

DISPUTE RESOLUTION SERVICE

D00013061

Decision of Independent Expert

Orbital Design Ltd

and

Mr Christopher Thew

The Parties:

Lead Complainant: Orbital Design Ltd

2 Churchill Court

Bournemouth

Dorset

BH1 4HN

United Kingdom

Respondent: Mr Christopher Thew

2, Highfield Park

Rossendale

Lancashire

BB4 4BH

United Kingdom

The Domain Name

orbitaldesign.co.uk

Procedural History

1. 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 such a nature as to call in to question my independence in the eyes of one or both of the parties.

09 July 2013 Dispute received.

10 July 2013 Complaint validated and parties notified of complaint.

16 July 2013 Response received and parties notified of response.

19 July 2013 Reply reminder sent.

23 July 2013 Reply received.

24 July 2013 Notification of reply sent to parties and mediator appointed.

29 July 2013 Mediation started.

30 August 2013 Mediation failed.

2. Each party provided a written submission pursuant to paragraph 13b. of the DRS procedure (“the Procedure”), the ‘explanatory’ paragraph of which was supplied to me. Having considered those paragraphs, I considered it appropriate to see the full submission of each side. Having considered each submission, a direction was issued at my request pursuant to paragraph 13a. of the Procedure and communicated to the parties by Nominet on 25 September 2013. The direction was in the following terms, -

'1. Each side may provide a written response to the paragraph 13b submission of the other according to the following timetable;
if possible, by 12 noon on Monday 30 September 2013 and in any event by 12 noon on Thursday, 3 October 2013; and if no such

response is to be submitted, the party in question to so notify Nominet by 12 noon on Monday 30 September 2013.

2. The Complainant alleges that, 'Earlier this year one of our staff picked up on the site following a search for 'Orbital Design' and found that the site had changed and was now trading very much in the style of 'Orbital Design' (Complaint). The Respondent alleges that the two sites are very different and no-one would be misled into believing that there was a connection between the two businesses.

Each side is directed to produce by the time specified in paragraph 1 above such information and documents (particularly web-pages) as are available to it and also point to documents so far produced by it or the other in these DRS proceedings as will enable the Expert to make a comparison between the content of the two websites during 2013.'

The parties provided further information and documents in response to the direction made under paragraph 13a., which were forwarded to me by Nominet on 1 October 2013. As potentially significant documents were produced for the first time, a further direction was issued by Nominet at my request: that each side be invited to provide a second Paragraph 13a. Submission by 12 noon on Friday, 4 October 2013 "limited to the issue of whether or not the respondent has changed his use of the domain name to take advantage of the complainant's rights". Brief Paragraph 13a Submissions were provided by each side and forwarded to me by Nominet on 4 October 2013.

Factual Background

3. The Complainant, Orbital Design Ltd ("ODL") was incorporated on 6 September 1999, trading as 'Orbital Design', and carries on business from Bournemouth in the supply of marketing and advertising services, including graphic design and web design. It operates a web site at 'orbital.co.uk', which was first registered on 14 July 2005. The Respondent, Christopher Thew ("Mr Thew") incorporated Chris Thew Design and Print Ltd ("CTDP") on 7 April

2003 trading as Orbital Design from Rossendale, Lancashire in the fields of graphic design and printing services. The Domain Name was first registered in July 2003¹.

Parties' Contentions

The Complaint

4. ODL alleges as follows, -
 - 4.1 It was incorporated on 6 September 1999. It supplies advertising and marketing services including graphic design and web site design. The company is based in Bournemouth and has many large corporate clients as well as smaller local and national clients. Its turnover is approximately £500,000 per annum.
 - 4.2 ODL has traded under the name of Orbital Design for 14 years and is well known as 'Orbital' and 'Orbital Design' by its clients.
 - 4.3 The company operates a web site at 'orbital.co.uk' and registered 'Orbital Design' as a trade mark in classes 35 and 42 (advertising and marketing, graphic design, web design, etc) on 31 January 2013. The registration was made to protect the business from many other businesses that have used the words 'Orbital Design' in the past 14 years. The trade mark is used in advertising, on the company's work product, its literature, stationery and web site.
 - 4.4 The Domain Name was registered in the name of Mr Thew on 19 July 2003. Until about 2007 the Domain Name hosted a web site which simply pointed to a holding page.

