is based in the UK and is the only owner of the TENSILE brand across the whole range of classifications within the UK Trade Mark Registry and would like to develop a UK only website for its TENSILE branded products. The Complainant therefore requests that the Disputed Domain Name be transferred into its name so that it may make legitimate use of it.

Abusive Registration

The Complainant asserts that the Disputed Domain Name is an abusive registration because it was registered with the primary purpose of selling or renting it to the Complainant (or a competitor) for more than the Respondent paid for it. Furthermore, the Respondent's website indicates that it has no interest or intentions with regard to the Disputed Domain Name itself and only mentions selling it for around three thousand pounds.

Response

Complainant's Rights

The Respondent accepts the Complainant's assertions regarding the ownership of The Super Cycle Group. However, the Respondent states that it does not admit the Complainant's trade mark registrations, claiming that the proper evidence required was not attached to the Complaint. Furthermore, the Respondent states that it does not admit the assertions regarding the alleged scale of the Complainant's business because such assertions are also unsubstantiated by any evidence. As a result the Respondent argues that the Complainant has not demonstrated that it has the necessary Rights under the DRS Policy.

Notwithstanding the above, the Respondent notes that the oldest registered trade mark claimed by the Complainant dates back to 21 February 2003 and is limited to specialist bicycle parts. The Disputed Domain Name was registered on 1 September 1999, and this pre-dates the earliest Right claimed by over 3 years. Thus the Respondent argues that none of the Rights claimed by the Complainant existed prior to the registration of the Disputed Domain Name.

According to the Respondent, the Complainant registered <tensile.net> in 2008 only after finding that both the Disputed Domain Name and <tensile.com> had already been registered (Whois data attached in Annex). In the Respondent's opinion, this is simply a case of a frustrated party seeking to use the Policy to subvert the prior registration of a generic domain name which was legitimately registered on the first come first served basis operated by Nominet. As such, it amounts to attempted Reverse Domain Name Hijacking.

The Respondent asserts that "tensile" is a common English word. A UK Google search displays over 18 million results (attached in Annex). The Respondent acknowledges the presence of the Complainant's website on page 1 of those results, but argues that the predominant application of the word is not as a trade mark, but as a common English word. The Respondent states that it registered the Disputed Domain Name because of its common English meaning and not for any abusive purpose. The Respondent provides the following illustrations of this:

The online Merriam-Webster dictionary defines "tensile" as an adjective, meaning:

- 1: capable of tension: ductile
- 2: of, relating to, or involving tension, "tensile stress"

Thefreedictionary.com defines "tensile" as:

- 1: of or relating to tension.
- 2: capable of being stretched or extended; ductile.

The Respondent points out that "tensile" is often conjoined in phrases such as "tensile strength" (examples of these definitions and uses are attached in Annex).

The Respondent argues that where a domain name is a common English word, compelling evidence that the plain meaning has been displaced by a secondary meaning is required under the Policy. Thus the appeal cases dealing with <maestro.co.uk>, <oasis.co.uk>, and <philosophy.co.uk> all failed because the Complainant was unable to show that the common meaning of these words had been displaced by the trade mark

rights claimed in those cases. The Respondent argues that, even if it accepts the Complainant's rights (which it does not), then even at their strongest they are far weaker than those claimed in the cases referred to above where the Complainant was unsuccessful.

Respondent's Knowledge

The Respondent asserts that it first became aware of the Complainant upon receipt of the Complaint. In the Respondent's view, it has long been established under the Policy that a complainant must show that a respondent was aware of the complainant and its rights in order to successfully claim under most of the abusive registration provisions under the Policy, as set out by the Panel in the <verbatim.co.uk> Appeal case (DRS 04331).

The Respondent argues that this is a case that falls squarely under the ratio set out in <verbatim.co.uk> because the Disputed Domain Name is a common English word and the Respondent had no knowledge of the Complainant until it received the Complaint. In this regard, the Respondent points out that the Complaint contains no allegations that the Complainant was (or was likely to be) known by the Respondent. The Respondent asserts that the Complainant is not well known and operates in the specialist cycle parts business, but the Respondent does not.

Chronology and Delay

The Complaint acknowledges that the Complainant's registration of <tensile.net> post-dates the registration of the Disputed Domain Name, and the Respondent argues that the Complainant thus admits that it sought to register a domain name long after the Disputed Domain Name had been registered and opted for what it perceived to be a less desirable domain name only when it found that both the Disputed Domain Name and <tensile.com> had already been registered.

