

DISPUTE RESOLUTION SERVICE

D00017088

Decision of Appeal Panel

The Bicycle Association of Great Britain Limited

and

Identity Protect Limited¹

1. The Parties:

Complainant: The Bicycle Association of Great Britain Limited
PO Box 1250
Castle Camps
Cambridge
CB21 4XX
United Kingdom

Respondent: Identity Protect Limited²
PO Box 795
Godalming
Surrey
GU7 9GA
United Kingdom

2. The Domain Names

The domain names in issue are:

bicycleassociation.co.uk
bicycleassociation.uk

These are referred to in this decision as the “Domain Names”.

¹ See below for details of why this company is the named Respondent.

² ditto

3. Procedural History

This is an appeal against the decision of Jon Lang (the Expert) issued on 26 May 2016 in favour of the Complainant. Definitions used in this decision have the same meaning as set out in the Nominet Resolution Service Policy Version 3, July 2008 (the Policy) and/or the Nominet UK Dispute Resolution Service Procedure Version 3, July 2008 (the Procedure) unless the context or use indicates otherwise.

The procedural history of relevance to this Appeal is as follows:

12 February 2016	Complaint received
4 March 2016	Response received from Identity Protect Limited
7 March 2016	Response received from C 2 Zero Limited (see below)
10 March 2016	Reply received
21 April 2016	Mediation failed
5 May 2016	13b full Submission filed by C 2 Zero Limited
26 May 2016	Expert's decision in favour of the Complainant
5 July 2016	Appeal Notice filed
12 July 2016	Appeal Response
12 July 2016	Appeal Panel appointment

Nick Gardner, Ian Lowe and David King (the Panel) have each made a statement in the following terms:

"I 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".

4. The Nature of This Appeal

Paragraph 10a of the Policy provides that *"The Appeal Panel will consider appeals on the basis of a full review of the matter and may review procedural matters"*. The Panel concludes that insofar as an appeal involves matters other than purely procedural complaints the appeal should proceed as a redetermination on the merits. It is not therefore necessary to analyse the first instance decision in any detail.

At this point, the Panel simply records that the Expert concluded that the Complainant had Rights in a name or mark which is identical or similar to each of the Domain Names and that the Domain Names were Abusive Registrations in the hands of the Respondent, and therefore should be transferred to the Complainant.

For convenience the Panel will continue to refer to the parties as the "Complainant" and the "Respondent".

5. Formal and Procedural Issues

The substantive dispute in this case is between two trade associations in the bicycle industry. One is the Complainant whose full name is The Bicycle Association of Great Britain Limited. The other is a company called National Association of Cycle Traders Limited that uses the name Association of Cycle Traders. It is referred to in this decision as “the ACT”.

The ACT is not however the named Respondent. The Respondent is the registrant of the Domain Names as recorded in Nominet’s database. It is a company called Identity Protect Limited. Identity Protect Limited responded by email to Nominet when served with the Complaint to say that it was a privacy provider and the substantive owner of the Domain Names was one Ryan Franklin, and objected to Nominet not allowing the substantive Respondent being changed to Ryan Franklin.

Matters became more confusing as the case before the Expert progressed as it transpired that Ryan Franklin was himself a nominee. He is the five-year-old son of Thomas Franklin who is apparently the partner of the daughter of Mark Walmsley, a director of a company called C 2 Zero Limited (see below). A long and complicated explanation was provided as to why Ryan Franklin was recorded with Identity Protect Limited as the registrant. For reasons explained below the Panel does not feel it necessary to explore this issue further.

The Complaint as filed was in substance directed at the ACT c/o Identity Protect Limited. The Response to the Complaint, was however filed by a company called C 2 Zero Limited which said it was the correct Respondent. It is also the Appellant in this appeal.

According to the Response the ACT is said to be a “*partner*” of C 2 Zero Limited and a participant and beneficiary of a project that C 2 Zero Limited is managing, providing the ACT with a range of business support and online services. Currently C 2 Zero Limited is hosting the ACT’s website which is linked to the Domain Names.

The Response said “*the ACT are relevant to the Complaint in that they are a participant in the project referred to below that C 2 Zero are managing and are also a client of C 2 Zero and beneficiary of the project, and for this reason it is necessary to consider the ACT’s history, activities and participation in the project.*”

Although the Policy and Procedure would appear to require Identity Protect Limited to remain as the Respondent of record, the Panel is satisfied, and the Complainant appears to accept, that the substantive respondent is C 2 Zero Limited as the beneficial owner of the Domain Names³. This decision proceeds on this basis and references to the “Respondent” are to be read as references to C 2 Zero Limited.

