

Nominet UK Dispute Resolution Service

DRS 5400

Direct Wines Limited v Domain Administration Limited

Decision of Independent Expert

1. Parties

Complainant: Direct Wines Limited
Address: New Aquitaine House
Exeter Way
Theale
Reading
Postcode: RG7 4PL
Country: United Kingdom

Respondent: Domain Administration Limited
Address: PO Box 37410
Parnell
Auckland
Postcode: 1151
Country: New Zealand

2. Domain Name

laithewaites.co.uk ("the domain name")

3. Procedural Background

Hard copy of the complaint dated 23 January 2008 was received by Nominet on 28 January. Nominet checked that the complaint complied with the Dispute Resolution Service Policy ("the Policy") and with the Procedure for the conduct of proceedings under the Dispute Resolution Service ("the Procedure"). The complaint was supported by material in two annexes:

- A printouts with details of the Complainant's European and UK trademark registrations
- B printouts from the webpage at the domain name on 23 January 2008 and the webpages for two of the Complainant's competitors (to which the webpage at the domain name provides links)

Nominet notified the Respondent of the complaint on 29 January and informed it that it had 15 working days within which to lodge a response. No response was received. Mediation to resolve the dispute informally not being possible, on 21 February Nominet advised both parties that the dispute would be referred for an expert decision if it received the appropriate fee from the Complainant. The fee was received on 6 March.

On 11 March I, Mark de Brunner, agreed to serve as an Expert under Nominet's Dispute Resolution Policy and Procedure. I confirmed that I am independent of each of the parties, and that there are no facts or circumstances that might call into question my independence.

4. Outstanding Formal/Procedural Issues

There are no outstanding formal or procedural issues.

5. The Facts

I have visited the webpage at the domain name. From that visit, the complaint and the administrative information supplied routinely by Nominet, I accept the following as facts.

The Complainant was incorporated in February 1973. It was established by Tony Laithwaite and has been trading as 'Laithwaites' for more than 30 years. It is currently the largest mail order and online seller of wines in the UK. In 2007 it was named Independent Wine Merchant of the Year at the Decanter World Wine Awards.

The Complainant operates websites at laithwaites.co.uk and laithwaites.com. It holds trademarks for its trading name both in Europe (registered 21 December 2000) and in the UK (registered 26 June 2000).

The domain name at issue was registered on 25 May 2004. It resolves to a SEDO parking page containing website links generated by automated internet searches – including links to the Complainant's own website but also to competitors such as Winedirect and Winestore.

6. The Parties' Contentions

Complainant

The Complainant says it has built up goodwill and therefore acquired rights in the name 'laithwaites'. It says that the name in which it has rights is similar to the domain name.

It argues that the domain name is an abusive registration because:

- (i) the Respondent has been found to have made abusive registrations in ten Dispute Resolution Service (DRS) cases in the last two years. Under paragraph 3 c of the Policy there is therefore a presumption of abusive registration
- (ii) in twelve cases heard under the Uniform Dispute Resolution Procedure it has been found that the Respondent made a 'bad faith' registration
- (iii) the Respondent has no legitimate rights in 'laithwaites' and, in choosing a domain name similar to the Complainant's trading name, the Respondent is taking advantage of the Complainant's reputation
- (iv) the Respondent's use of the domain name, taking people to a page of links relating to the sale of wine, is bound to have caused internet users to be confused into thinking that the domain name is connected to the Complainant
- (v) the cases in which the Respondent has been found to have made an abusive registration all relate to domain names that are slight misspellings of well-known names in which the Respondent has no apparent rights

The Complainant lists the following DRS decisions in which it says the Respondent has been found to have made an abusive registration in the preceding two years:

Domain Name	Dispute Resolution Service Reference
healthcarecomission.org.uk	04437
electoralcommision.co.uk	04389
robertdyass.co.uk	04415
michalepage.co.uk	04344
hotwheel.co.uk	04298
fisherpice.co.uk	04293
learndirec.co.uklerandirect.co.uk	04292
myt-mobile.co.uk	04245
ulsterbankanytime.co.uk	04229
hotelconect.co.uk	04646

Respondent

There has been no response.

7. Discussion and Findings

'No response' cases

Where there is no response to a complaint, the approach to be taken by experts is now well-established. If the Complainant makes out a prima facie case, that case demands an answer. In the absence of an answer, the complaint will ordinarily succeed. The question therefore becomes whether the Complainant has made out a prima facie case.

General

To succeed in this complaint the Complainant must prove, on the balance of probabilities, that

- (i) it 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

The Complainant's unchallenged evidence is that it has been trading as 'Laithwaites' for more than 30 years and that it is the UK's largest mail order/online wine merchant. As such, it has clearly built up goodwill in its name. Beyond the unregistered rights established by the acquisition of that goodwill, the Complainant has registered rights represented by the trademarks it holds.

The Complainant has rights in 'laithwaites'. Ignoring the .co.uk suffix as simply a generic feature of the Nominet registry, the domain name is 'laithewaites'. 'Laithwaites' is similar to 'laithewaites'. I conclude that the Complainant has rights in respect of a name which is similar to the domain name.

