

DISPUTE RESOLUTION SERVICE

D00017789

Decision of Independent Expert

RUGBYSHOP

and

Mr Andy Hugh

1. The Parties:

Lead Complainant: RUGBYSHOP
21 avenue Léon Jouhaux
Zone Industrielle du Terroir
SAINT-ALBAN
31140
France

Respondent: Mr Andy Hugh
95 Mortimer Street
London
W1W 7GB
United Kingdom

2. The Domain Name(s):

rugby-shop.co.uk

3. Procedural History:

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.

27 July 2016 15:26 Dispute received
28 July 2016 14:39 Complaint validated
28 July 2016 14:41 Notification of complaint sent to parties
16 August 2016 02:30 Response reminder sent
22 August 2016 09:58 Response received
22 August 2016 09:59 Notification of response sent to parties
25 August 2016 09:22 Reply received
25 August 2016 09:22 Notification of reply sent to parties
31 August 2016 13:19 Mediator appointed
31 August 2016 13:19 Mediation started
01 September 2016 15:21 Mediation failed
01 September 2016 15:21 Close of mediation documents sent
13 September 2016 02:30 Complainant full fee reminder sent
13 September 2016 16:59 Expert decision payment received
03 October 2016 13:45 Expert requests further information from Nominet/Parties
04 October 2016 14:44 Nominet provides name and address of registrant
05 October 2016 12:01 Nominet provide Respondent's further information to Expert
10 October 2016 14:37 Nominet provide Respondent's further information to Expert and Complainant
13 October 2016 09:58 Complainant serves further submission.

4. Factual Background

The Domain Name was registered on 5 March 2005.

The Complainant is the sole partner of a business located in France that trades as RUGBYSHOP and which unsurprisingly sells products related to the sport of rugby. It commenced trading in 1990 and since 1999 its business has been conducted mainly over the internet under the domain name rugbyshop.com, which was registered in February 1997. It is asserted that it has 100,000 unique visitors to the website a month and around 150,000 loyal customers from both France and the United Kingdom. In support of this assertion it has provided a list of UK customers and prospects although this is relatively modest in number considering the time frame involved.

The Complainant asserts that it now wants to open a new website dedicated to the British market and that it wants to do so via a website that is accessible from the Domain Name and was surprised to find that it had been registered by the Respondent, although never exploited.

The Complainant is the proprietor of registered trade marks in various classes, including French TM number 1712964 filed on 8 October 1990 and UKTM number 2185174 filed on 23 December 1998 which pre-date the registration of the Domain Name, and EUTM number 14065122 filed on 13 May 2015 which post-dates the registration of the Domain Name. These marks are for figurative marks, or to put it another way, logos, which include the word RUGBYSHOP. It also registered the trade name RUGBYSHOP with the Toulouse Trade and Companies Register in February 1997.

The whois details for the Domain Name at the time the Complaint was filed state that the registrant was 'A Hugh'. The address details for the Registrant were not shown because the registrant had opted to have them omitted on the basis of being a non-trading individual. The whois details also identified that Nominet had been unable to match the Registrant's name and address against a third party data source on 17 March 2016. Following a request from myself (as referred to below), Nominet disclosed that the Registrant of the Domain Name is Andy Hugh and that the recorded address for the Domain Name is 95 Mortimer Street, London, W1W 7GB. Subsequently the Respondent provided a photograph of the letter and envelope by which the Complaint was communicated to him by Nominet as proof of his connection with the above address and a copy of his passport.

5. Parties' Contentions

a. The Complaint

The Complainant asserts that the Domain Name was registered subsequent to its first rights and that it is visually, phonetically and intellectually identical to the distinctive sign RUGBYSHOP. Such similarity can only result from a will to block and resale it and the Respondent would have been aware of the Complainant's business in the United Kingdom particularly because of the Respondent's UK trade mark and by the number of its British customers.

It also asserts that the Domain Name was registered with false contact details because a) it has never been able to contact the Respondent, and b) Nominet had not been able to match the Respondent's name and address against a third party data source.

Further, it also asserts that the Domain Name was primarily registered to stop the Complainant registering it and it has never been exploited (by which I understand the Complainant to mean that the Respondent has not used the Domain Name).

b. The Response

The Respondent disputes that the Complainant has Rights. He asserts that it is a foreign entity that has not been trading from the UK or supplied goods aimed at the UK market and as such it has not substantiated the existence of any goodwill or unregistered rights in the UK and he says that it was not a company that he had heard of, or a household name. He says that the French trade mark is of no relevance to the UK and that the descriptive term rugby-shop is not registrable as a trade mark and that the marks that have been registered by the Complainant are for designs, and as such the claim that the domain Name is visually, phonetically or intellectually identical to the design is absurd.