³ The Panel notes that Nominet’s terms and conditions provide that a domain name registration is not an item of property and therefore cannot be owned. The Panel uses this terminology as convenient shorthand for the relevant contractual rights. The same issue arises elsewhere in this decision.

The Complainant also alleges that the circumstances involved in this registration and the use of a nominee child registrant using a privacy shield are themselves evidence of bad faith and amount to obfuscation and deception by the Respondent and/or the ACT. Ultimately the Panel does not find it necessary to determine whether that allegation is correct as it is satisfied, for reasons explained below, that the Complaint should in any event be upheld irrespective of whether the relevant facts amount to deliberate obfuscation or not. In view of this conclusion the Panel does not consider it necessary to explore further the evidence as to why Ryan Franklin was named as the client of Identity Protect Limited.

6. The Facts

In this section the Panel outlines the key facts which are not in dispute. Further facts appear in each parties contentions and the discussion below.

The Complainant is one of two bodies representing the cycle industry in the UK. The other body is the ACT. In very broad terms the Complainant appears to represent manufacturers and other large organisations whilst the ACT represents retailers and smaller organisations. It would appear that the two bodies' activities are largely complementary.

The Complainant was incorporated at Companies House as The Bicycle Association of Great Britain Limited on 1 May 1973. It has had an internet presence since 2004. Between 2004 and 2012 it used the domain name *ba-gb.com*. It has used the domain name *bicycleassociation.org.uk* since 2012.

National Association of Cycle Traders Limited was incorporated at Companies House on 30 July 1969⁴ under the name *The National Association of Cycle and Motor Traders Limited* and in 1987 changed its name to its present form. It appears to refer to itself generally as simply *The Association of Cycle Traders*. For many years it used the domain name *theact.org.uk* but now its website is linked to and hosted at the Domain Names as part of what is said to be a project run by the Respondent

bicycleassociation.co.uk was registered on 14 December 2010 and *bicycleassocation.uk* was registered on 30 October 2014.

There was a period in 2012 when the Domain Names redirected to the ACT's website. Following correspondence from the Complainant to the ACT that redirection was removed and it would seem the Domain Names were not then used until 2016 when they were used to link directly to the ACT's website. Each of the Domain Names appears to link to an identical version of the ACT's website. www.theact.org.uk now redirects to www.bicycleassociation.uk

⁴ This information is derived from Companies House records. In all the material in evidence this company is referred to as the Association of Cycle Traders

7. The Parties' Contentions

The Parties' contentions before the Expert are set out in his decision and do not need to be repeated verbatim here. In this section the Parties contentions so far as relevant to the Appeal are summarised. The Respondent's are set out first, as it is the Appellant.

Respondent's Contentions

The Respondent says that it appears the Expert made up his mind to reach a particular decision and has then tried to "stretch" the rules to back up his decision.

The Respondent accepts that the Complainant is one of the two dedicated trade bodies representing the cycle industry in the UK. However, it denies that the Complainant has established Rights in a name or mark which is similar or identical to the Domain Names or that the registrations are Abusive. The main points it advances are as follows:

- It was not until 2012 or early 2013 that the Complainant began formally referring to itself as Bicycle Association and adopted its Bicycle Association logo. The press articles relied upon by the Complainant in which it is referred to as the Bicycle Association all post-date the registration of *bicycleassociation.co.uk* in December 2010 by at least three years.
- "Bicycle Association" and "Bicycle Association of Great Britain" are descriptive terms and since the Complainant only re-branded itself as the Bicycle Association in late 2012 or early 2013 it has not been using that term long enough for it to have acquired a secondary meaning sufficient to establish Rights in the name for the purposes of the Policy.
- There are many other consumer organisations in the UK concerned with cycling that could legitimately use the Domain Names.
- The Complainant only has very limited public exposure as it is purely a trade organisation with 58 members, so it is not correct that the public would recognise Bicycle Association as referring to it.
- Even if the Complainant can establish rights in the name Bicycle Association of Great Britain by demonstrating secondary meaning in this descriptive term, the "of Great Britain" would sufficiently differentiate it from bicycle association, which could refer to any association in the world.
- The Complainant has not established that all the elements involved in the tort of passing off apply and hence it cannot show Rights
- There was no use by the Complainant (sic - the Panel assumes this is intended to say Respondent) of the names in dispute (the Panel assumes this refers to the Domain Names) until after the Complainant made contact on 17 May 2012 to request for them to be ceded to the Complainant.