The Respondent submits that these admissions amount to an acceptance by the Complainant that it has coveted the Disputed Domain Name since at least 2008, and this indicates two things. First, it underlines that the Complainant's failure to bring a claim earlier shows that it knew that it had no right to bring a Complaint and that it had no right to the Disputed Domain Name. In the Respondent's opinion, the Complainant's failure to take action for at least 5 years (and for the 14 years since registration) illustrates that the Complainant knew that it had no right to the Disputed Domain Name and the Complaint is nothing more than a belated speculative attempt at Reverse Domain Name Hijacking.

In addition, the Respondent argues that the delay of 14 years from the date of registration of the Disputed Domain Name raises the legitimate defence of laches, and acquiescence in respect of the registration.

Respondent's Legitimate Rights

The Respondent acknowledges that, inter alia, it conducts business buying and selling domain names. The Respondent states that it is a legitimate business and has never been the subject of a successful Complaint under the Policy. The Respondent underlines that Paragraph 4(d) of the Policy makes clear that trading in domain names is lawful.

The Respondent points out that the Disputed Domain Name was registered by the Respondent on 1 September 1999 (almost 14 years ago) and the registration has never been the subject of any objection before the Complaint was filed. The registration pre-dates the Complainant's UK trade mark registration by almost four years, and no evidence has been adduced of the alleged scale of the Complainant's use of the word "tensile" prior to the trade mark registration. The Respondent thus denies that any common law rights have been established and also reiterates that it had no knowledge of the Complainant and its alleged rights until receipt of the Complaint.

The Respondent argues that the registration and retention of a single English word as a domain name for the purposes of selling it is expressly identified as lawful under the Policy, and states that this particularly applies to this case where the Disputed Domain Name is not a well-known trade mark. The Respondent notes that the reselling of domain names has been acknowledged as legitimate and lawful in a number of DRS cases.

The Respondent underlines that the Complainant referred to the Policy in the Complaint and must therefore have been aware of Paragraph 4(b) prior to filing the Complaint. The Respondent argues that the Complainant knew that the only purported evidence of alleged abusive registration – namely the general offer to sell the Disputed Domain Name on the corresponding website – did not amount to evidence of an abusive registration because this is expressly stated by the Policy.

In the Respondent's opinion, the Complainant was also aware that the date the Disputed Domain Name was registered pre-dated its trade mark registration, and that there was no evidence to support a claim that the offer to sell was directed specifically at the Complainant or at its competitors. Consequently, the Respondent asserts that the Complainant knew when it filed the Complaint that there was no valid claim that the Disputed Domain Name was an abusive registration.

The Respondent states that it did not know about the Complainant when it registered the Disputed Domain Name and so denies the allegation that it registered it primarily for the purpose of selling or renting it to the Complainant.

Attempted Reverse Domain Name Hijacking

This Respondent argues the Complainant is merely frustrated because it could not register the domain name of its choice, and that there is nothing more to the Complaint, which squarely amounts to attempted Reverse Domain Name Hijacking.

The Respondent asks the Expert to make plain in its decision that merely claiming to own a registered trade mark (particularly for a generic English word and one that post-dates the registration of the domain name in question) does not equate to the domain name being an abusive registration and that there is no automatic right that arises to bring a claim under the Policy.

The Respondent points out that having a qualifying trade mark (denied in this case) is only one of the requisite criteria and, absent any evidence of "abusive registration", there is no merit to a complaint under the Policy in such circumstances. In the Respondent's view, such speculative and unmeritorious complaints put legitimate domain name registrants to the time and expense of filing a response. They also require unnecessary use of Nominet's resources. The Respondent argues that, in situations where a

registrant might fail to file a response, there is a real risk of a transfer of a legitimately held domain name, particularly if the matter is decided by way of a Summary Decision.

The Respondent asserts that the Complainant accepts that the term "tensile" may be held legitimately by a third party (in the case of <tensile.com>), but then ignores those provisions of the Policy that make clear that dealing in generic domain names is a legitimate reason to retain a domain name registration.

