



## DISPUTE RESOLUTION SERVICE

**D00020892**

### **Decision of Independent Expert**

Gift Voucher Solutions Limited

and

Clockwork Marketing and Direct Mail Limited

#### **1. The Parties:**

Complainant: Gift Voucher Solutions Limited  
17e East King Street  
Helensburgh  
G84 7QQ  
United Kingdom

Respondent: Clockwork Marketing and Direct Mail Limited  
Longlands Barns  
Whilborough Road  
Kingskerswell  
Newton Abbot  
Devon  
TQ125DY  
United Kingdom

#### **2. The Domain Name:**

*giftvouchersolutions.co.uk*

### 3. Procedural History:

- 3.1 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.

06 December 2018, the Dispute was received.

06 December 2018, the Complaint was validated.

06 December 2018, notification of the Complaint was sent to the Parties.

28 December 2018, the Response was received.

28 December 2018, notification of the Response was sent to the Parties.

28 December 2018, the Reply was received.

28 December 2018, Notification of the Reply was sent to the Parties.

07 January 2019, a Mediator was appointed.

07 January 2019, Mediation was started.

10 January 2019, Mediation failed and the close of the Mediation documents were sent out.

22 January 2019, the Complainant's full fee reminder was sent.

25 January 2019, the Expert decision payment was received.

### 4. Factual Background

4.1 The Complainant has traded under the name "GIFT VOUCHER SOLUTIONS" (the 'Name') since August 2010, having been registered at Companies House under its current name (Gift Voucher Solutions Limited) since that date.

4.2 The Complainant registered *giftvouchersolutions.com* and the Domain Name in 2010. It trades online through its website hosted at [www.giftvouchersolutions.com](http://www.giftvouchersolutions.com).

4.3 The Complainant accidentally failed to renew its registration of the Domain Name at some point prior to April 2014.

4.4 The Respondent registered the Domain Name on 10 April 2014.

4.5 The Complainant is the registered proprietor of a UK trade mark for the Name (UK00003310946), and phrases that include the Name (UK00003307774, UK00003354071), all of which were registered in 2018.

4.6 The Complainant and Respondent provide competing services that enable restaurants and hospitality businesses to sell gift vouchers online.

## 5. Parties' Contentions

### The Complaint

For the purposes of this section of the Decision, the Expert has summarised the submissions of the Parties but only insofar as they are relevant to the matters that the Expert is required to determine under Nominet's Dispute Resolution Service ('DRS') Policy (the 'Policy').

- 5.1 In summary, the Complainant submitted that the Complaint should succeed for the reasons below.

#### The Complainant's Rights

- The Complainant has Rights in respect of a name or mark which is identical to the Domain Name, in that it is the registered owner of the UK trade mark "GIFT VOUCHER SOLUTIONS" (the 'Mark').
- The Name has been used by the Complainant for trading for almost nine years, generating over "*£34 million of gift voucher sales*", and it has "*established [itself as] an industry leading name, brand and reputation.*"
- The Name is recognised by trade clients as indicating the services of the Complainant, as can be seen from various links to its website and Facebook page, along with Google search results (organic and paid), various press releases and invoices to trade clients and from trade suppliers.
- The Complainant had previously registered the Domain Name, but the registration "*had fallen through the renewal net in 2012 due to an internal email error*" and it was then purchased by the Respondent who trades as *Gift Voucher Brilliance*. [Proof of the original registration was provided.]

#### Abusive Registration

- The Domain Name was registered by the Respondent to enable the Respondent to unfairly disrupt the Complainant's business by trying to pass off its trading as the Complainant's.
- The Respondent is causing confusion in the marketplace by "*positioning their Google keywords, website content and Google Advertising to pass off as Gift Voucher Solutions Limited.*"
- Further, the Respondent has pointed the Domain Name to the Respondent's own website, *www.giftvoucherbrilliance.co.uk*, which is a direct attempt by the

Respondent to confuse potential or existing clients of the Complainant and could cause harm to the Complainant's reputation, brand, clients or partners.