- The Expert has decided as a fact that questionable use has arisen only after the Domain Names were registered. In this regard the DRS Guidance says: “The party making the complaint needs to prove that they have rights in a name here and now. It will often be beneficial to be able to prove that they had rights when the domain name was registered. Although this is not essential, it may be difficult to show that someone has made an abusive registration if you didn't have rights when the registration took place”.
- The Expert found that the “Complainant has made out a case of Abusive Registration based on the use to which the Domain Names have been put, such use being likely to confuse people or businesses into believing that they are registered to, operated or authorised by, or otherwise connected with the Complainant.” The Expert had no basis for saying this.
- There is a difference in the use of the two Domain Names. “The .uk domain (sic) is used on the website that incorporates the domain (sic) and the ACT brand together. Bicycleassociation.co.uk is not used”⁵.

Complainant's Contentions

The Complainant contends that it has Rights in a name or mark which is similar or identical to the Domain Names and that the registrations are Abusive. The main points it advances are as follows:

- The Complainant has been known as the Bicycle Association since it was incorporated in 1973 and it has been using that name since that date in connection with the provision of information and services, including advocacy, lobbying and funding cycling related charities and member services such as technical advice and market data.
- “Bicycle Association” is recognised by the purchasing trade and the public as indicating the work and services of the Complainant as is evidenced by press articles.
- The Expert's findings on Rights were correct. It says the assertion by the Respondent that there is no misrepresentation because the two trade bodies are “complimentary” (sic) serving “different parts of the cycle trade” is absurd. The Complainant and the Respondent are the only two bodies the industry or general public could approach on a whole range of matters, products, and services. Misrepresentation is both possible, and is in fact compounded by this.
- The Complainant says that the Respondent asserts there is no evidence of damage. However, passing off law requires the probability of damage to goodwill. It is clear the Respondent's business, misrepresenting an

⁵ The Panel has been unable to understand this issue. As appears below both domain names link to the ACT's website.

association with the Complainant, has significant potential for damage to the latter, which has no control over the Respondent's activities.

- The Respondent states, without evidence, that the Domain Names are not recognised by the public because they are “industry facing”. It is true that the Complainant and Respondent's main customers are from the same industry. This is why the Respondent's misrepresentation has such potential for damage to the Complainant's goodwill. However, both parties' websites will clearly be visited by other members of the public (e.g. journalists, officials, or enthusiasts). Here too, misrepresentation has the clear potential to confuse, and injure the Complainant's goodwill.
- The Complainant rejects the Respondent's argument that the term “bicycle association” is entirely descriptive. It says the only additional rationale the Respondent provides, is to claim the ACT is the “largest bicycle association”. This undermines its argument, since if “bicycle association” were truly “descriptive” in this context and there truly were any number of “bicycle associations” then it could not be confident to claim it was the largest. In fact, it demonstrates the Respondent's tacit understanding that there are only two trade bodies in the cycle industry, since it must be comparing the ACT with the Complainant on the basis of membership numbers. It is moot that by any other measure e.g. volume of cycles sold, or economic output the Bicycle Association is far “larger”, but to make such comparison is to miss the point.
- The Respondent's argument about timing of registration is incoherent and the Complainant says it has asserted its rights in the name both here and now, and at the time the Domain Names were registered. The Complainant could not assert its rights before it became apparent the Domain Names had been abusively registered.
- The Complainant refers to the Respondent describing the Expert's “noise” around the domain name ownership arrangements, implying that these are irrelevant. In fact, the nature of these arrangements is highly relevant (a shameful charade via young family members, 3rd party “suppliers”, and identity protection services, designed to allow the ACT to deny its responsibility). They are clear evidence of deliberate, meticulous attempts to obfuscate the true nature and purpose of the domain registrations.
- The Complainant disputes the Respondent's claim that *bicycleassociation.co.uk* is not used. It says the domain name still points directly to the ACT website and the same location as *bicycleassociation.uk*.
- The Complainant denies that the steps it took in 2012 to modernise its web presence amounted to a rebranding or renaming of the Complainant. It maintains that throughout the period since 1973 it has been known as the Bicycle Association. It does not accept that the fact that there are a number of consumer organisations concerned with different aspects of the activity of cycling or cyclists demonstrates that there are a number of UK

based bicycle associations. Only the Complainant and ACT represent the bicycle industry in the UK.

8. Discussion and Findings

General

Pursuant to paragraph 2 of the Policy, the Complainant must prove in relation to each of the Domain Names, 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

“Rights” are defined in the Policy as follows:

“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.”

The Complainant does not rely on any registered trade mark rights in respect of a relevant name or mark and the issue is therefore whether the Complainant has sufficient unregistered rights to establish this first element. Paragraph 2.2 of the Nominet DRS Experts’ Overview (available at http://www.nominet.uk/wp-content/uploads/2015/08/Expert_Overview.pdf) (the “Experts’ Overview”) suggests that this turns on whether the Complainant has included evidence to demonstrate that (i) it has used the relevant name or mark for a not insignificant period of time and to a not insignificant degree; and (ii) the name or mark is recognised by the relevant public as indicating the goods or services of the Complainant. The Panel agrees with this approach.