The Respondent submits that a clear statement is needed that – absent anything to support a claim of "abusive registration" – such complainants will be held to have brought complaints in bad faith in an attempt to game the system, and so will be found to have engaged in attempted Reverse Domain Name Hijacking. The Respondent therefore asks the Expert to make a finding of Reverse Domain Name Hijacking in this case.

Reply

Complainant's Rights

The Complainant states that the Respondent has clearly ignored all the evidence of the Complainant's Rights that was submitted with the original Complaint - trade mark registration certificates were attached for the United Kingdom, the European Union, The United States of America, Canada, Australia, New Zealand and Japan. In addition, the Complainant points out that all of these countries have their own intellectual property websites where the existence of these Rights may be verified.

The Complainant states that the United Kingdom trade mark registration is now into its second ten year period and all the other trade mark registrations are approaching ten years. It also states that in the USA a section 8 and 15 file of incontestability has been actioned and accepted by the USPTO. The Complainant asserts that it has been actively selling TENSILE branded products into all the countries referred to since the development of its first product in 1997.

The Complainant argues that the word "tensile" is absolutely identical, not merely similar, to the word used by the Respondent in the Disputed Domain Name, and thus it fails to see how any greater proof of its Rights could have been submitted.

The Complainant submits that statements made by the Respondent in its Response have made assumptions and distorted the facts surrounding its original domain name registration. The Complainant states that at the time it wanted to register both <tensile.com> and the Disputed Domain Name, but they were both taken, which was clearly stated in the Complaint. In the Complainant's opinion, the Respondent has twisted the meaning to suggest that the Complainant has been hovering and waiting for five years coveting the Disputed Domain Name, but nothing could be further from the truth. The Complainant states that, as an international company, it was looking for a top level domain to develop its internet business. At the time the Complainant wanted to register <tensile.com>, but this was taken by a company involved in tensile testing. The Complainant thus concluded that it was operating a legitimate website.

The Complainant argues that it therefore registered the best alternative, <tensile.net>, and that is where all its investment in the internet has been made. The Complainant states that it would also have registered the Disputed Domain Name at the time, but when it saw that it was already registered it abandoned this idea. The Complainant goes

on to submit that it did not visit the website to which the Disputed Domain Name is pointing until June 2013, as a result of an incident with a customer described below.

The Complainant also points out that the Respondent states that the Complainant's use of the TENSILE trade mark is limited to specialist bicycle parts, which implies that its operation is small and niche. The Complainant asserts that it designs, develops, markets and sells a large and growing range of bicycle components to all aspects of bicycle sport and all disciplines of cycle usage.

The Complainant fully accepts that "tensile" is a common English word, but in the Complainant's opinion this does not mean that it should not be a registered trade mark. The Complainant states that it took advice on this issue at the time of registration and argued before the Trade Mark Registry that "tensile" was meaningless in isolation and to achieve meaning it had to be used in combination with other words, for example "high tensile" or "tensile strength". The Complainant points out that these facts were reiterated by the Respondent in its response. The Complainant states that the UK Trade Mark Registry found in its favour at an Ex Parte hearing on 13 May 2003 and the trade mark was passed for registration (a copy of this decision is attached in Annex).

In the Complainant's view, the Respondent's reference to the delay of fourteen years only points to the Respondent's lack of legitimate use of the Disputed Domain Name for fourteen years other than to offer it for sale at an exorbitant price.

Respondent's Knowledge

The Complainant states that it had no knowledge of the Respondent prior to this dispute and that it could not know whether or not the Respondent was aware of the Complainant. The Complainant wonders whether the Respondent could be said to be taking its responsibility as a domain name registrant seriously enough if it was unaware of a brand name which, by the Respondent's own admission, occupied two entries in the first page of the Google Search submitted by the Respondent. Conversely, the Complainant states that it viewed about ten pages of the same search and found no mention of the Disputed Domain Name.

The Complainant argues that the Respondent's statement that the Complainant is not well known is rash, as the Respondent can have no real idea of this. The Complainant states that www.tensile.net is now receiving sixty thousand hits worldwide per year and the Complainant has a six figure turnover in relation to TENSILE branded products. In the Complainant's opinion, the Respondent makes the assumption that the brand is not well known just because the Respondent has not heard of it.