¹ It is unnecessary to make a finding as to which date in July, the parties differing by 10 days as to the date of registration. Nothing turns on the date in July,

- 4.5 In about 2007 the Respondent's web site changed to the appearance of a web site offering mainly printing services. There was some confusion among actual and prospective clients of ODL as a result of their visiting that web site, but the 'print-heavy' style of the design was not 'so much' in conflict with ODL. The name used on the Respondent's web site did not contain the word 'orbital' or any derivative of that word. The word 'Orbital' was not prominent on the site, which referred to something like 'printing.co.uk'.
- 4.6 ODL received emails intended for Mr Thew and ODL corresponded with him as a result. However, earlier in 2013 it became apparent that the Respondent's site had changed and was trading very much in the style of 'Orbital Design'. It was this that prompted the company to register the trade mark.
- 4.7 The Respondent is unfairly gaining an advantage from ODL's good name and that the web site is confusing to its clients and prospective customers, which diminishes ODL's credibility and adversely affects the good will value of ODL's business.

The Response

5. In the Response Mr Thew alleges as follows, -
- 5.1 He incorporated CTDP on 7 April 2003 and it started trading in July of that year. After researching and developing a business identity, the trading name 'Orbital Design' was chosen and the Domain Name was registered on 29 July 2003.
- 5.2 Mr Thew developed a web site with a distinct identity, which showed examples of the company's work in the fields of graphic design and solutions for printing. There have been various incarnations of the web site over the past 10 years, though consistently indicating CTDP's

primary business of graphic design, as shown by examples taken from the Way Back Machine annexed to the Response.

- 5.3 After a few years the Respondent and his company became aware of ODL when an email was received addressed to Justin Smith. This was forwarded on to him and there was a brief exchange of emails with him. In the past 10 years only 5 or 6 emails have been received in error, including one which was received in 2013. However, the identity of the intended recipient was not clear and it may have been for a different 'Orbital' altogether.
- 5.4 Mr Thew's business took a franchise in a printing business called printing.com and the brand guidelines required that the printing.com logo had to sit alongside the 'Orbital Design' logo. Printing.com remains an important part of the company's business.
- 5.5 A franchise of printing.com covers a particular geographical area. In 2011 another printing.com franchise was acquired and at this point a rebrand was undertaken, as shown in the screenshots copies of which are annexed to the Response.
- 5.6 Over the past 10 years CTDP has worked for 2000 companies, which know its business as Orbital Design. The company has 5 employees and acquires new customers at an average rate of 15 each month. The majority of its clients are based in the northwest of England, though it has other customers such as Asda, the NHS and Members of Parliament.
- 5.7 Neither the Respondent nor CTDP has ever pretended to be another business. It is clear on the company's web site who it is, where the company carries on business and the nature of the business: graphic design and print solutions.

- 5.8 The supporting evidence shows that at the time when CTDP was incorporated and when the Domain Name was first registered by Mr Thew, ODL's web site was offering software solutions, first called 'Orbital Software' and later 'Sopheon'.
- 5.9 In summary, the company has been carrying on business for 10 years and is known to thousands as Orbital Design, the name used in CTDP's advertising and other commercial communications. ODL and CTDP have co-existed for 10 years and there is no reason why this should not continue. CTDP does not operate, advertise or actively seek business outside its geographical location. The Domain Name should remain the property of the company as the registration was fair and is used in a non-abusive manner.

The Reply

6. The Reply alleges, -

- 6.1 Following its incorporation in 1999, ODL operated the domain name orbital-web.co.uk. The Domain Name was not available at the time.
- 6.2 The points about the software business are not accepted. These were trading names or brands owned or used by the previous owners of orbital.co.uk, which was purchased by ODL in 2005.
- 6.3 ODL employs 10 staff and has some 250 customers, including many 'blue chip' international businesses.
- 6.4 ODL owns the rights to Orbital Design as a registered trade mark and Mr Thew does not have the right to use this name for his business. Its use is an abusive registration in that it is confusing both existing customers of ODL and potential customers looking for the company online.