The Panel wishes to explain the position with regard to the interrelationship between Rights under the Policy and the law relating to the tort of passing off. The Respondent’s submissions indicate a degree of misunderstanding as to the relevant principles. Nominet experts have often found it appropriate to refer to the law of passing off when considering the question of enforceable unregistered rights. This can be helpful because one of the elements required to give rise to a claim in passing off is that the claimant has acquired sufficient goodwill or reputation in the name relied upon. If a Complainant has such goodwill or reputation then it potentially has the ability to protect that goodwill or reputation by an action for passing off. Once that potential ability is established then Rights for the purpose of the Policy are established. This is because at that stage the relevant complainant has established that it has rights in respect of the name concerned which could, in appropriate circumstances, be enforced by a passing off action. Whether such circumstances do or do not exist is not relevant so far as the Policy is concerned - the issue then to be decided by the expert or appeal panel is

whether there has been an Abusive Registration. It accordingly follows that it is not necessary for a Complainant under the Policy to establish that it actually has a good claim in passing off. The other two elements required for a passing off claim, namely that the use of the name complained of amounts to a misrepresentation and that the use complained of has caused damage or the likelihood of damage, are entirely irrelevant so far as the Policy is concerned.

This approach is explained in the Expert's Overview, as follows: -

“If the right is an unregistered trade mark right, evidence needs to be put before the Expert to demonstrate the existence of the right. This will ordinarily include evidence to show that (a) the Complainant has used the name or mark in question for a not insignificant period and to a not insignificant degree (e.g. by way of sales figures, company accounts etc.) and (b) the name or mark in question is recognised by the purchasing trade/public as indicating the goods or services of the Complainant (e.g. by way of advertisements and advertising and promotional expenditure, correspondence/orders/invoices from third parties and third party editorial matter such as press cuttings and search engine results).”

In this case, there is no dispute that the Complainant has been named The Bicycle Association of Great Britain since at least 1973. The Complainant asserts that it has provided its various services under the name Bicycle Association since that time and in any event the Respondent accepts that the Complainant has used the name Bicycle Association and has branded itself as such since at least 2012. The Respondent has not seriously challenged the evidence that the bicycle industry knows the Complainant as the Bicycle Association. Even if the Complainant is not widely known by the general public by that name, the fact that it is well known by the trade, which is the relevant public for this purpose, is enough. The relevant evidence seems to the Panel to be very clear. For example:

The website www.bikebiz.com, referring to “Bike Week 2016” states “*Industry organisation the Bicycle Association will fund national indemnity insurance for all registered cycling events associated with Bike Week, as it has done in previous years*”.

A government press release in 2013 about the Government's commitment to promoting cycling announced amongst other things “*the creation of a new national School Awards Scheme to recognise schools that have demonstrated excellence in supporting cycling and walking; the UK cycle industry, led by the Bicycle Association, has volunteered to work with government to sponsor this award*”

A Guardian newspaper article for November 11, 2014 reviewing a video promoting safer cycling state “*As part of this they will be interacting with vulnerable road users like cyclists. That's why it's so interesting to see the video above, made by the tireless cycling journalist, author and campaigner Carlton Reid, for the Bicycle Association.*”

The Complainant also referred in evidence to the contents of its own website which again confirm the Panel's view. Thus for example on the testimonials page:-

"I've been a member of the Bicycle Association for over 35 years. The BA's work on technical matters, lobbying Government and providing a forum for networking throughout the industry have been invaluable. I can wholeheartedly recommend membership to anyone involved with manufacturing, distributing or promoting bicycles or bicycle usage." - Mark Bickerton, Cyclemotion

and

"An industry organisation is the only way an SME can have its voice heard by legislators and government. In this respect undoubtedly the Bicycle Association is the U.K.'s leading body that is both consulted regarding policy and listened to by regulators, so I consider it vitally important to the long-term success of the business I manage." - Philip Taylor, Schwalbe UK

and (on another page of the Complainant's website):

"John Mills, director of coaching and education at British Cycling, said: "Both British Cycling and the Bicycle Association are passionate about giving young people an enjoyable and safe introduction to cycling, and that is exactly what we aim to provide through our Go-Ride programme".