Chronology and Delay

The Complainant reiterates that it only became aware of the abusive nature of the Respondent's website in June 2013 when a customer rang to enquire about a pair of TENSILE wheels and asked if the Complainant was selling its business. After further questioning by the Complainant it became apparent that the customer had tried www.tensile.com but to no avail and so had gone to www.tensile.co.uk and noted the message that the Disputed Domain Name was for sale. The customer then proceeded to obtain the Complainant's telephone number from www.rocknrollbikes.com, another of the Complainant's websites.

The Complainant immediately went to www.tensile.co.uk and realised why the customer had made the assumption and saw how other customers could potentially be confused and make the same assumption. In the Complainant's opinion, this was quite clearly a case of "Initial Interest Confusion" and abusive registration. The Complainant points out that there is no attempt to place advertisements on the website or use it to divert people to other websites. In the Complainant's opinion, the "For Sale" sign could certainly confuse the Complainant's potential customers into thinking that it was for sale, or alternatively it could offer one of its competitors a way to buy the Disputed Domain Name and divert potential customers to its own website.

Respondent's Legitimate Rights

The Complainant states that it recognises the fact that trading in domain names is a legitimate business activity and has no wish to oppose this practice. However, the Complainant disagrees that the Respondent has demonstrated that "tensile" is a generic word and stresses that it has not admitted this. In the Complainant's view, commonly used does not mean generic.

The Complainant points out that, since it had no knowledge of the Respondent prior to the Complaint and was not aware of the website to which the Disputed Domain Name was pointing until recently, it does not know why the Respondent registered the Disputed Domain Name fourteen years ago. However, the Complainant is of the opinion that the Respondent obviously had no intention of developing a legitimate website at the Disputed Domain Name and that it is now clearly operating an abusive website. Such website is potentially causing harm to the Complainant's business which is based on its legitimate trade mark rights in the word "tensile".

Attempted Reverse Domain Name Hijacking

The Complainant vigorously denies this allegation. Whilst the Complainant accepts that the buying and selling of domain names is a legitimate activity, it argues the following:

- The Respondent has owned the Disputed Domain Name for fourteen years;
- The Respondent has no legal rights in the term TENSILE, and attempts to portray it as a generic word. The Respondent has put forward no evidence of any attempt to build a real website relating to the term "tensile" during the fourteen years of its registration and neither has it made any proposals for its future use;
- Tensile is not a generic word and could in no way be considered as one. The Respondent has shown no examples of the word used generically;
- The Respondent is clearly cybersquatting. There is no real evidence that the two parties were aware of each other, but neither is there any real evidence that they weren't. On the balance of probabilities they probably were not, but the sole reason for registration was still to sell at an exorbitant price to somebody with real rights;
- The Complainant has shown strong and well documented rights in the term "tensile" and is suffering damage to those rights by the Disputed Domain Name which is being used abusively by the Respondent. It is not clear at what point the Disputed Domain Name became abusive as the Complainant cannot check the historical operation of the corresponding website, but it was clearly abusive from June 2013 onwards when the Complainant first became aware of its content;
- The Complainant categorically denies that the Complaint was brought in bad faith and states that this is not a case of attempted Reverse Domain Name Hijacking, but rather a

legitimate attempt to retrieve the Disputed Domain Name in which it has legal rights and which is currently being used to its detriment; and

- The Complainant asserts that by continuing to offer the Disputed Domain Name for sale the Respondent is now effectively threatening continuing abusive action as it is now well aware of the Complainant's existence.

6. Discussion and Findings

General

Under paragraph 2(a) of the Policy, for the Expert to order a transfer of the Disputed Domain Name, the Complainant is required to demonstrate, on the balance of probabilities, both of the following elements:

"(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."*

Complainant's Rights

Despite the Respondent's assertions to the contrary, the Complainant has in fact demonstrated that it holds various registered trade marks in the term TENSILE in a number of different countries – copies of the relevant trade mark certificates were indeed attached to the original Complaint. The Expert is therefore satisfied that the Complainant has Rights in this term under the Policy (which defines Rights as including, but not limited to, rights enforceable under English law).

It should be noted that the date that the Complainant's Rights came into existence is not relevant as far as paragraph 2(a)(i) is concerned. However, in cases such as this where the registration of the Disputed Domain Name significantly pre-dates the Complainant's Rights then this issue will be considered under paragraph 2(a)(ii) and Abusive Registration (see below).