With regard to whether the registration of the Domain Name was abusive, he says that the fact that Nominet's system fails to validate registered details particularly where initials are used, does not mean that the information is incorrect. He goes on to say that he registered the domain names rugby-shirts.co.uk and rugby-shirt.co.uk on the same day 11 years ago when the Complainant would have been even less well known than they are now, if at all, and that the Respondent is also the registrant of a number of other descriptive shop based domain names.

The Respondent asserts that the Complainant's claims are a clear work of fiction and asks that a case be considered against the Complainant for Reverse Domain Name Hijacking.

c. The Reply

The Complainant asserts that the Respondent has not established any rights to the name rugby-shop or explained why it has not exploited the Domain Name. It reiterates the level of business that it has conducted in the UK in support of its claim to have Rights.

It does not accept that the name is generic and refers to the trade mark registrations it has obtained in support of this and it also reiterates its claim to have rights as a result of its use of the trade name RUGBYSHOP as registered with the Toulouse Trade and Companies Register, its use of the domain name rugbyshop.com and the registered French trade mark.

The Complainant also asserts that the other domain names registered by the Respondent, rugby-shirts.co.uk and rugby-shirt.co.uk are also unexploited and as such evidence the intention of the Respondent to block or sell such domain names.

d. The Complainant's further submissions

After Nominet disclosed the Registrant's recorded name and address and the Respondent provided evidence in respect of the truthfulness of that information, I invited the Complainant to make a further submission in respect

of the ground set out in paragraph 3(a)(iv) of the DRS Policy (the "Policy") (false contact details). In response the Complainant submitted the following:

"At the time the complaint was filed, the registrant was not identifiable on the WHOIS of its domain name "rugby-shop.co.uk"."

6. Discussions and Findings

a. General

To succeed in this Complaint, the Complainant must, in accordance with paragraph 2 of the Policy, prove to the Expert on the balance of probabilities that:

- (i) it has Rights (as defined in paragraph 1 of the Policy) in respect of a name or mark identical or similar to the Domain Name; and
- (ii) the Domain Name in the hands of the Respondent is an Abusive Registration (as defined in paragraph 1 of the Policy).

b. Complainant's Rights

The DRS Policy defines Rights 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 relies upon both the rights that arise from its various trade mark registrations and its common law rights as a result of the business that it has conducted under the RUGBYSHOP name. In respect of the former, the Respondent takes issue with the existence of such rights as they attach to the name RUGBYSHOP because the registrations are for figurative marks, and not the name RUGBYSHOP alone which he asserts to be generic. With regard to the latter, he does not accept that the Complainant has any goodwill in the UK. In my view the Complainant has shown on the balance of probabilities, and in this respect I am mindful of the length of time it has been trading, including via the website rugbyshop.com (since 1999), the number of visitors to its website and the number of customers that it has including UK customers, that it does have Rights as a result of its trading activities under the mark RUGBYSHOP. As such I do not consider it necessary to deal with the issues raised by the Respondent concerning the rights that the Complainant claims to subsist in the RUGBYSHOP mark from the registrations of the figurative marks. For the purpose of analysing whether the Domain Name is identical or similar to the name or mark in which rights are claimed, one should ignore the .co.uk suffix. The mark and the Domain Name are identical if one ignores the hyphen or similar if one does not and in my

opinion the Complainant has therefore established that it has Rights in a mark identical or similar to the disputed Domain Name.

c. Abusive Registration

I now go on to consider the extent to which the disputed Domain Name is an Abusive Registration.

The Complainant asserts that the Domain Name is an Abusive Registration for the reason identified above.

The Policy defines an Abusive Registration as -

"a Domain Name which either:

- i. *was registered or otherwise acquired in a manner which, at the time when the registration or acquisition took place, took unfair advantage of or was unfairly detrimental to the Complainant's Rights; or*
- ii *has been used in a manner which took unfair advantage of or was unfairly detrimental to the Complainant's Rights"*

and goes on to set out a (non-exhaustive) list of factors which may be evidence that a domain name is an Abusive Registration.

Two such grounds are that the Respondent registered the Domain Name primarily for the purpose of selling it to the Complainant for valuable consideration (Paragraph 3(a)(i)(A) of the Policy) or as a blocking registration against a name or mark in respect of which the Complainant has Rights ((Paragraph 3(a)(i)(B) of the Policy).

