

Dispute Resolution Service

D00009322

Decision of Independent Expert

Viverdi Ltd

and

Miss Emma Shaw

1. Parties

Complainant : Viverdi Limited

Unit 54a, Aidan Court
Bede Industrial Estate
Jarrow
Tyne and Wear
NE32 3EF

United Kingdom

Respondent : Miss Emma Shaw

Paws Pet Supermarket
Communications House
26 York Street
London
W1U 6PZ

United Kingdom

2. Domain Name

pawspetsupermarket.co.uk (the "Domain Name")

3. Procedural Background

On 24th November 2010 the Complaint was lodged with Nominet UK Limited (“Nominet”) and was validated. On 24th November 2010 Nominet sent the notification of the complaint letter to the Respondent by e-mail and post, advising her to log into her account to view the details of the Complaint and giving her 15 working days within which to lodge a Response and which was to be on or before 16th December 2010.

The Respondent responded on 16th December 2010 and on the same day Nominet informed the Complainant that the Response was available to be viewed via the Complainant’s online services account. The Complainant replied to the Response on 24th December 2010 and Nominet informed the Respondent that the Reply was available to be viewed via the Respondent’s online services account. Mediation documents were generated for the Complaint and mediation first commenced on 5th January 2011. Mediation was unsuccessful and concluded on 7th April 2011.

On 8th April 2011 the Complainant paid the appropriate fee for a Decision by an Expert pursuant to paragraph 6 of Nominet’s DRS Policy (“the Policy”).

On 8th April 2011 Mr. Niall Lawless (“the Expert”) was selected and on 13th April 2011 was formally appointed to act as Expert in this dispute, having confirmed that he knew of no reason why he could not properly accept the appointment and knew of no matters which ought to be drawn to the attention of the parties which might appear to call in to question his impartiality and / or independence. He is required to give his Decision by 10th May 2011.

4. Outstanding Formal / Procedural Issues

There are no outstanding formal or procedural issues.

5. Factual background

The Complainant Viverdi Limited owns and operates an on-line pet supplies retail business trading under the name Pet Supermarket and using the domain names petsupermarket.co.uk and pet-supermarket.co.uk. In its 2009 financial year Pet Supermarket’s sales were over £5.3 million. On 6th March 2009 the Complainant applied to the Trade Marks Registry to register a series of three trademarks “PETSUPERMARKET”, “PET-SUPERMARKET” and “PET SUPERMARKET” under Class 20, 21, 31 and 35 and which were granted on 21st May 2010.

The Respondent Miss Emma Shaw is part of a family business which has been involved with the pet industry for over seventeen years. On 23rd September 2009 the Respondent registered pawspetsupermarket.co.uk to help it trade on-line.

The Complainant seeks transfer of the Domain Name to it.

6. The Parties' contentions

The Complainant

The Complainant says that the Domain Name controlled by the Respondent is an Abusive Registration under Nominet's Dispute Resolution Service Policy (the "Policy") because:-

- It has trademarked two domain names "pet-supermarket.co.uk" and "petsupermarket.co.uk" and has been granted Registered Trade Marks Rights to the words "Pet Supermarket".
- The Respondent's use of the Domain Name is inherently unfair in that its use is similar to the concept of an "instrument of fraud" as in the Court of Appeal Case *One in a Million*.
- It has invested heavily in developing the Pet Supermarket brand and it believes that the Respondent's use of the Domain Name takes unfair advantage of this.
- The Respondent's use of "petsupermarket" in the Domain Name is unfairly using the Complainant's brand which has "goodwill", a strong reputation and a large customer base.
- The Respondent's use of the Domain Name is causing confusion as the Complainant has received telephone calls from customers enquiring about products listed on the Respondent's website.
- Based on the Respondent's Paws Pets service the Complainant's Pet Supermarket has received reviews on Trustpilot, these have subsequently been removed.
- The Respondent's Search Engine Optimization (SEO) for her homepage is optimised around the trademark Pet Supermarket and if customers type this phrase into a search engine they will find a listing for the Respondent's website below the Complainant's. This has the effect of driving customers away from the Complainant's website causing it to lose money.

The Respondent

The Respondent says that the Domain Name controlled by her is not an Abusive Registration under Nominet's DRS Policy because :-

- The Respondent registered the Domain Name before the Complainant was granted its trademarks.
- The Respondent has been investing in her own branded products “Designs by Paws” and refers to her business as Paws, for example using “Paws” alone as her discount voucher codes. She says that she has invested heavily in the design and marketing of the Paws brand and promoted it to the public at countrywide shows and events.
- She does not in any circumstances use “Pet Supermarket” as part of her own branding.
- She does not use the term “Pet Supermarket” as part of the SEO.
- That the term “Pet Supermarket” is simply generic words used to describe a shop selling pet products and the Domain Name is generic or descriptive as set out in Nominet’s Dispute Resolution Service Policy (DRSP) Section 4 Paragraph ii and the Respondent is making fair use of it.

7. Discussions and Findings

7.1 General

The Policy requires that for a Complaint to succeed the Complainant must prove to the Expert on the balance of probabilities 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.

Rights include, but are not limited to, rights enforceable under English Law.

In order to show that the Domain Name is an Abusive Registration, the Complainant must prove that the Domain Name either:-

- i. 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.

The Complainant is required to prove to the Expert that the Complainant has Rights and that the Domain Name in the hands of the Respondent is an Abusive Registration; both elements must be present.

