

DISPUTE RESOLUTION SERVICE

D00014414

Decision of Independent Expert

Regspec Limited

and

Mr Mick Robinson

1. The Parties:

Lead Complainant: Regspec Limited
Bank Chambers 1-3 Woodford Avenue
Gants Hill
Ilford
Essex
IG2 6UF
United Kingdom

Respondent: Mr Mick Robinson
6 Kevin Grove
Rotherham
South Yorkshire
S66 8HF
United Kingdom

2. The Domain Name(s):

regspec.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.

23 June 2014 15:46 Dispute received

24 June 2014 13:35 Complaint validated
24 June 2014 13:54 Notification of complaint sent to parties
11 July 2014 02:30 Response reminder sent
16 July 2014 10:24 Response received
16 July 2014 10:24 Notification of response sent to parties
17 July 2014 10:16 Reply received
18 July 2014 09:47 Notification of reply sent to parties
18 July 2014 09:47 Mediator appointed
23 July 2014 15:21 Mediation started
11 August 2014 16:02 Mediation failed
11 August 2014 16:03 Close of mediation documents sent
12 August 2014 12:25 Expert decision payment received

4. Factual Background

- 4.1 The Complainant is an English limited company which provides services in the general field of electrical inspection and testing.
- 4.2 The Complainant was incorporated on 10 March 2008 as Regspec Limited by Mr Darren Brown (“Mr Brown”).
- 4.3 The Complainant is the registered proprietor of UK registered trade mark number 00002484943 for the word mark REGSPEC which is registered in class 42 for, “inspection and testing of electrical installations and apparatus; testing of emergency lighting and portable electrical appliances”. This trade mark was registered on 15 April 2008.
- 4.4 The Domain Name was registered by the Respondent on 22 April 2008.
- 4.5 The Domain Name is currently being used by the Respondent to link to a site which promotes the business of “Robinson’s Electrical Inspection & Testing”.
- 4.6 Mr Brown and the Respondent were previously employed by a company called Regspec Limited. Regspec was acquired by a company called Bureau Veritas in 2002 and Bureau Veritas discontinued the use of the name Regspec shortly after they acquired the business of Regspec Limited. The original company Regspec Limited was then dissolved in 2005.

5. Parties’ Contentions

Rights

- 5.1 The Complainant contends that it has Rights in a name or mark which is similar or identical to the Domain Name for the following reasons;
 - 5.1.1 It is the owner of a UK registered trade mark for the word mark REGSPEC;
 - 5.1.2 It has been registered at UK Companies House since 10 March 2008 as Regspec Limited;

- 5.1.3 It has used the names Regspec and Regspec Limited since March 2008 for the supply of electrical inspection and testing services and has built up a significant amount of goodwill and reputation in relation to these services over this time across the UK.
- 5.2 The Respondent disputes that the Complainant has been using the names Regspec and Regspec Limited since 10 April 2008 because the Complainant was an employee of Bureau Veritas at this time. The Respondent also contends that at the time the Domain Name was registered the Complainant had not built up goodwill. Additionally, the Respondent points out that his area of work is South Yorkshire which is not one of the locations in which the Complainant claims to have built up goodwill.

Abusive Registration

- 5.3 The Complainant contends that the Domain Name is an Abusive Registration for the following reasons:
- 5.3.1 The Respondent was aware that the Complainant was incorporating a company in the name of Regspec Limited. Both Mr Brown and the Respondent were employed by Bureau Veritas about this time and Mr Brown told his line manger about his intention to use Regspec at that time. The Complainant contends that Mr Brown's line manager would have been in contact with the Respondent and the Respondent would therefore have found out about Mr Brown's intentions.
- 5.3.2 The timing of the registration of the Domain Name (22 April 2008) is barely a month after the incorporation of the Complainant and one week after the Complainant's trade mark application was filed. The Complainant contends that the registration of the Domain Name was triggered by these actions.
- 5.3.3 The Respondent is involved in the same sort of business as the Complainant and is a potential competitor.
- 5.3.4 The Domain Name (1) includes the name REGSPEC which is identical to: the Complainant's UK registered trade mark, company name and the name in which the Complainant has built up rights; (2) is being used to advertise services identical to those in the UK registered trade mark and (3) is being used to deceive customers into thinking that the Respondent's business is associated with the Complainant in a way that will, or is likely to, damage the Complainant's business.
- 5.4 The Respondent contends that the Domain Name is not an Abusive Registration for the following reasons:
- 5.4.1 The Respondent did not have any knowledge of the Complainant's intentions;
- 5.4.2 The Respondent always intended to register the name REGSPEC with Companies House and to register the Domain Name and the domain name regspec.com;
- 5.4.3 The Respondent registered the Domain Name and the domain name regspec.com but could not register Regspec Limited because the Complainant had already registered this. The Respondent believes that the