Abusive Registration

The DRS rules define an abusive registration as a domain name which either

- (i) was registered or otherwise acquired in a manner which, at the time when the registration or acquisition took place, took unfair advantage of or was unfairly detrimental to the Complainant's rights; or
- (ii) has been used in a manner which took unfair advantage of or was unfairly detrimental to the Complainant's rights.

At the outset, the Complainant draws my attention to paragraph 3 c of the Policy. 3 c says that there is a presumption of abusive registration if the Complainant proves that the Respondent has been found to have made an abusive registration in three or more DRS cases in the two years before the complaint was filed. Paragraph 4 c says that, if that presumption applies, the Respondent 'must' rebut it by proving in the response that the registration of the domain name is not an abusive registration.

The Complainant does not make the point but, as the Respondent has not made any response, it cannot prove anything 'in the response'. It follows that, if paragraph 3 c applies, the presumption cannot be rebutted in the way the Policy requires. Where paragraph 3 c applies, the presumption of abusive registration must remain undisturbed.

The Complaint was filed on 28 January 2008. The Complainant includes a list of what it says are abusive registrations that the Respondent has been found to have made in the preceding two years. It has not shown the dates of the decisions, but I have checked them against the Nominet table to which that list refers (the table of cases in which the Respondent is or may be a party found to have made an abusive registration in three or more DRS cases). All fall within the period 11 January 2007 to 17 June 2007 (inclusive). All ten decisions are therefore findings of abusive registration in the two years before the complaint was filed.

I conclude that paragraph 3 c applies, that there is a presumption of abusive registration and that, because there has been no response, the presumption cannot be rebutted in the way the Policy requires. The presumption of abusive registration must stand.

Strictly, therefore, there is no need to consider any of the Complainant's other arguments. But for completeness, I will review them too.

The Complainant says that the Respondent has been found to have made twelve 'bad faith' registrations within the Uniform Dispute Resolution Procedure (UDRP). The UDRP is not identical to Nominet's DRS and it is used to settle disputes based on a different set of underlying rules. I must say therefore that I attach no significant weight to that, as a factor.

The Complainant's other arguments all relate to elements of the Policy's non-exhaustive list of factors that may be evidence that the domain name is an abusive registration. These factors include

- (i) circumstances indicating that the Respondent registered the domain name primarily...for the purpose of unfairly disrupting the business of the Complainant
- (ii) circumstances indicating that the Respondent is using the domain name in a way which has confused people or businesses into believing that the domain name is registered to, operated or authorised by, or otherwise connected with the Complainant
- (iii) where the Complainant can demonstrate that the Respondent is engaged in a pattern of registrations where the Respondent is the registrant of the domain names...which correspond to well known names or trade marks in which the Respondent has no apparent rights, and the domain name is part of that pattern.

I can take these in turn.

The Complainant says that the Respondent has no legitimate rights in the domain name and that, in choosing a name so similar to the Complainant's trading name, the Respondent is taking advantage of the Complainant's reputation. In the absence of evidence from the Respondent, that seems to me to be a strong argument: there does not appear to be any legitimate reason for the Respondent to select a name so nearly identical to the Complainant's trading name.

The Complainant offers no evidence of internet users having been confused into thinking that the domain name is connected to it, but the list of factors in the Policy is non-exhaustive, it seems clear that the risk of such confusion is high and I regard that level of risk as a material consideration.

I do think it is telling that many of the DRS decisions listed against the Respondent seem to involve domain names that are slight misspellings of well known names but that appear to have nothing to do with the Respondent – that is, the domain names correspond to well known names in which the Respondent has no apparent rights. The domain name at issue here looks to be part of precisely that pattern.

The Policy also contains a non-exhaustive list of factors that may be evidence that the domain name is not an abusive registration. These are where

- i) before being informed of the Complainant's cause for complaint, the Respondent has
 - (a) used the domain name in connection with a genuine offering of goods or services
 - (b) been commonly known by the name...which is identical or similar to the domain name
 - (c) made legitimate non-commercial or fair use of the domain name

or where

- (ii) the domain name is generic or descriptive and the Respondent is making fair use of it.

None of these seems to advance the Respondent's case. In particular, whether the Respondent has made 'fair' use of the domain name is for me to decide in the context of this decision.

The Respondent has chosen a domain name that is nearly identical to the Complainant's trading name, yet without any obvious legitimate reason for that choice. It has used that domain name to direct traffic to the Complainant's competitors. Even without the undisturbed presumption of abusive registration, both the registration and the use of the domain name look to take unfair advantage of the Complainant's rights. At the very least, there is a prima facie case that demands an answer. In the absence of an answer, the complaint succeeds.

8. Decision

I find that the Complainant has rights in respect of a name which is similar to the domain name and that the domain name, in the hands of the Respondent, is an abusive registration.

In the light of that, I direct that the domain name be transferred to the Complainant.

Mark de Brunner

21 March 2008