7.2 Complainant's Rights

The Complainant conducts substantial business under the name Pet Supermarket and it uses the domain names petsupermarket.co.uk and pet-supermarket.co.uk to support that business on-line. Additionally it has registered the trademarks "PETSUPERMARKET", "PET-SUPERMARKET" and "PET SUPERMARKET". Because of that I decide that the Complainant has Rights in respect of a name or mark which is similar to the Domain Name.

7.3 Abusive Registration

The Complainant says that the Domain Name controlled by the Respondent is an Abusive Registration under the Policy, but it does not state under which part of the Policy. Under Paragraph 3 - Evidence of Abusive Registration - guidance is given as to what factors may evidence that the Domain Name is an Abusive Registration.

"A non-exhaustive list of factors which may evidence that the Domain Name is an Abusive Registration is as follows :-

3(a)(i). Circumstances indicating that the Respondent has registered or otherwise acquired the Domain Name primarily :-

3(a)(i)(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;

3(a)(i)(B). as a blocking registration against a name or mark in which the Complainant has Rights; or

3(a)(i)(C). for the purpose of unfairly disrupting the business of the Complainant;

3(a)(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".

Of the above, the only potentially applicable example is 3(a)(ii).

Confusion

Although it does not provide any supporting evidence the Complainant says that the Respondent's use of the Domain Name is causing confusion as it has received telephone calls from customers enquiring about products listed on the Respondent's website and also that reviews concerning the Respondent's business were incorrectly listed on Trustpilot (which provides a service that allows consumers to assess the reliability of companies which they might purchase from).

The Respondent says that some confusion is just a normal part of business and that it would be an extremely rare event for a customer to be viewing a product on its website, then to leave that website and contact Pet Supermarket to purchase the product from them. The Respondent says that in the event this did happen that it confers an advantage to the Complainant as it has an opportunity to sell one of its own products.

Under the Policy one of the factors which may evidence that the Domain Name is an Abusive Registration is 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.

There is insufficient evidence before me to enable me to make any such finding.

Generic Words

The Respondent has clearly explained and justified why she selected the Domain Name. She says that she is investing in her own branded pet products "Designs by Paws" and when choosing the Domain Name searched for others which might have been suitable such as pawspets.co.uk, pawspetshop.co.uk and pawspetstore.co.uk, none of which were available.

The Complainant has registered trade-marks for Pet Supermarket and the name Pet Supermarket has a clear association with its aim "*to provide delivery of the widest range of pet products, providing all of its customers with exceptional value without any compromise on quality with every order*".

However, as the name Pet Supermarket comprises generic words (as discussed in DRS 04884 Maestro International, Inc -v- Mark Adams) the trade-mark or goodwill is not in itself enough to

provide the Complainant with a monopoly in the term for all purposes or exclusivity in it for the purposes of domain name registrations. For example, if the trade mark in question was “foodsupermarket” that would not be sufficient to inhibit registration of domain names such as indianfoodsupermarket.co.uk or petersfoodsupermarket.co.uk.

Search Engine Optimization

The Complainant says that the Respondent’s Search Engine Optimization (SEO) for its homepage is optimised around the trademark Pet Supermarket.

The Respondent says that it is not using the term “Pet Supermarket” as part of its SEO.

As the source code of the homepage resolved by the Domain Name shows the meta name keywords to be “*pet, shop online, pawspetsupermarket.co.uk, cat, dog bird, aquarium, reptile, products, wild bird, pond fish, glamorous dog, Christmas pet, UK pet*”, I agree with the Respondent.

Trade-mark and One in a Million

The Complainant says that it has trademarked two domain names “pet-supermarket.co.uk” and “petsupermarket.co.uk” but it provides no evidence as to what this is or what it means. It says that it has been granted Registered Trade Marks Rights to the words “Pet Supermarket” and confirms this by providing a copy of its Trade Marks Registry Registration Certificate dated 21st May 2010.

As a Nominet Expert I am not under duty to consider whether or not the Respondent’s activities amount to a violation of the Complainant’s trade-mark. Expert Decisions are to be determined by reference to Nominet’s DRS Policy and not the law in respect of trade-mark infringement, for example as decided in Deutsche Telekom AG v Lammtara Multiserve Limited Appeal Decision (DRS 05856).

The Complainant says that the Respondent’s use of the Domain Name is inherently unfair in that the use is similar to the concept of an “instrument of fraud” described in the Court of Appeal Case *One in a Million*. In the Complainant’s 29th January 2010 letter to the Respondent, Ward Hadaway, its solicitors wrote “*In the circumstances, we have advised our client that it is entitled to bring legal proceedings against you for passing off and to claim the remedies of injunction, damages or an account of profits, legal costs and interest*”. If passing off (or trade-mark infringement) is a pressing concern the Complainant has the option of pursuing the matter in the English Court which it has not

done. It is not the role of Nominet's DRS to act as a potential substitute for litigation in relation to all domain name disputes, only those falling within the narrow confines of the Policy.

7.4 Conclusion

The Expert finds on the balance of probabilities that the Complainant has Rights in respect of a name or mark which is identical or similar to the Domain Name. However, the Complainant has not proved, on the balance of probabilities, that the Domain Name in the control of the Respondent is an Abusive Registration.

8. Decision

For the reasons set out in detail above, having decided that the Domain Name in the hands of the Respondent is not an Abusive Registration, the Expert directs that no action is required.

Niall Lawless, Nominet Expert

3rd May 2011