

DISPUTE RESOLUTION SERVICE

DRS 07005

Decision of Independent Expert

The Listed Property Owners Club

- and -

CPL Media

1. The Parties:

Complainant: The Listed Property Owners Club
Address: Lower Dane
Hartlip
Kent
Postcode: ME9 7TE
Country: UK

Respondent: CPL Media
Unit 7
Drywall Castle Road
Sittingbourne
Kent
Postcode: CT5 4QT
Country: UK

2. The Domain Name:

listedheritage.co.uk

3. Procedural History:

The Complaint was received by Nominet on 17 March 2009. Nominet validated the Complaint and sent a copy to the Respondent.

No Response was received by Nominet.

On 17 April 2009 the Complainant paid Nominet the required fee for a full decision of an Expert pursuant to the Nominet UK Dispute Resolution Service Policy ("the Policy").

Nominet invited the undersigned, Jason Rawkins ("the Expert"), to provide a decision on this case and duly appointed the undersigned as the Expert with effect from 29 April 2009.

4. **Factual Background and Findings:**

The Nominet records show that the Domain Name was registered on 5 March 2007.

Based on the Complainant's submissions (see section 5 below) and a review of the materials annexed to the Complaint, set out below are the main facts which I have accepted as being true in reaching a decision in this case:

- (1) The Complainant was established in 1993 and has, since April 2002, published a bi-monthly magazine called "Listed Heritage".
- (2) The Respondent had a relationship with the Complainant for approximately 12 months from around December 2003, printing and selling the advertising space in the Complainant's Listed Heritage magazine.
- (3) The home page of the website at www.listedheritage.co.uk is a page which promotes the Respondent's "Heritage Homes" magazine, which is a competitor with the Complainant's Listed Heritage magazine.
- (4) The Complainant has received an email from an employee of the Respondent purporting to be the editor of the Listed Heritage magazine.

5. **Parties' Contentions:**

Complainant:

The Complainant's submissions can be summarised as follows:

1. The Complainant has rights in trade marks/names which are identical or similar to the Domain Name:
 - (1) The Listed Property Owners Club was established in 1993 to provide advice, information and support to owners of listed properties. It has acquired substantial goodwill and reputation in its name during the past 16 years.
 - (2) Since its beginning The Listed Property Owners Club has published a newsletter, which evolved into a bi-monthly magazine. Since April 2002 the publication has been called Listed Heritage. Before this time it was simply called Heritage. However, the organisation felt there was potential confusion with English Heritage's publication so changed the name to Listed Heritage.

2. The Domain Name is an Abusive Registration in the hands of the Respondent:

- (1) The Listed Property Owners Club enlisted the help of CPL Media to print and sell the advertising space in the Listed Heritage magazine. They did this from issue 35 - 40, from approximately December 2003 until December 2004. The Listed Property Owners Club has never at any time transferred any rights or intellectual property attached to the "Listed Heritage" name to either CPL Media or any other parties.
- (2) Since ending its agreement with CPL Media there have been a number of companies confused about similarities between it and The Listed Property Owners Club.
- (3) The Listed Property Owners Club believes that the website using the Domain Name was registered by CPL Media purposely to create traffic for their company. This has caused confusion for customers because when the words "Listed Heritage" are searched for on the internet, the website www.listedheritage.co.uk appears first. This is compounded when the Internet users accessing the website are then taken to a page promoting the Heritage Homes magazine.
- (4) CPL Media is a competitor of The Listed Properties Owners Club with its publication Heritage Homes.
- (5) The Listed Property Owners Club has also received an e-mail from an employee of CPL Media claiming to be the Editor of the Listed Heritage magazine (copy email provided).

Respondent:

No Response has been filed by the Respondent. The lack of a Response does not mean that the Complainant wins by default. For the Complaint to succeed, the Complainant must still show on the balance of probabilities that its case satisfies the requirements of the Policy. Nevertheless paragraph 15c of the Dispute Resolution Service Procedure is of relevance. This provides as follows:

"If, in the absence of exceptional circumstances, a Party does not comply with any provision in the Policy or this Procedure or any request by us or the Expert, the Expert will draw such inferences from the Party's non compliance as he or she considers appropriate."

6. **Discussion and Findings:**

General

Paragraph 2 of the Policy provides that, to be successful, 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 (as defined in paragraph 1 of the Policy).*

Complainant's Rights

The Complainant's name "Listed Heritage" obviously has a descriptive meaning. It is therefore not inherently high up the scale of distinctiveness. As a result, in order to qualify for legal rights, sufficient use needs to have been made of the name for people to recognise it as belonging to the Complainant. In other words, it needs to have acquired what is known as "secondary meaning". In light of the Complainant's use of the name over a number of years, I am prepared to find on the balance of probabilities that it has established Rights in the nature of legally protectable goodwill in the name Listed Heritage, particularly in relation to magazines.

Disregarding the generic *.co.uk* suffix, the Domain Name is identical to that name. I therefore find that the first limb of paragraph 2 of the Policy is satisfied.

Abusive Registration

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

Paragraph 3 of the Policy sets out a non-exhaustive list of factors which may be evidence that a Domain Name is an Abusive Registration. The factor under paragraph 3a which is relevant in this case is 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;"*

The nature of the Domain Name itself, being identical to the magazine of the Complainant, means that it is likely that many people will go to *www.listedheritage.co.uk* expecting it to be the website of the Complainant. The home page of the website is such that there is nothing to make clear that the website does not belong to the Complainant. People could easily be confused into believing that the Heritage Homes magazine which is promoted there is another magazine of the Complainant or even the new name of the Listed Heritage magazine.

Even if some people would not be confused for very long after they reach the Respondent's website, initial confusion is almost inevitable. Some of those people, who are looking for a website for Listed Heritage and who come to the Respondent's site, will be tempted to remain on that site and to become interested in the Respondent's competitive publication, Heritage Homes. This is what is commonly known as "bait and

switch". As paragraph 15c of the Procedure entitles me to do, I infer from the Respondent not having filed a Response that this was its intention when registering the Domain Name and using it in this way.

In summary, relevant confusion is likely to be caused by the Respondent's use of the Domain Name, whether enduring or short-lived. That confusion will only be compounded by the fact that an employee of the Respondent has sent emails falsely suggesting that she is the editor of the Listed Heritage magazine.

Such confusion takes unfair advantage of the Complainant's Rights because it serves unfairly to attract people to the Respondent's alternative magazine offering. It is also unfairly detrimental to the Complainant's Rights because, when people are diverted in this way, they do not then reach the Complainant's website, which is what they were looking for. I am therefore satisfied that the Domain Name is an Abusive Registration.

7. Decision:

Having found that the Complainant has rights in respect a name or mark which is identical to the Domain Name and that the Domain Name in the hands of the Respondent is an Abusive Registration, the Expert directs that the Domain Name *listedheritage.co.uk* be transferred to the Complainant.

Jason Rawkins

21 May 2009