Complainant registered the company Regspec Limited after hearing of the Respondent's intentions from various sources;

- 5.4.4 The Respondent registered the Domain Name Regspec.co.uk and regspec.com before the trade mark REGSPEC was granted to the Complainant. This trade mark was not granted until 12 September 2008;
- 5.4.5 The Domain Name is not an Abusive Registration because it is being used to promote the Respondent's business;
- 5.4.6 None of the Respondent's websites mention Regspec Limited and therefore there is no intention to divert traffic away from the Complainant. The Domain Name does not imply any association with the Complainant.

Reply

- 5.5 The Complainant has replied to the Respondent's Response as follows:
 - 5.5.1 The Complainant submits that if the Respondent had wanted to register Regspec as a company name then he would have done so before registering the Domain Name;
 - 5.5.2 The Complainant had no idea that the Respondent had registered the Domain Name until after Regspec Limited had been registered at Companies House;
 - 5.5.3 Regspec is a unique company name in the field of electrical testing and inspection and the only reason for the Respondent to be using the Domain Name is to divert potential customers of the Complainant to the Respondent's own business.

6. Discussions and Findings

- 6.1 Paragraph 2(a) of Nominet's Dispute Resolution Policy ("the Policy") requires that the Complainant must prove, on the balance of probabilities, that:
 - 6.1.1 *The Complainant has Rights in respect of a name or mark which is identical or similar to the Domain Name; and*
 - 6.1.2 *The Domain Name, in the hands of the Respondent, is an Abusive Registration.*

Rights

- 6.2 As a first step I must therefore decide whether the Complainant has Rights in respect of a name or mark which is identical or similar to the Domain Name.
- 6.3 The definition of Rights in the Policy is as follows:

Rights means rights enforceable by the Complainant, whether under English law or otherwise, and may include rights in descriptive terms which have acquired a secondary meaning.
- 6.4 This has always been treated in decisions under Nominet's DRS as a test with a low threshold to overcome and I think that must be the correct approach.
- 6.5 The Complainant is the registered proprietor of a UK trade mark for the word mark, REGSPEC. It is also clear that the Complainant has some trading history under this

name. I therefore have no difficulty in concluding that the Complainant has Rights in the word or mark REGSPEC.

- 6.6 The Domain Name contains the word in which the Complainant has Rights i.e. the name or mark REGSPEC in its entirety with the addition only of the first and second level suffix .co.uk. I therefore conclude that the Complainant has Rights in a name or mark which is identical with or similar to the Domain Name.

Abusive Registration

- 6.7 Abusive Registration is defined in Paragraph 1 of the Policy as 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.*

- 6.8 This definition allows me to consider whether the Domain Name is an Abusive Registration either at the time of registration/acquisition or subsequently through the use that was made of it.

- 6.9 Paragraph 3 of the Policy provides a non-exhaustive list of the factors which may constitute evidence that a Domain Name is an Abusive Registration and Paragraph 4 of the Policy provides a non-exhaustive list of the factors which may constitute evidence that the Domain Name is not an Abusive Registration.

- 6.10 The Policy provides for the Complainant to prove, on the balance of probabilities, that the Domain Name is an Abusive Registration. The burden of proof is therefore firmly on the Complainant.

- 6.11 In order to make a finding of Abusive Registration it is reasonably common ground amongst Nominet Experts that, in all but a minority of cases, there must be an element of knowledge on the part of the Respondent in the sense that the Respondent must, on some level, be aware of the Complainant's Rights. In some cases where the name in which the Complainant has Rights is particularly well known this will be fairly obvious and straightforward while in other cases where the name in which the Complainant has Rights is less well known and/or where there are other meanings or uses which can be made of the name this will require substantial evidence from the Complainant.

- 6.12 The position on knowledge has been summarised by Nominet's Appeal Panel in the earlier case of Verbatim Limited -v- Michael Toth DRS04331 and it is convenient to reproduce the following paragraphs from the Appeal Panel's decision here:

In this Panel's view the following should be the approach to the issues of knowledge and intent in relation to the factors listed under paragraph 3 of the Policy:

- 6.12.1 *First, some knowledge of the Complainant and/or its brands/rights is a pre-requisite for a successful complaint under all heads of the DRS Policy other than paragraph 3(a)(iv) (giving false contact details). The DNS is a first-come-first-served system. The Panel cannot at present conceive of any circumstances under which a domain name registrant, wholly unaware of*

the Complainant and its Rights, can be said to be taking unfair advantage of or causing unfair detriment to the Complainant's Rights.