Complainant's Paragraph 13b Submission

7. In its submission made pursuant to paragraph 13b. of the DRS Procedure, the Complainant supplemented its case as follows, -

7.1 In addition to operating its web site at 'orbital.co.uk', it owns the Twitter account '@orbital design' and the Facebook page 'orbitaldesignltd'.

7.2 ODL's business is based in Bournemouth but is global and is not confined to one area, unlike the Respondent and his business. The vast majority of ODL's turnover comes from clients in London, Paris and the USA. However, a web site is a global presence and an actual or potential customer of ODL will not know the difference between Bournemouth and Rossendale (where Mr Thew's business is based).

7.3 ODL says that the registration and use of the Domain Name is abusive as a result of paragraph 3.ii. of the DRS Policy ('the Policy'): confusion.

7.4 In the 6 years or so that ODL has been aware of the Respondent's business it has received a number of telephone calls and emails intended for Mr Thew, the last call being two weeks ago. A number of ODL's clients have stated that they had found the Respondent's web site via web searches only to be confused with who they had found and could not understand how there can be two similar businesses operating with the same name. There are 2 clients in particular who have been 'caught out' by the Domain Name. A number of ODL's suppliers have informed it that there is another company with the same name; and even Mr Thew in his Response mentions an email he received that was intended for ODL.

7.5 Mr Thew's registration of the Domain Name causes confusion, which may be causing financial loss by potential customers visiting the wrong

web site: seeing a local print shop instead of an international creative agency. Also, suppliers see a company based in Lancashire whereas ODL is based in Bournemouth. If unresolved, this confusion will make ODL difficult to sell as a business.

- 7.6 ODL's international business will likely be damaged by the confusion. If a potential customer wished to act on a recommendation, that person would make an online search and would not necessarily know where in the UK ODL is located. The first impression they would get is of Mr Thew's business, which looks like a local print shop and not an international creative agency. Once this impression has been made, and people being busy as they are, they would be unlikely to look further: see the search statistics from Google Analytics.
- 7.7 In further rebuttal of Mr Thew's point about ODL starting as a software business, it never was such and has always been a graphic design, advertising and web design company.
- 7.8 Mr Thew should have performed due diligence before selecting the name of his business. ODL had been in business for 3 and a half years by the time Mr Thew decided to call his business Orbital Design. Had he checked at Companies House he would have found that there was already a business registered as Orbital Design Ltd and the company's Memorandum of Association made clear the nature of its business.
- 7.9 Had Mr Thew performed a web search on Orbital Design he would have found ODL's web site and seen that the company operates wholly in the fields of marketing, graphic design, advertising and web design.
- 7.10 By the time that Mr Thew decided to call his business Orbital Design, ODL had gained a significant reputation and goodwill in the UK and globally.

7.11 Mr Thew's use of the Domain Name is not malicious, and not even deliberate, but it is abusive in that he does not have the rights to the name Orbital Design since ODL was the originator of the name Orbital Design (unregistered trade mark rights), ODL is the owner of the registered trade mark, and given the global nature of the internet the locality for 'passing off' should be seen as the UK as a whole. There is also evidence of ongoing confusion between the two companies.

The Respondent's Paragraph 13b. Submission

8. In his Paragraph 13b. Submission Mr Thew made the following further points,

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8.1 Under the Policy, ODL must show that the Domain Name either took unfair advantage of or was unfairly detrimental to its rights at the time of registration; or has been used in a manner which takes unfair advantage of or has been unfairly detrimental to its rights.

8.2 At the time his company started trading Mr Thew was unaware of any potential for conflict with ODL, especially as it appeared to be a software company.

