

DISPUTE RESOLUTION SERVICE

D00010124

Decision of Independent Expert

Save Your Sole Limited t/a Red Soles

and

Mr Mike Barnett

1. The Parties:

Lead Complainant: Save Your Sole Limited t/a Red Soles
PO Box 60583
London
W2 7PS
United Kingdom

Respondent: Mr Mike Barnett
8 Sevenoaks Drive
Bournemouth
Dorset
BH7 7JG
United Kingdom

2. The Domain Name(s):

red-soles.co.uk (the Disputed Domain)

3. Procedural History:

25 July 2011 13:05 Dispute received
26 July 2011 11:12 Complaint validated
26 July 2011 11:28 Notification of complaint sent to parties
01 August 2011 09:57 Response received
01 August 2011 09:57 Notification of response sent to parties

04 August 2011 06:07 Reply reminder sent
08 August 2011 10:17 Reply received
09 August 2011 11:59 Notification of reply sent to parties
12 August 2011 09:26 Mediator appointed
12 August 2011 11:12 Mediation started
31 August 2011 13:45 Mediation failed
31 August 2011 13:47 Close of mediation documents sent
06 September 2011 08:53 Expert decision payment received
14 September 2011 Michael Silverleaf appointed as expert
23 September 2011 Decision issued

4. Factual Background

4.1 The complainant is the owner of the domain name redsoles.co.uk through which it has traded according to the complaint since 2008 (the complaint does not specify precisely when). The complainant was apparently incorporated as Red Soles Limited and changed its name to the present one on 7 September 2009. No reason has been given by the complainant why it changed its name when it continued to trade under the name Red Soles.

4.2 The complainant says that when it began trading in 2008 it was the first company to sell red soles online and that it has later added red sole paint for women's shoes. The complainant explains that in the first six months trading it spent about £1000 on online marketing to build its reputation. Since then it has spent more than £20,000 in marketing and advertising to alert customers to its products.

4.3 The complainant claims that as a result of its activities it now has a significant reputation worldwide in relation to designer shoe repair for red soled shoes as the first and premier provider of these products.

4.4 The complainant makes no mention in the complaint of the fact that it is well known that Christian Louboutin shoes characteristically have red soles, even though its website specifically refers to its products being for Christian Louboutin or Cesare Paciotti soles. I note that in order to ascertain this information I had to visit the complainant's website: it does not appear on the part of the homepage that was annexed to the complaint.

4.5 I am aware that there are ongoing trade mark disputes between Christian Louboutin and others over the rights to red soles as a trade

mark. That, however, does not appear to me affect the decision I am asked to make in this case for the reasons which I explain below.

4.6 The respondent also sells red sole products online for repairing red-soled designer shoes. Its website mentions Christian Louboutin at the top of the homepage. This can be seen on the copy annexed to the complaint. The respondent started its business earlier this year and was quickly the subject of complaint from the complainant.

4.7 The respondent claims to have built up a substantial client base in the last four months, denies any intention to confuse and says that its primary purpose is to offer genuine products and services to people who own red-soled shoes. It says that its listing text is different from that of the complainant and that the domain name is “generic and descriptive”. It claims to be making fair use of it.

5. Parties’ Contentions

5.1 As can be seen from the outline of the facts in the previous section of this decision, the contest between the parties is whether the Disputed Domain is distinctive of the complainant or, as the respondent claims, descriptive and generic.

6. Discussions and Findings

6.1 The version of the DRS Policy relevant to the present dispute is version 3 which relates to complaints lodged after 29 July 2008.

Paragraph 1 of that 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”

6.2 Paragraph 1 of the DRS Policy also defines “Rights” for the purposes of this procedure as

“rights enforceable by the Complainant, whether under English law or otherwise, and may include rights in descriptive terms which have acquired a secondary meaning.”

Under Paragraph 2 of the DRS Policy a complainant must show on the balance of probabilities

- (a) that it has Rights in a name or mark identical or similar to the Domain Name; and
- (b) that the Domain Name in the hands of the Respondent is an Abusive Registration.

6.3 Paragraph 3 of the DRS Policy identifies a non-exhaustive list of factors which may be evidence that the domain name is an Abusive Registration. The relevant factors for the purposes of the present case are

- “(a)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;
 - B. as a blocking registration against a name or mark in which the Complainant has Rights; ...
- 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 remaining factors are not relevant in the present case. I have accordingly taken the above factors into account in reaching my conclusions.