Furthermore, the Policy stipulates that the name or mark in which the Complainant has Rights (TENSILE) must be identical or similar to the Disputed Domain Name (<tensile.co.uk>). It is accepted practice under the Policy to discount the ".co.uk" suffix, and so the Complainant's trade mark and the Disputed Domain Name are thus identical to one another.

As a result, the Expert finds that paragraph 2(a)(i) of the Policy is satisfied and the Complainant has Rights in respect of a mark which is identical or similar to the Disputed Domain Name.

Abusive Registration

Moving on to paragraph 2(a)(ii) of the Policy, "Abusive Registration" is defined in paragraph 1 of the Policy to mean a domain name which:

"(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."*

In the Expert's opinion the Complainant has not succeeded in proving limb (i) above which relates to abuse at the time that the Disputed Domain Name was *registered*. The Complainant briefly claims in the Complaint that it started using the TENSILE brand in 1996, but it supplies no evidence of this and makes no attempt to prove unregistered (or common law) rights dating from this time.

Thus this Complainant's earliest Right for the purposes of this proceeding must be taken as its UK trade mark registered in February 2003. However, the Disputed Domain Name was registered by the Respondent in 1999, over three years earlier. It is therefore simply not possible for the Respondent to have taken unfair advantage of (or acted in a way that was unfairly detrimental to) the Complainant's Rights upon registration of the Disputed Domain Name when such Rights were not yet in existence.

Turning to limb (ii) of the definition of Abusive Registration which relates to the Respondent's subsequent *use* of the Domain Name, the Expert also finds that the Complainant has not succeeded in proving this. The Respondent is using the Disputed Domain Name to point towards a website offering it for sale. As the Respondent points out, such activities are not necessarily prohibited under the Policy. Paragraph 4(d) of the Policy reads as follows:

"(d) Trading in domain names for profit, and holding a large portfolio of domain names, are of themselves lawful activities. The Expert will review each case on its merits.

In this regard it is important to note that the nature of the Disputed Domain Name itself is crucial when reviewing this particular case. If the Respondent was offering a domain name for sale which was identical to a distinctive well-known brand and indeed could only ever refer to that brand and nothing else, then this would generally be abusive, especially if that brand was well known long before the domain name was registered.

In this particular case the situation is very different. The Respondent asserts that the term "tensile" is generic, but the Complainant refuses to accept this on the basis that it has a registered trade mark in the term TENSILE. However, the Complainant's registered trade mark only means that it is able to stop third parties from using the word TENSILE if such use could be said to infringe its trade mark registration, ie in conjunction with the goods and services listed and in the countries at issue. What the Complainant's trade mark does not do is give it a blanket monopoly over the use of the term "tensile" in other situations. Despite the Complainant's assertions, there can be no doubt that "tensile" is a term that has its own meaning in the English language (unlike a distinctive brand name which does not) and thus third parties may wish to use it, and may of course do so as long as they do not infringe the Complainant's registered trade marks.

Trade marks must be capable of distinguishing particular goods or services and thus must be distinctive (as opposed to descriptive). The minutes of the trade mark registration hearing on 13 May 2003 supplied by the Complainant demonstrate that the officer considered the term "tensile" to be "borderline" when used for bicycles or their parts and fittings, but nevertheless allowed the registration to proceed for that class of goods because "on balance, the mark is distinctive for those goods as the consumer

would not expect the word 'tensile' to convey any descriptive message in relation to cycles or their parts and fittings".

No doubt the Complainant's trade marks are expensive to maintain, as per the Complainant's submissions, but the hearing minutes underline that the scope of such trade marks has been carefully considered. In short, the Complainant's trade marks do not allow the Complainant to prevent any use of the word "tensile" other than use in relation to those goods and services covered by its trade marks (and furthermore the term "tensile" has been found to be distinctive in relation to such goods and services, as required for registration). If this was not the case and the Complainant was able to prevent additional use by third parties, especially in a descriptive manner, then the situation would be unworkable.

The Respondent is merely offering the Disputed Domain Name for sale on its website. There are no factors which may lead to a finding of abuse under the Policy. Nothing would suggest that the Respondent is specifically targeting the Complainant in an effort to take unfair advantage of (or be unfairly detrimental to) the Complainant's Rights, as required by the Policy. As a result, the Respondent's use cannot be said to be abusive.