8.3 He has been advised that in the 10 years to 31 January 2013 his company has acquired a significant reputation and goodwill in the Lancashire area, with over 2000 customers; and that this would be sufficient to prevent any other third party by the law of passing off from operating in the Lancashire area trading using the name Orbital and offering design and printing services.

8.4 Advice has also been given that these unregistered rights would afford a defence to infringement under section 11(3) of the Trade Marks Act.

8.5 It is also unlikely that ODL could show as at 2003 that it had sufficient goodwill throughout the UK to have prevented Mr Thew's company

from using the mark at the date of its first use. There are also serious questions for the Complainant to answer if it is to establish pre-existing rights in passing off before, or as at, 2003.

- 8.6 On the issues of confusion and misrepresentation, when a Google search is carried out for 'Orbital Design', the link reads as follows, 'Welcome to Orbital Design, Graphic Designers in Rossendale, Lancashire and printers part of Printing.com ...'. The geographical link is made clear on the Respondent's web site. Hence, a third party would continue looking for the Bournemouth business.
- 8.7 Moreover, the visitor to the Respondent's site would see that Mr Thew's company does not offer web site design, which is the sole business of ODL, and hence capture of that customer would not be possible.
- 8.8 Since the Respondent's web site has always been clearly targeted at third parties requiring design and print services in the Lancashire area, there has been no allusion to a connection with ODL's business. The use has remained the same. There has never been an attempt to expand into web site design services. And there has never been any deception of customers. By contrast, it appears that ODL did not offer design services until their change of business in 2005.
- 8.9 The Respondent can also show that it made preparations to use the domain name for a legitimate business for the purposes of the Policy; indeed, it has been using the Domain Name for its own business purposes for 10 years.
- 8.10 There is no scope for confusion and the reasonably observant third party who visited the Respondent's web site in error would immediately leave the site and continue to search for ODL's web site.

Complainant's Paragraph 13a Submission (1)

9. The following is a summary of the additional points made on behalf of ODL in its first Paragraph 13a Submission -
 - 9.1 From the outset ODL was a marketing, graphic design, advertising and web design company, as shown by a screenshot of its web site as it stood on 18 July 2003.
 - 9.2 The vast majority of ODL's clients are in the USA, Paris and London. It operates in no specific local territory, unlike the Respondent. The reputation of ODL's business is stronger than Mr Thew's local business. ODL's client list shows the extent of its UK goodwill and goodwill elsewhere in 2005.
 - 9.3 In 2007 Mr Thew did offer web site design services contrary to his assertion above, as can be seen on the 'design' page of his 2007 site (see web.archive.org).
 - 9.4 Although Mr Thew did not intentionally target the Complainant's business when he registered the Domain Name, his lack of due diligence has caused the present problem. He is now causing confusion within the meaning of the Policy and his registration is abusive because it infringes ODL's registered and unregistered trade mark rights.
 - 9.5 ODL has recently updated its web site to a format that has been in development for 12 months, but this has not been in response to Mr Thew's web site.
 - 9.6 The form of Mr Thew's web site in 2007 was that the name Orbital Design was used in the introductory paragraph only, with the printing.com logo. The site gave the impression of a high street print shop with a small design service on the side.

- 9.7 Moving on to 2013, ODL noticed that there is much more emphasis on design services. Now there are 4 main bullet points on the site: creative design, branding, advertising, full colour print. That has decisively swung the emphasis away from printing services to design services. There is now a portfolio link on the home page, with a comprehensive list of items presumably designed and printed by Mr Thew's business. The design page now has 4 sub pages and the print page retains 14 sub pages. The Printing.com logo has reduced in size and the Orbital logo has greatly increased.
- 9.8 Therefore, the 'design' emphasis has changed markedly between the 2007 site and the 2012/2013 site. It is this change that positions Mr Thew's business in direct competition with ODL and causes confusion. His is looking more like a design agency called Orbital Design, rather than a print shop called Printing.com.
- 9.9 ODL offers creative services across the board: brand development, literature design, photography, advertising, print management, marketing strategy, etc. Many of the services provided by each company now overlap.