The Respondent's answer to this is to say *"The terms Bicycle Association and Bicycle Association of Great Britain merely indicate the nature of the Complainant, an association relating to bicycles (in Great Britain). As such a descriptive term, the Complainant should not be entitled to monopolise it. The terms could respectively and sensibly refer to any bicycle association in the world or in Great Britain of which there are many. They could equally refer to and be used to describe the ACT."*

This seems to the Panel to be nonsense. The fact of the matter is that on the evidence there is only one organisation in the UK which calls itself the Bicycle Association and that is the Complainant. It may well be that its full name is The Bicycle Association of Great Britain Limited but that does not detract from the fact that it is naturally referred to as the Bicycle Association. The fact that the Respondent is able to point to examples where the Complainant's full name is used does not detract from the fact that it is also commonly referred to by an abbreviated version of that name, namely the Bicycle Association. It may well be the case that when newly formed it would not have been able to show relevant rights in a name which is of a general nature, but the fact that it has used the name and is generally known by it enables it to show it has Rights in its name in abbreviated form as at the date the Complaint was filed.

The Complainant's case is that such use has occurred over 40 years. The Respondent appears to assert that the use in question has only been since 2012. It is well established that Rights need only exist at the time of the Complaint so that even if the Respondent had established that the Complainant had only accrued Rights after the first of the Domain Names was registered in 2010 that would not assist the Respondent.

The Respondent accepts that there are just two dedicated trade bodies, or associations, representing the cycle industry in the UK, that is ACT and the

Complainant. On the basis of the evidence, the Panel is satisfied that Bicycle Association is not merely a descriptive, generic term, but in the cycle industry refers only to the Complainant. Accordingly, as a result of its activities over many years (and even on the Respondent's case since at least 2012) it has established sufficient goodwill and reputation in the name Bicycle Association to give rise to enforceable Rights in that name for the purpose of the Policy.

The Domain Names *bicycleassociation.co.uk* and *bicycleassociation.uk* are for the purposes of the Policy to be regarded as identical to the name "bicycle association". The omission of the space is an immaterial difference and the suffixes ".co.uk" and ".uk" are to be ignored for the purposes of this assessment.

Accordingly the Panel is satisfied that the Complainant has Rights in respect of a name or mark which is identical or similar to the Domain Names.

Abusive Registration

"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 took unfair advantage of or was unfairly detrimental to the Complainant's Rights"

In the present case it is important to note that these provisions are alternatives. It is not necessary for the Complainant to show that the Domain Name was both registered and used in such a manner – either will suffice. The reason this is significant is that the Respondent makes much of the fact that it registered *bicycleassociation.co.uk* in 2010 (which it says was before the Complainant re-branded its website and started to use the domain name *bicycleassociation.org.uk* in 2012). The Respondent's case is that this was part of a more general project to develop a number of "themed" or generic "association" domain names, such as *outdoorassociation.co.uk* (registered 5 January 2011); *creativeassociation.co.uk* (registered 5 January 2011) and *craftandhobbyassociation.co.uk* (registered 7 February 2012). The Complainant for its part says this is all further obfuscation and disputes that any of these other domain names have been put to genuine use.

The Panel finds it unnecessary to resolve these issues as it is satisfied (for reasons explained below) that the manner in which the Domain Names have been used by the ACT with effect from January 2016, as a client of the Respondent, took unfair advantage of the Complainant's Rights. As indicated above the Panel is satisfied that whatever may have been the position prior to 2012, the Complainant has established that by 2016 it had Rights in the name Bicycle Association.

Whatever the motives and thinking were at the time *bicycleassociation.co.uk* was registered, the fact is that it only started to be used by the ACT in January 2016. This appears to be confirmed by correspondence from the ACT which is discussed below, but in any event actual evidence of how the ACT has used the Domain Names is in the evidence before the Panel. The ACT's newsletter dated 7 January

2016 is headed with an ACT logo, a telephone number and a prominent reference to theact.org.uk. Its newsletter for January 21, 2016 has the same logo and telephone number but the reference to *theact.org.uk* has been replaced by *bicycleassociation.uk*

Paragraph 3a of the Policy provides a list of factors which may establish a registration as Abusive. In the present case the Panel considers paragraph 3(a) (ii) to be directly applicable:

“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”

In the present case the ACT is simply using what is in substance the Complainant’s name as its domain name. That to the Panel seems self evidently likely to be confusing. As the Expert’s Overview again states:

“3.3 Paragraph 3(a)(ii) concerns confusing use of the domain name. What is meant by confusing use?”

The ‘confusion’ referred to in this paragraph of the Policy is confusion as to the identity of the person/entity behind the domain name. Will an Internet user seeing the domain name or the site to which it is connected believe or be likely to believe that “the domain name is registered to, operated or authorised by, or otherwise connected with the Complainant”?