This is not to say though that the use of the Disputed Domain Name could never be abusive – as the Complainant points out it could be acquired by a competitor of the Complainant and pointed towards such competitor's website in order to attempt to poach the Complainant's customers. Generally speaking this would be a classic case of cybersquatting and something that the Policy has been designed to prevent. However, merely offering the Disputed Domain Name for sale is not as it could equally be purchased by a party with a legitimate interest, for example the owner of a TENSILE trade mark in a different class or an entity wishing to use the term in a purely descriptive manner.

For the sake of completeness, it should be noted that a list of five factors which may be evidence that the Disputed Domain Name is an Abusive Registration is set out at paragraph 3(a) of the Policy. The Complainant appears to argue that factor 3(a)(i)(A) is satisfied, namely:

- "(i) *Circumstances indicating that the Respondent has registered or otherwise acquired the Domain Name primarily:*
 - (A) *for the purposes of selling, renting or otherwise transferring the Domain Name to the Complainant or to a competitor of the Complainant, for valuable consideration in excess of the Respondent's documented out-of-pocket costs directly associated with acquiring or using the Domain Name."*

It may well be that the Respondent acquired the Disputed Domain Name primarily for the purposes of selling it, but, given that the Expert is convinced that it was unaware of the Complainant at the time of registration (and the Complainant itself admits that this is probably the case), it is difficult to see how this could have been to the Complainant or to a competitor of the Complainant. Thus factor 3(a)(i)(A) is not found.

The Complainant also appears to argue that factor 3(a)(ii) is satisfied, which reads as follows:

"(ii) 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"

In support of this contention, the Complainant relates how a customer mistakenly accessed the website to which the Disputed Domain Name is pointing, saw the message saying that it was available for sale and assumed that the Complainant was selling its business. In the Expert's opinion, this confusion cannot be attributed in any way to the Respondent's use of the Disputed Domain Name because nothing on the website brings to mind the Complainant or its TENSILE brand. The confusion therefore appears to be a one off incident which was particular to a specific customer, and is not something likely to happen on a regular basis.

For the sake of completeness, the Expert has also reviewed the additional factors listed at paragraph 3(a) of the Policy and finds that none of them have been satisfied.

Furthermore, a list of five factors which may be evidence that the Disputed Domain Name is not an Abusive Registration is set out at paragraph 4(a) of the Policy, and the Expert finds that paragraph 4(a)(ii) is of assistance to the Respondent, as follows:

"(ii) The Domain Name is generic or descriptive and the Respondent is making fair use of it."

In conclusion, the Expert has considered the admissibility, relevance, materiality and weight of the evidence as a whole and is not satisfied that the Complainant has succeeded in proving, on balance of probabilities, that the Domain Name is an Abusive Registration in accordance with paragraph 2(a)(ii) of the Policy.

Reverse Domain Name Hijacking

Reverse Domain Name Hijacking is defined under paragraph 1 of the Nominet Dispute Resolution Service Procedure as use of the Policy in bad faith in an attempt to deprive a registered domain name holder of a domain name.

Given all the surrounding facts and circumstances, the Complainant's case was quite frankly hopeless. However, the Expert does not believe that the Complainant necessarily acted in bad faith in bringing the Complaint, given the nature of its submissions and the fact that it did not appear to take any legal advice. Contrary to the Respondent's assertions, the Complainant did submit correct trade mark evidence and was not trying to hide the date of its earliest trade mark registration and the fact that this post-dates the date of registration of the Disputed Domain Name (if it had the Expert may well have made a different finding).

The Complainant seems to honestly believe that offering a domain name for sale when another party has trade mark rights in that particular term is against the Policy, even when such term is a dictionary word. Clearly such a proposition cannot be correct. Indeed, by the Complainant's own admission, a third party is using the domain name <tensile.com> to point to a website using the term "tensile" in its descriptive sense.

However, the Expert does not believe that the Complainant was acting in bad faith when it filed the Complaint and so Reverse Domain Name Hijacking is therefore not found.

7. Decision

The Expert finds that the Complainant has Rights in a name which is identical to the Disputed Domain Name, but is not satisfied that the Disputed Domain Name, in the hands of the Respondent, is an Abusive Registration. No action should therefore be taken in relation to the Domain Name. The Expert declines to make a finding of Reverse Domain Name Hijacking against the Complainant.

Jane Seager
25 November 2013