To be successful in its complaint on these grounds, the Complainant must show that the Respondent had knowledge of the Complainant's Rights and intended to take unfair advantage of or cause unfair detriment to them. In appeal case DRS 04331 *Verbatim*, the Appeal Panel said the following:

"8.13 In this Panel's view the following should be the approach to the issues of knowledge and intent in relation to the factors listed under paragraph 3 of the Policy:

- (1) First, some knowledge of the Complainant and/or its brand/rights is a pre-requisite for a successful complaint under all heads of the DRS Policy other than paragraph 3(a)(iv) (giving false contact details). The DNS is a first-come-first-served system. The Panel cannot at present conceive of any circumstances under which a domain name registrant, wholly unaware of the Complainant and its Rights, can be said to be taking unfair advantage of or causing unfair detriment to the Complainant's Rights.*
- (2) Secondly, 'knowledge' and 'intention' are pre-requisites for a successful complaint under all heads of paragraph 3(a)(i) of the*

Policy. The wording of that paragraph expressly calls for the relevant intent, which cannot exist without the relevant knowledge.

- (3) Thirdly, 'intention' is not a necessary ingredient for a complaint under paragraph 3(a)(ii) of the DRS Policy. The test is more objective than that. However, some knowledge of the Complainant or its name/brand is a pre-requisite.*
- (4) Fourthly, while some knowledge of the Complainant or its name/brand is a pre-requisite for a successful complaint under the DRS Policy (save for a complaint under paragraph 3(a)(iv)), knowledge is not of itself conclusive in favour of the Complainant. The Expert/Appeal Panel will still need to be satisfied that the registration/use takes unfair advantage of or is causing unfair detriment to the Complainant's Rights.*
- (5) Fifthly, when a Respondent denies all knowledge of the Complainant and/or its Rights at the relevant time, that denial is not necessarily the end of the matter. The credibility of that denial will be scrutinised carefully in order to discern whether, on the balance of probabilities, the relevant degree of knowledge or awareness was present."*

The Respondent has denied that he knew of the Complainant and asserts that it is not a household name. Whilst there is evidence that the Complainant conducted business in the UK, the level of that business seems to be fairly modest which is supported by the Complainant's stated intention to open a new website dedicated to the UK market, its preference being to use the Domain Name.

The Respondent explains his registration of the Domain Name as being part of a broader pattern of registering domain names including rugby-shirts.co.uk and rugby-shirt.co.uk which he registered on the same day and other descriptive 'shop' related domain names.

In my view, the Complainant has not adduced any evidence to suggest that the Respondent was aware of its Rights at the time that he registered the Domain Name or that he intended to take unfair advantage or cause unfair detriment thereto. Conversely the Respondent has provided a credible explanation of why he registered the Domain Name, which I choose to accept. As such I do not consider the registration of the Domain Name to be abusive on these grounds.

That leaves the further ground relied upon by the Complainant, that it has been independently verified that the Respondent has given false contact details (Paragraph 3(a)(iv) of the Policy). In support of this ground, the Complainant referred to the whois records for the Domain Name and the statement contained therein prior to the filing of the complaint that as at 17 March Nominet had been unable to match the Registrant's name and address against a third party data source. It also asserted that it had been unable to get in touch with the Respondent, although provided no evidence to support

this. The Respondent, in my opinion, failed to engage with this ground of complaint in any meaningful way in the Response, but simply asserted that the validation processes used by Nominet are flawed. In my opinion, the inability of Nominet to validate the Respondent's name and address was a satisfactory basis for the Complainant to raise the ground of complaint set out in the Policy and in light of this view and the Respondent's failure to engage meaningfully with it, I requested (pursuant to Paragraph 13 of the DRS Procedure (the "Procedure")) that Nominet release the name and address records for the Domain Name to myself and the parties, that the Respondent provide any evidence showing the truthfulness of those records, and that subsequently the Complainant make any further submissions on this ground of complaint.

In response to this request, the name and address records were disclosed and the Respondent provided (a) a photograph of the letter from Nominet to him notifying him of the complaint which was sent to the address contained within Nominet's records and the envelope that it was contained in, by way of confirmation of his connection with that address, and (b) a copy of a passport for Mr Andrew Hugh. The Complainant made the further submission which I have set out above.

In light of the evidence submitted by the Respondent, I have concluded that the contact details provided by the Respondent were not false and this ground of complaint must fail too.

In the Response, the Respondent urges me to make a finding of Reverse Domain Name Hijacking. This is defined in the Procedure as a Respondent using the DRS in bad faith in an attempt to deprive the Respondent of a Domain Name. If such a finding is made on three separate occasions in a two year period, the Complainant will be prevented from filing any DRS complaints within a further two year period (Paragraph 16(d) of the Procedure). For the reasons given above, I consider that the statement in the whois records was enough to engage the provisions contained within Paragraph 3(a)(iv) of the Policy and I do not therefore consider that the complaint was brought in bad faith.

7. Decision

For the reasons set out above, I find that the Complainant does have Rights in respect of a name which is identical or similar to the Domain Name <rugby-shop.co.uk> but that the Domain Name in the hands of the Respondent is not an Abusive Registration. The Complaint therefore fails.

Signed: Simon Chapman

Dated: 20 October 2016