In the case of BT v One In A Million [1999] 1 WLR 903, the Court of Appeal cited, as one example of how confusion of this kind could occur, the making of a Whois search of the registry/registrar database. The enquirer conducts such a search and because of the similarity of the domain name to the well-known trade mark (the case was concerned solely with well-known trade marks), assumes that the registrant is in some way associated with the trade mark owner. Whether or not this is still (if it ever was) a likely scenario, the English Courts have clearly held that mere registration of a domain name can constitute unfair use of a domain name for the purposes of passing off and trade mark infringement, even if nothing more is done with the domain name.

The prevailing approach under the DRS is consistent with this. Commonly, Internet users will visit web sites either by way of search engines or by guessing the relevant URL. If the domain name in dispute is identical to the name of the Complainant and that name cannot sensibly refer to anyone else, there is bound to be a severe risk that a search engine, which is being asked for the Complainant, will produce high up on its list the URL for the web site connected to the domain name in issue. Similarly, there is bound to be a severe risk that an Internet user guessing the URL for the Complainant’s web site will use the domain name for that purpose. In such cases, the speculative visitor to the registrant’s web site will be visiting it in the hope and expectation that the web site is a web site “operated or authorised by, or otherwise connected with the Complainant.” This is what is known as ‘initial interest confusion’ and the overwhelming majority of Experts view it as a possible basis for a finding of Abusive Registration, the vice being that even if it is

immediately apparent to the visitor to the web site that the site is not in any way connected with the Complainant, the visitor has been deceived.”

See also the Appeal decision in GuideStar UK -v- Wilmington Business Information Limited (DRS 02193) in which the Panel stated:

“Registering as a domain name, the name of another (without any adornment), knowing it to be the name of that other and intending that it should be recognised as the name of that other and without the permission of that other is a high risk activity insofar as the DRS Policy is concerned. Ordinarily, it would be tantamount to impersonating the person whose name it is”.

In the present case it is quite clear that the ACT and the Complainant, as the two trade associations in their relevant industry, knew each other. The ACT must have realised when it adopted the use of *bicycleassociation.co.uk* and/or *bicycleassociation.uk* that it was adopting domain names which were in substance the Complainant’s abbreviated name. The Panel cannot conceive of how it could do this without recognising it was likely to be confusing. It seems to the Panel to be a paradigm example of the type of conduct paragraph 3(a) (ii) is directed at. In this regard paragraph 3(a)(ii) does not involve any assessment of what the Respondent’s (or ACT’s) motive was in using the Domain Names in this manner. It would seem the Respondent’s case is that it simply considers the Domain Names to be generic and available for any association to use. In this regard the Respondent says that *“there are many other consumer organisations, for example, International Mountain Biking Association UK, British Schools Cycling Association, Association of British Cycling Coaches, Consortium of Bicycle Retailers, Cyclists’ Touring Club, European Cyclist Federation, National Association of Veteran Cycle Clubs and, now amalgamated with the Complainant, British Electric Bicycle Association. Any of these could have registered and could legitimately use the domain names in question”*. The Panel disagrees. Had any of them done so it too would also have been adopting what was the Respondent’s name in a manner which would be confusing. If this was the Respondent’s (or the ACT’s) reasoning it was in the Panel’s view wrong.

In reaching this conclusion the Panel has been interested to understand in particular what the ACT, as opposed to the Respondent, has to say about its actions. That evidence is to be found in a letter annexed to the Response dated 3 March 2016 from a Mr Chris Compton who is a director of the ACT. The Panel finds it rather difficult to understand and sets it out in full, as follows:-

“To whom it may concern

At the ACT Board meeting on 30th September 2010 the issue of potential confusion between the ACT and ActSmart was discussed and it was agreed that it would be ideal for the ACT to have its own site, whilst still benefiting from all of the services and provisions of ActSmart. Mark Walmsley of C 2 ZERO (which incorporates ActSmart) stated that he had been approached by a party with an initial interest in the equestrian market, who was promoting the option of developing a community of leisure based activity sites, which the ACT might benefit from and agreed to investigate.

Later that year Mark contacted the Board to update us on the project, which would involve producing a number of mini-sites with trade organisation partners in different leisure sectors, accessing all of the services and support of ActSmart and critically incorporating ActSmart's direct debit facility into a dedicated subscription enrolment process. The sites would carry the lead brand of the sector partner, but would utilise a consistent domain structure for branding and ease of identity. The site domains would be (sector)association.co.uk and Mark had identified that the bicycleassociation.co.uk domain was available, so he would purchase it to use for this purpose.

Mark originally hoped to have the ACT's bicycle mini site live before the end of 2011, but was clear that this was dependent upon buy in from other sectors to be identified by himself and his partner in the project.