Respondent's Paragraph 13a Submissions (1)

10. The following is a summary of the additional points made by Mr Thew in his first Paragraph 13a Submissions, -
- 10.1 Screen shots of the company's web site over the past few years accompanying this submission show the consistent use of the Orbital Design logo and later printing.com.
- 10.2 The web site has always been branded as Orbital Design in various styles and colours to match the companies branding at the time.

10.3 The company became the printing.com franchisee for Rossendale and Accrington, both in Lancashire. Printing.com franchisees are known as 'printing.com @ company name'. Between 2007 and 2010 the web site reflected this convention in the use of the two logos together. This was done to promote the partnership with printing.com and the increased product offering.

10.4 As part of a rebranding in 2010, the company designed its literature and web site to reflect its main brand Orbital Design, while also showing the printing.com branding and listing their products on the web site.

Complainant's Paragraph 13a Submissions (2)

11. The following is a summary of this submission, -

11.1 As for earlier iterations of Mr Thew's web site, ODL was unaware of his business in its earlier years. Had ODL known at the time that he was actively promoting exactly the same business services as it, under the very same company name, a DRS Complaint would have been lodged at the time.

11.2 In the earlier years Mr Thew was abusing ODL's rights and now, since the design change of 2012, he is doing it again.

Respondent's Paragraph 13(a) Submissions (2)

12. The following is a summary of this submission, -

12.1 As the screenshots provided by each side illustrate, Mr Thew's business has always offered graphic design and printing services. The design and branding may have changed over the years, but the services offered have always remained the same.

- 12.2 Between 2003 and 2007, Mr Thew's web sites were focused on design services showing examples of work, with print management as an additional service, sourced from local print suppliers.
- 12.3 Even when CTDL became part of the printing.com franchise in 2007 graphic design remained the company's core business, but from that time it was able to offer a huge range of printed products in addition.
- 12.4 In 2010, as the business had evolved and grown considerably, CTDP again redesigned its logo and branding, adding more examples of design work to its website, while clearly indicating our association with printing.com and still listing the products and offers available.
- 12.5 In summary, the business has grown over the last 10 years, and the branding, identity and web site have changed to reflect this. The Domain Name, however, has always pointed to a graphic design and printing company.

Discussion and Findings

13. The Complainant is required under subparagraphs 2a. and 2b. of the Policy to prove to the Expert on the balance of probabilities that: -
- 13.1 he has Rights in respect of a name or mark which is identical or similar to the Domain Name; and
- 13.2 the Domain Name, in the hands of the Respondent, is an Abusive Registration.
- . I refer to the matters set out in paragraph 3 above and adopt them as findings of fact.

Rights

14. By paragraph 1 of the Policy, -

‘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.’

15. ODL owns the UK trade mark ‘Orbital Design’ no: UK00002650688, registered in classes 35 (advertising and marketing) and 42 (graphic design and other related services). The trade mark was first registered on 31 January 2013.

16. ODL has not established on the balance of probabilities on the evidence it has provided that it has rights to sustain a claim in passing off. In view of the existence of many other businesses trading as Orbital Design over the past 14 years (details of which have not been provided) including CTDP, I am not satisfied that the name Orbital Design carries with it the necessary degree of distinctiveness so as to be understood to refer exclusively to the services provided by ODL.

17. Nonetheless, ODL has shown that it owns the registered trade mark ‘Orbital Design’ and that it is identical or similar to the Domain Name. Therefore, ODL has Rights for the purposes of the Policy.

Abusive Registration

18. By paragraph 1 of the Policy, -

‘Abusive Registration means 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.'

By paragraph 3 of the Policy, -

'3. Evidence of Abusive Registration

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

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; or

C. for the purpose of unfairly disrupting the business of the Complainant;

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;

iii.;

v.

b. Failure on the Respondent's part to use the Domain Name for the purposes of email or a web site is not in itself evidence that the Domain Name is an Abusive Registration.

c.'