- 6.12.2 *Secondly, "knowledge" and "intention" are pre-requisites for a successful complaint under all heads of paragraph 3(a)(i) of the Policy. The wording of that paragraph expressly calls for the relevant intent, which cannot exist without the relevant knowledge.*
- 6.12.3 *Thirdly, "intention" is not a necessary ingredient for a complaint under paragraph 3(a)(ii) of the DRS Policy. The test is more objective than that. However, some knowledge of the Complainant or its name/brand is a pre-requisite.*
- 6.12.4 *Fourthly, while some knowledge of the Complainant or its name/brand is a pre-requisite for a successful complaint under the DRS Policy (save for a complaint under paragraph 3(a)(iv)), knowledge is not of itself conclusive in favour of the Complainant. The Expert/Appeal Panel will still need to be satisfied that the registration/use takes unfair advantage of or is causing unfair detriment to the Complainant's Rights.*
- 6.12.5 *Fifthly, when a Respondent denies all knowledge of the Complainant and/or its Rights at the relevant time, that denial is not necessarily the end of the matter. The credibility of that denial will be scrutinised carefully in order to discern whether, on the balance of probabilities, the relevant degree of knowledge or awareness was present.*

Accordingly, in the view of this Panel, for this complaint to succeed, the Complainant must satisfy the Panel, as an opener, that the Respondent was aware of the existence of the Complainant or its brand at the date of registration of the Domain Name.

- 6.13 The Complainant's position in relation to the Respondent's knowledge is simple. Shortly after the Complainant was incorporated and a registered trade mark was applied for the Respondent opportunistically registered the Domain Name and is using the Domain Name to divert business away from the Complainant. To paraphrase the Complainant's case this is the case because Mr Brown (who is behind the Complainant) and the Respondent previously worked together and the Respondent would have found out Mr Brown's plans because of this common linkage. Additionally, the Respondent and the Complainant are in exactly the same line of business.
- 6.14 I will look in more detail at the question of knowledge in the context of analysing the Respondent's position a little later in this Decision. At this stage, and looking only at the Complainant, I am satisfied that the Complainant has established a prima facie case that the Respondent would have known about the Complainant at the time at which the Domain Name was registered.
- 6.15 The Complainant's case is essentially that the Respondent is using the Domain Name to redirect internet users to the Respondent's website(s) that competes with the Complainant's business.
- 6.16 Evidence of Abusive Registration may include the following under Paragraph 3(a)ii of the Policy:

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;

- 6.17 The Experts' Overview states in relation to confusion under Paragraph 3(a)ii of 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,...

...In DRS 07991 (toshiba-laptop-battery.co.uk) an aspect which the appeal panel regarded as being indicative of abusive use was the fact that the Respondent was using the domain name featuring the Complainant's trade mark to sell in addition to the Complainant's goods, goods competing with the Complainant's goods.

Findings of Abusive Registration in this context are most likely to be made where the domain name in issue is identical to the name or mark of the Complainant and without any adornment (other than the generic domain suffix)...

- 6.18 In this case the Domain Name contains the name or mark in which the Complainant has Rights without adornment. Further, the Respondent is in exactly the same line of business as the Complainant albeit that he appears to be in a completely separate geographical area to the area in which the Complainant focuses most if not all of its business. It therefore seems to me that there will be a good chance that potential customers of the Complainant will arrive at the Respondent's site by using the Domain Name (or a url containing the Domain Name). Having done this they will simply leave or go elsewhere having realised that it is not the Complainant's site or they will look at and may even purchase the services being offered by the Respondent. In both scenarios so called "initial interest confusion" would have occurred although in the second scenario the confusion will go further than that. In either scenario (absent any defence that the Respondent may have) the Respondent's actions amount to an Abusive Registration.
- 6.19 Given all of the above, the Complainant has established a prima facie case that, on the balance of probabilities, the Respondent is acting in manner which takes unfair advantage of and/or which is unfairly detrimental to the Complainant's Rights. It follows that the Complaint has prima facie established, on the balance of probabilities, that the Domain Name is an Abusive Registration.
- 6.20 That is however not the end of the story and I will now go on to look at the arguments put forward by the Respondent to see whether it is able to rebut my prima facie finding of an Abusive Registration.