At the ACT Board meeting on 25th October 2011 Mark reported that progress was very slow in recruiting other sector organisations, the general problem being that most wanted to try and deliver the business support from within their own framework, but that they would persevere. In the interim ActSmart would develop an area within the ActSmart site for ACT and purchase a relevant domain for this purpose, pending recruitment to develop the association community. Accordingly theact.org.uk (the best option available at the time) was purchased on 28/10/11 and was made live within ActSmart in February 2012.

At the ACT Board meeting on 24th April 2012 it was acknowledged that this was an acceptable interim compromise, but ACT's objective was a dedicated site with its own branded enrolment platform, ideally as part of a wider community in line with what was already being delivered via C 2 Zero's 'the experts' community for B2C promotion. Mark committed to deliver bicycleassociation.co.uk (sic) as part of the community once at least one other sector organisation was committed to do so.

Mark made us aware of the interest shown in the bicycleassociation.co.uk domain in summer 2012 and explained that the BAGB might start utilising a similar bicycleassociation domain as their web identity, but he did not see any issues as it would not form part of their B2B trade community project. The BAGB latterly adopted bicycleassociation.org.uk for their website.

When a member of C 2 Zero's staff latterly redirected the bicycleassociation.co.uk domain to theact.org.uk we were approached by a BAGB director to redirect away. Although some ACT directors were loath to take any action, as we had undergone regular disputes with this particular BAGB director and given that domain related traffic would be insignificant, pending the launch of the full project we asked Mark if he would redirect to a suitable alternative location.

Over the next few years there were a number of hopeful developments that might have allowed the association community to go live, but progress was slow and a number of other positive projects took priority as ACT grew strongly during this period. Eventually at the ACT Board meeting on 27th October 2015 Mark announced that they now had a positive indication to progress within another leisure sector, which he hoped to finalise by the new year and accordingly bicycleassociation.uk (the strategy had changed to adopt the .uk suffix post their launch in June 2014) would go live in early 2016 with other sites to follow shortly.

Mark highlighted that through his role with the Independent Retailers Confederation there was now wider interest beyond leisure activities and into areas such as fine food, which might allow for a much bigger community to be developed over the long term.

Bicycleassociation.uk went live in January 2016 and I subsequently met Mark Bickerton, Deputy President of the BAGB at a Westminster event. At our impromptu meeting Mr Bickerton wanted to understand the rationale behind using the bicycleassociation.uk domain; I outlined the strategy and decided for clarity, to follow it up with an e-mail fully outlining the ACT's position. At that meeting Mr Bickerton inferred that they (BAGB) had been slow off the mark to register any bicycle association domains.

Chris Compton 3 March 2016

The email mentioned by Mr Compton, which he says he sent and which he said "fully outlined the ACT's position" would appear to be one dated 5 February 2016 which is also annexed to the Response and which reads as follows:

"Hi Mark,

It was good to see you at the APPCG meeting the other week, I hope this is the best e-mail address for you?

Following on from our conversation regarding ACT activities and your comments, I thought it might be worth me dropping you a line to clarify our position.

Under our tenure the ACT has never viewed itself to be in competition with the BAGB, far from it.

Over the past decade plus, the ACT Board has purposefully developed a strategy for the Association, which is complimentary to that of BAGB, avoiding any overlap of interests in our opinion, whilst offering support to BAGB and other cycling organisations, where there are clear benefits to all.

Our core focus remains upon business development and support, a space that no other cycling organisation fills in the UK, as opposed to duplicating the activities that the many cycling organisations already excel at.

Obviously our key responsibility is for the growth and overall expansion of the ACT to service the market and membership.

We have recently re-joined the APPCG with regards to making a contribution, after a period where expenditure and operations were unclear to us and accordingly we could not warrant expenditure on behalf of our members. Throughout this period we have continued to take a lead role in the Independent Retailers Confederation and the All Party Parliamentary Small Shops Group, which has proven advantageous to our membership.

We find that working with other trade bodies across multiple sectors is highly beneficial to our understanding of the market and opportunities that we can realise within the cycle sector.

As a board we are comfortable that our strategy is servicing a wider market and we expect to exceed our 3000 business subscriber objective during this trading year, whilst also providing some areas of service support to cycle businesses which don't subscribe to the ACT.

Through strong business partnerships the ACT is now delivering support schemes worth in excess of £300m p.a. throughout the UK and in the independent retail

sector the ACT is viewed as one of the most progressive business focused trade bodies.

Cytech continues to expand at a pace, with ACT now the awarding body for industry developed technical qualifications overseas as well as in the UK. Having proven Cytech in South Africa we are currently progressing projects in Australia, New Zealand, Canada and the USA.

In order to deliver all of these initiatives on our limited income, we have increasingly become an online association, operating multiple websites in partnership with other trade operations.