By paragraph 4 of the Policy, -

‘4. How the Respondent may demonstrate in its response that the Domain Name is not an Abusive Registration

a. A non-exhaustive list of factors which may be evidence that the Domain Name is not an Abusive Registration is as follows:

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 or a domain name which is similar to the Domain Name in connection with a genuine offering of goods or services;

B. been commonly known by the name or legitimately connected with a mark which is identical or similar to the Domain Name;

C. made legitimate non-commercial or fair use of the Domain Name;
or

ii.

19. All the facts, matters and submissions relied on by each side have been taken into account in my findings on the issue of Abusive Registration. The findings set out below are limited to those necessary to resolve that issue.
20. The abuse relied on by ODL derives from paragraphs 1.ii. (use) and 3.a.ii. of the Policy (confusion). Although ODL has not advanced a case based on the original registration of the Domain Name and has expressly acquitted Mr Thew of targeting his business when he registered it, the circumstances of that registration are relevant in determining the issues in this dispute, particularly in view of Mr Thew's case under paragraph 4 of the Policy.
21. Mr Thew incorporated CTDP on 7 April 2003 and started trading in July of that year. After researching and developing a business identity, the trading name 'Orbital Design' was chosen and the Domain Name was registered.
22. ODL was known as 'Orbital' and 'Orbital Design' by its customers from the time when it first started trading in 1999.

23. I accept that Mr Thew was not aware of ODL or its business at the time he chose Orbital Design as the trading name of his company, CTDP. The domain name orbital.co.uk appeared to be a software company and the Domain Name he registered was available for registration. Although I accept that this had been the use of the seller of the orbital.co.uk domain name, the point is that a third party such as Mr Thew would not have known from that web site that there was another business in the field of graphic design trading as Orbital Design. Thus, screen shots from the Wayback Machine produced by ODL show that orbital.co.uk was being used to promote a computer software business on 1 January 2004; and this is likely to have been the case until ODL purchased that domain name in 2005.
24. True it is that Mr Thew would have discovered the name ODL and the nature of its trading activities had he conducted further searches. However, the name of his company was very different to ODL, ODL did not operate from www.orbital.co.uk (the obvious alternative to the Domain Name) and the Domain Name was available. The important facts are that Mr Thew did not have ODL in mind when he registered the Domain Name and was unaware of its existence and activities in July 2003 when he chose the trading name of the business and registered the Domain Name.
25. Mr Thew says that he became aware of ODL 'after a few years', when an email was received addressed to Justin Smith. This was forwarded on to him and there was a brief exchange of emails with him. Although none of these emails have been produced, it is likely that there was such an exchange of emails, most probably in or after mid-2005 when ODL purchased www.orbital.co.uk and began trading online from that site. I accept Mr Thew's case that this was the first time that he became aware of ODL's name and business.
26. One of the examples from the Wayback Machine produced by ODL shows that the Respondent's web site as at 6 March 2005 (before ODL's purchase of orbital.co.uk) advertised the company's business in the following terms –

‘Orbital Design is a creative studio providing innovative solutions to enhance your business.

We offer a comprehensive design and print management service producing everything from business stationery to exhibition stands, flyers to corporate re-branding.

Orbital Design is dedicated to producing creative solutions ... The end result is an effective design, which communicates your message to the right audience - clearly.’

This page was similar on 16 December 2004: see the example from ODL’s Paragraph 13a Submissions.

27. The web site of CTDP on 15 December 2006 contained links to examples of its work under the headings, ‘Advertising’, ‘Logo Design’, Stationery Design, ‘Brochure/leaflet design’ and ‘Exhibition/signage’. That web site as at 15 December 2006 and 16 January 2007 also made reference to the services offered by Orbital Design, namely ‘creative solutions in a wide range of formats including booklets, leaflets, posters, brochures, roller banners and pop-up stands’.
28. CTDP purchased a franchise from printing.com in 2007 and its web site was re-designed. I take the example from the Wayback Machine produced by ODL for 22 June 2008, which states –

‘Printing.com@OrbitalDesign combines the experience of an established design company with the benefits of a dynamic national printing franchise ...