- 6.21 The Respondent does not put his case very clearly and the Response is limited to a few fairly short comments on the Complaint. The Respondent's case is however essentially as follows: (1) the Respondent knew nothing about the Complainant's intentions to set up a business using the name Regspec and the Respondent's registration of the Domain Name shortly after the incorporation of the Complainant and the Complainant applying for a UK registered trade mark was entirely coincidental (2) the Respondent's use of the Domain Name is not intended to and does not mislead anyone as the site which the Domain Name is linked to is clearly a site which promotes the Respondent's business.
- 6.22 Both of these points have considerable merit. This is not a case where the Complainant has simply set up a business under a new or invented word. If that was the case then it would be much easier to conclude that the Respondent had come along afterwards and by registering the Domain Name tried to take unfair advantage of the Complainant's business. In this case, there is a complicating factor in that both the person behind the Complainant, Mr Brown, and the Respondent were employed by a company which has long since been dissolved but which traded under the name Regspec. This company which the Complainant refers to in its complaint as "Old Regspec" was in exactly the same line of business as both the Complainant and the Respondent.
- 6.23 Given the fact that Mr Brown and the Respondent were both employed by a company which traded as REGSPEC in the field of electrical inspection and testing it is therefore entirely conceivable that when both came to setting up their own businesses they both independently decided to use the name REGSPEC presumably because it was a name that was known in the industry albeit that it had long since been abandoned by the business that acquired Old Regspec. If this was the case then I think it would be very difficult for me to go on and make a finding of Abusive Registration and I would have to conclude that the Respondent's registration of the Domain Name had nothing at all to do with the Complainant.
- 6.24 Ultimately, I am marginally more persuaded by the Complainant's version of events. This is primarily because of the connection between Mr Brown and the Respondent which means that it is very likely that the Respondent knew about Mr Brown's intentions and because of proximity of the date on which the Domain Name was registered and the dates on which the Complainant was incorporated and its registration of the trade mark for REGSPEC. I think it is simply unlikely that the Respondent would have registered the Domain Name so shortly after the Complainant was incorporated and/or the Complainant applied to register its UK trade mark for the word mark Regspec. The proximity of these dates lead me to conclude, very much on the balance of probabilities, that it is more likely than not that the Respondent knew about the Complainant when it registered the Domain Name.
- 6.25 The Respondent also says that the Domain Name is not being used to divert traffic away from the Complainant because the Respondent's websites do not mention the Complaint, do not imply any association with the Complainant and are simply concerned with promoting the Respondent's business. Paragraph 4 of the Policy provides a non-exhaustive list of factors which may be evidence that the Domain Name is not an Abusive Registration. Relevant here is paragraph 4(a)(i)(A) which reads as follows;
- (i) *Before being aware of the Complainant's cause for complaint (not necessarily the "complaint" under the DRS), the Respondent:*

(a) used or made demonstrable preparations to use the Domain Name or a domain name which is similar to the Domain Name in connection with a genuine offering of goods and services”

- 6.26 This provision would certainly apply to the Respondent if I concluded that the Respondent’s registration of the Domain Name was not made in knowledge of what the Complainant was doing. If therefore the Respondent had simply thought that Regspec was a good name for a business, because for example he had previously worked for a business using the same name, then I think it very likely indeed that I would conclude that paragraph 4(a)(i)(A) of the Policy applied. However, having concluded, on the balance of probabilities, that the Respondent knew about the incorporation of the Complainant and/or the Complainant applying to register a trade mark for REGSPEC when he registered the Domain Name then I do not think the Respondent can avail itself of this provision. I am also assisted in this finding by the fact that the Respondent’s website does not make any reference whatsoever to Regspec as one would expect if the Respondent had genuinely believed that Regspec was a good name for his business. It is not conclusive but the fact that the Respondent only used the name or mark REGSPEC in the Domain Name is another factor which tends to lead me to conclude that the Domain Name is an Abusive Registration.
- 6.27 I am therefore not satisfied, on the balance of probabilities, that the Respondent has successfully rebutted my prima facie finding that the Complainant has established, on the balance of probabilities, that the Domain Name is an Abusive Registration

7. Decision

- 7.1 I find that, on the balance of probabilities, the Complainant has Rights in a name or mark which is identical or similar to the Domain Name and that the Domain Name is, in the hands of the Respondent, an Abusive Registration. I therefore direct that the Domain Name be transferred to the Complainant.

Signed: Nick Phillips

Dated: 5 September 2014