Our recently launched dedicated website is part of a bigger multi-channel initiative, which is being delivered in partnership with other operations and trade bodies.

The ACT has no plans to use bicycleassociation.uk in any other manner than for our own website as part of this developing association community and you will note that our e-mail address remains directors@theactorg.uk

I hope that this serves to clarify the ACT's position in the market.

Kind Regards

Chris Compton

ACT Board of Directors

Association of Cycle Traders

E: directors@theactorg.uk

T: 01273 427 700

W: bicycleassociation.uk

Strikingly nowhere in the letter or the email does Mr Compton address the obvious possibility that launching a website with the name www.bicycleassociation.uk was likely to cause confusion given the fact that The Bicycle Association of Great Britain Limited has been in existence for over 40 years and is often referred to as simply as the Bicycle Association. Mr Compton appears careful in his communications to always refer to the Complainant as "BAGB", but the evidence in this case does not establish that it is generally known or referred to by that acronym. The most relevant passage to explain what the ACT was thinking would seem to be that reading:

"In order to deliver all of these initiatives on our limited income, we have increasingly become an online association, operating multiple websites in partnership with other trade operations.

Our recently launched dedicated website is part of a bigger multi-channel initiative, which is being delivered in partnership with other operations and trade bodies.

The ACT has no plans to use bicycleassociation.uk in any other manner than for our own website as part of this developing association community and you will note that our e-mail address remains directors@theactorg.uk

The Panel can entirely understand that the ACT was pursuing various initiatives, and seeking to become an online association and that involved a newly launched dedicated website. What it does not understand is why that initiative chose to use domain names which were in substance identical to the Complainant's abbreviated name. The evidence in this case has included details of a rather inchoate and difficult to understand idea which revolves around the Respondent's apparent plans to develop some sort of community or joint venture of "association" related sites. It may be that this is what Mr Compton is talking about

when he refers to the ACT's website as being "*part of a bigger multi-channel initiative, which is being delivered in partnership with other operations and trade bodies.*" The Panel really does not understand what this is all about – the ACT's website is a standalone website related to the ACT and suggestions (if that is what these are) that it has some commonality with say outdoorassociation.co.uk, or any of the other "association" domain names registered by the Respondent do not seem to the Panel to make any real sense at all. In any event the Panel considers that irrespective of whatever this plan is, when the ACT (acting in conjunction with the Respondent) came in 2016 to use the Domain Names to link to its own website it should have appreciated the likelihood for confusion that would result, given the long standing existence of the Complainant, the only other major bicycle trade association in the UK. Any number of other alternative domain names the ACT could have used can readily be conceived of, and Mr Compton's letter and email really does not explain why the ACT did what it did.

Accordingly the Panel is satisfied that whatever the motives of either the Respondent or the ACT, the ACT's use of the Domain Names from January 2016 onwards was likely to cause confusion. In reaching this conclusion the Panel notes that no evidence of actual confusion has been provided. The Panel does not consider that matters. In some cases, where the facts are borderline it may be difficult for a Panel to infer that confusion is likely and evidence of actual confusion then becomes important. Where however there is a clear and obvious case the Panel is entitled to reach its own conclusion as a matter of common sense. That is the position here. It seems to the Panel inevitable that cases will occur where persons looking for the Complainant's presence on the Internet will, either via a search engine, or via themselves directly guessing at the appropriate domain name, end up at the Respondent's website. That is why the use of the Domain Names by the ACT, as facilitated by the Respondent, is Abusive.

It follows that the Panel having reached its decision based on what the ACT did in 2016 means that various other earlier issues become effectively redundant. Specifically:

- The Panel does not need to reach a conclusion on whether or not the original registration of the Domain Names took unfair advantage of or was unfairly detrimental to the Complainant's Rights.
- It does not therefore need to address the various allegations the Complainant has made about the arrangements for registration amounting to deliberate obfuscation.
- The fact that in 2012 the *bicycleassociation.co.uk* domain name was being used to provide a redirection to the ACT website and this was removed following complaint by the Complainant now becomes irrelevant (although the Panel notes in passing this seems to explain why the Complainant did not feel it needed to take any further action until the Domain Names were put into use again in 2016).
- the fact that the Complainant's evidence of use of the term Bicycle Association is all post 2012 – this does not matter.

- the fact that Respondent's original registration of *bicycleassociation.co.uk* predated the Complainant's adoption of *bicycleassociation.org.uk* as its main domain name again does not matter.

9. Decision

The Appeal is dismissed. The domain names *bicycleassociation.co.uk* and *bicycleassociation.uk* shall be transferred to the Complainant.

Dated August 18, 2106

Signed: Nick Gardner

Signed: Ian Lowe

Signed: David King