Created four years ago, Orbital works with numerous clients ... and has produced countless designs for some fantastic companies in and around the Lancashire/Manchester area.’

The web site as at 6 April 2011 carried similar words to the version of 22 June 2008 and went on to state, -

‘[Innovative design?](#) [Professional service?](#) We like all of these things and with Orbital Design we guarantee that is what you’ll receive. Created five years ago Orbital works with numerous clients ... and has produced countless designs for some fantastic companies ... We work with you to make the right design so your customers say wow.

Printing.com is a completely different concept of print.... The centrally located multimillion pound printing presses ensure the offer of a truly phenomenal range of print.... and as Orbital Design runs the Rossendale franchise ... we will run all your orders for you.’

29. The Respondent’s site was changed in June 2008, with a number of oblong coloured tabs on the left hand side of what appears to have been the Home Page. These tabs included, ‘Business cards’, ‘Folders’, ‘Booklets’ and other print-based products, with a further tab stating ‘Design’ and in a version produced by ODL in its Paragraph 13a Submissions, a tab stating ‘Websites’. The web site also stated, ‘At Orbital we eat, sleep and breathe design’.
30. By 20 January 2012 the content of the Respondent’s site showed a number of links, including ‘design’ and ‘printing’, with the words ‘Rossendale’ and ‘Accrington’ prominently showed. The site had 4 other headings shown on the same page, ‘Creative design’, ‘advertising’, ‘branding’ and ‘full colour print’. Advertising had already appeared; see the example referred to above as at 15 December 2006.
31. In late 2012 the design of Mr Thew’s web site was changed, with the word ‘Orbital’ prominently displayed in a thick black strap line across the top of each web page, with a page showing 4 design services and 14 services connected with printing.

32. The link on Google searches for Mr Thew's site reads as follows, 'Welcome to Orbital Design, Graphic Designers in Rossendale, Lancashire and printers part of Printing.com ...'.
33. The allegation of confusion was originally based on confusion caused by the style of Mr Thew's web site at an unspecified date in 2013 before the Complaint, when compared to ODL's site. The case advanced in ODL's Paragraph 13b Submission was that confusion would be caused, because visitors to the web site of Mr Thew would believe that they were visiting a local print shop instead of an international creative agency. In contrast, the case put forward in ODL's Paragraph 13a Submissions is that there has been a decisive change in the content of the web site and the nature of the services offered, because Mr Thew's business is now one where design is uppermost and it is said that the businesses are now in direct competition as a result. In other words, the complaint is no longer one of style but content.
34. The critical question in cases such as the present is whether the respondent has changed his use of the domain name to take advantage of the complainant's rights: see paragraph 4.7 of the DRS Experts' Overview and cases there cited². The use will not be abusive 'provided that [the registrant] does nothing actively to exploit his position': see the Appeal decisions in *maestro.co.uk* DRS 04962 and *oasis.co.uk* DRS 06365 at paragraph 8.29.
35. Nominet operates a system of registration based on first-come-first-served, subject to the principles of Abusive Registration. The question is not whether Mr Thew has infringed ODL's trade mark rights: see the Appeal decision in DRS 05856 (*t-home.co.uk*). In that case, the complainant registered a trade mark several years after the respondent registered the domain name in dispute and the Appeal Panel considered that the correct approach in that case was not to ask, as the complainant had invited it to do, whether operation of the

² That paragraph states, 'Is it possible for a Respondent to make fair use of a domain name where (a) that name is also the Complainant's trade mark and (b) the Respondent's use of the domain name is causing confusion? Yes ...'

disputed web site amounted to a trade mark infringement. The question was whether the use was abusive. On the facts, it was not, because there had been no change of substance once the registrant had become aware of the complainant's Rights. I add that even if I had found that ODL did have rights in passing off, this would have made no difference to the proper analysis on abusive registration. Under the DRS, the question is not whether the facts give rise to passing off (or trade mark infringement), but whether the registration or use is abusive.