6.4 Clause 4 of the DRS Policy sets out a non-exhaustive list of factors which may be evidence that the Domain Name is not an Abusive Registration. These include the following which are relevant to the present case:

- “(a)i. Before being aware of the Complainant’s cause for complaint (not necessarily the ‘complaint’ under the DRS) the Respondent has:
 - A. used or made demonstrable preparations to use the Domain Name as a domain name which is similar to the Domain Name in connection with a genuine offering of goods or services;
 - ...
 - C. made legitimate non-commercial or fair use of the Domain Name.
 - ...

6.5 According to the Appeal Panel decision in the *Seiko* case (DRS 00248) whether a registration is an abusive registration under the DRS Policy is independent of whether a domain registration is an infringement of trade mark and should be decided under the terms of the DRS Policy alone. The same decision also makes clear, however, that the relevant principles of English law should be applied in determining whether the Complainant has Rights under the Policy and that the Policy is founded on the principle of intellectual property rights which should be taken into account.

6.6 In this context, the reference to “secondary meaning” in the definition of rights (see 6.2 above) is particularly relevant to the present case. Under English law a claimant may establish a claim of passing off by demonstrating that a prima facie descriptive term has become by reason of the use that he has made of it in trade distinctive of his goods or service rather than merely bearing its primary descriptive meaning. A classic example is the *Jif* plastic lemon as a container for lemon juice. In order to establish that a descriptive name or mark has acquired a secondary meaning, it is necessary to demonstrate that customers and potential customers for the goods or services in issue recognise the apparently descriptive term as in fact designating such goods or services associated with a particular trader. The evidence in the *Jif* lemon case established precisely that: members of the public who bought the competitor’s product believed, even though it had another name on it, that it was a *Jif* lemon.

6.7 To demonstrate that a descriptive term has acquired a secondary meaning requires considerably more than mere evidence that it has been used: use may be either descriptive or use as branding, or a combination of the two; and it takes considerable publicity and public education to produce in the public consciousness a belief that an apparently descriptive name is in fact associated with a particular trader.

6.8 With these principles in mind, I turn to the first question in any DRS complaint: whether the complainant has Rights. This, as has been said in many cases, is a low threshold test. The present case, however, is one of those rare DRS disputes in which in my view the complainant fails to meet the threshold. The reason for this is simple. The name “red soles” is highly, indeed virtually entirely, descriptive of the products and services provided by the complainant. The mark is not and, in the light of the multiple prior claims which already exist, could not be registered as a trade mark by the complainant.

6.9 The complainant in the present case asserts that the name red soles has become distinctive of it but provides not a shred of actual evidence to support the claim. No details of any kind have been given of the claimed marketing and advertising except that “a significant amount of these funds have been spent in directing people to www.redsoles.co.uk”. I suspect that this means that most of the money has been spent on Google Adwords. The use of Google Adwords (assuming that is what has been done) is wholly insufficient to generate the necessary appreciation by the public that the name red soles identifies a particular source rather than the product.

6.10 I note that no details of any kind have been given of the claimed “worldwide” reputation which is, therefore, just that, a claim. I have no basis for concluding that the claim could be substantiated. It is worth noting that the complainant asserts that its business has fallen since the respondent began trading from 6-8 sales per month to 2 sales per month. The minuscule level of sales at the outset is perhaps a good indicator of the likelihood that the claim to worldwide reputation is justified.

6.11 The complainant’s difficulties in this case do not end there. As I have noted above, Christian Louboutin and other designer shoe manufacturers already make claims to the distinctiveness of red soles for their products. In the light of this and of the fact that the complainant itself expressly asserts on its website that it is providing materials and services to repair such shoes, I cannot begin to see how the complainant could ever demonstrate that the name red soles was distinctive of it rather than descriptive of its goods and services. It claims that it is using the name red soles distinctively. In truth it is using it wholly descriptively.

6.12 The complainant cannot therefore make out its claim that the Disputed Domain is being used deceptively. There is no reputation in the name which could lead to deception. Accordingly, the complaint that the respondent is causing confusion by use of the Disputed Domain fails.

6.13 Further, it is a pre-requisite of a finding that a domain name is an Abusive Registration under paragraph 3 (other than paragraph 3(a)(iv)) of the DRS Policy that the respondent had some prior knowledge of the complainant’s rights in the Disputed Domain: see the Appeal Panel decision in *Verbatim* (DRS 4331). The requisite knowledge can be inferred in an appropriate case. In the present case,

however, it seems to me that the complainant at least has to allege some facts from which the appropriate conclusion could be drawn. It has not attempted to do so. Accordingly, the complaint must fail on this ground also.

6.14 I accordingly conclude that the registration of the Disputed Domain is not an Abusive Registration.

7. Decision

7.1 I direct that no action is taken on this complaint.

Signed Michael Silverleaf

Dated 29 September 2011