36. Contrary to ODL's most recent case, a prominent part of Mr Thew's business since at least December 2004 has been design, as shown by the extracts from its web site referred to above. Nor is it the case that Mr Thew's web site was simply a holding page until 2007, as the extracts show.
37. Again, ODL has not shown that the word 'orbital' or any derivative disappeared from Mr Thew's web site in around 2007, or was no longer prominent on the web site: see the examples referred to above. Thus, the example of his site as at 22 June 2008 shows that the word 'Orbital' was still prominent and that a derivative was also being used 'Printing.com@OrbitalDesign', 'Orbital' being used to describe the name of that part of the business concerned with design.
38. I also find, as conceded in the Complaint, that until 2013 even ODL did not consider the activities of Mr Thew's business as operated from his web site to intrude on its business. ODL now says that Mr Thew's use has been abusive almost from the very outset of his company's trading. However, its conduct until 2013 (i.e. lack of complaint) shows that it considered the opposite to be the case, despite the existence of some confusion.
39. Mr Thew accepts that the web site underwent a redesign. The site in late 2012 and 2013, as shown in the web pages included in ODL's Paragraph 13a Submissions, has the word Orbital shown prominently.

40. However, ODL has not established that from 2013 Mr Thew's web site began trading in the style of Orbital Design. The Complaint exhibited no copies of ODL's web site in 2013. It included 2 one page extracts of its site in its Paragraph 13a Submissions. The first was from 2011 and is very different to Mr Thew's site in that year, in 2012 and 2013. The second web page has a © notice of 2013³ and shows a large black strap line across the top of the page, like Mr Thew's new site. That new version, as ODL accepts in its Paragraph 13a Submissions, was first shown on Mr Thew's site in late 2012: see page 13 of ODL's Paragraph 13a Submission (1). Thus, any similarity is not as a result of Mr Thew having copied ODL's site.
41. I do not accept that Mr Thew's company is now carrying on in substance a design business. ODL's Paragraph 13b Submission was based on the proposition that confusion had occurred and was also likely in future, because customers did, and would continue to, believe that they had visited the site of a local print shop rather than that of an international creative agency, i.e. advertising and marketing agency. Existing customers and suppliers are under no illusion: they have fed back to ODL their impression of 2 separate businesses.
42. The content of the Respondent's web site in 2013 is largely based on print services, but with a significant design element. There has been no change of substance in the nature of the business.
43. I accept that Mr Thew is wrong on the point about his company never having offered web design services. It has and did so for some time on its web site. However, he did that without complaint from ODL at the time (before 2013) and I consider it unlikely that he took this step so as to take advantage of ODL's rights, bearing in mind the facts as I have found them to be. These include that in over 8 years (since 2005 when he became aware of ODL) he has not changed the style of his web site to copy ODL's web site, contrary to

³³ The first paragraph of ODL's response to paragraph 2 of the request for information issued in response to the Paragraph 13b Submissions also made clear that ODL had recently updated its site in a form that had been under development for 12 months, albeit not in response to Mr Thew's site. The point is that this version of ODL's site was not copied by Mr Thew.

the case initially advanced by ODL; and the fact that the essential nature of his business, namely a design business, has not changed save to add printing services from 2007.

44. I have compared the size of the Orbital logo with earlier manifestations of it used by Mr Thew. There is a difference, even a significant one. But, as indicated, it is not in response to ODL's site. Moreover, the word 'Orbital' has been used for virtually all the trading history on Mr Thew's web site. I accept Mr Thew's case that this was no more than one of a number of changes to the design of his web site that have occurred in the past 10 years, and was not made in response to ODL or its web site.
45. Taking into account all the evidence and the conclusions reached in this section of the Decision, I conclude that Mr Thew has not changed his use of the Domain Name to take advantage of the Complainant's Rights.
46. Having reached this conclusion, it is right to point out that there may well be continued confusion caused to potential customers of each business. Mere confusion, however, is not enough to sustain a finding of Abusive Registration in the circumstances as I have found them to be.

Decision

47. In those circumstances, neither the registration nor the use of the Domain Name is abusive and the Complaint fails.

Signed:

STEPHEN BATE

Dated: 11 October 2013