- Finally, the Complainant noted that, in response to a request that the Domain Name be transferred to the Complainant, the Respondent offered to sell the Domain Name for £20,000.

### The Respondent's Response

5.2 In summary, the Respondent submitted that the Domain Name should not be transferred to the Complainant for the reasons set out below.

#### **The Complainant's Rights claim**

- The Complainant does not have Rights in respect of a name or mark which is identical or similar to the Domain Name.
- The Respondent summarised the 2018 communications it had with the Complainant and explained that it had refused to transfer the Domain Name to the Complainant when requested to do so.
- The Respondent explained that it received a response from the Complainant advising that, unless the Respondent refrained from using the term '*Gift Voucher Solutions*' immediately, court action would be commenced. [The Expert notes that no legal proceedings have been lodged to date.]
- The Respondent submitted that it "*has been providing marketing services and software solutions to hotels and restaurants for 26 years (since 1992)*", and it "*first developed [its] Gift Voucher Solution 10 years ago*" in order to provide an alternative to the previous "*manual*" voucher process.
- The Respondent's original solution was called "*Gift Voucher Pro*" but this was changed in 2014 to "*Gift Voucher Brilliance*", in line with other solutions it has such as "*Email Marketing Brilliance*."
- The Respondent noted the Complainant's statement that the domain "*fell through their renewal net*" six years ago in 2012, and that the Complainant "*only discovered [this] in May 2018, four years after we purchased it.*"
- The Domain Name has been pointing to the same domain "*for years*", [www.giftvoucherbrilliance.co.uk](http://www.giftvoucherbrilliance.co.uk), and the Respondent has not made any recent changes to it.

### **The Complainant's Abusive Registration claim**

- The Respondent explained that it had reviewed all the paperwork submitted but considers that the term *"gift voucher solution"* is not unique but is descriptive of the *"actual description of the service offered to our clients."* The Respondent considered that the *"term is used widely by multiple companies/competitors in the marketplace who all provide these services."*
- The Respondent submitted that it *"did not purchase the domain with malice in mind, more the opportunity to secure the description of the service we provide"*, and it had searched for *"a domain [name] that described the type of work [it] undertake[s] and [it] felt it fitted the description perfectly."*
- The Respondent submitted that it did not acquire the Domain Name in bad faith, but rather as a key search term of the service it offers.
- Finally, the Respondent evidenced a copy of its 2016 printed brochure, one of its presentations and its website <https://www.giftvoucherbrilliance.co.uk/>, and stated that such marketing material is *"littered with the terminology 'gift voucher solution' as that is one of the services we provide."*

### **Complainant's Reply**

5.3 In summary, the Complainant submitted that:

- *"Gift Voucher Brilliance"* was established in 2014 as a trading name of the Respondent, being a direct competitor of the Complainant (who had been established since 2009);
- though the Respondent claimed that they developed a *"Gift Voucher Solution"* ten years ago, the Respondent did not register the domain names [www.giftvouchersolutions.com](http://www.giftvouchersolutions.com) or [www.giftvouchersolutions.co.uk](http://www.giftvouchersolutions.co.uk) at the same time, which were both available;
- the name and terms *"gift voucher solution"* and *"gift voucher solutions"* were totally unknown 10 years ago until the Complainant established a successful business and brand in the gift voucher marketplace;
- it had purchased the domain names [www.giftvouchersolutions.com](http://www.giftvouchersolutions.com) and [www.giftvouchersolutions.co.uk](http://www.giftvouchersolutions.co.uk) in 2010 during a rebrand from [www.buyagiftvoucher.com](http://www.buyagiftvoucher.com);

- due to a change in company credit card details and email accounts, the Domain Name it had registered did not automatically renew and, subsequently, it had no access to any email notifications that were sent to it;
- its error not renewing the Domain Name was only discovered in 2018 when external consultants working on the Complainant's trade mark applications and franchise proposals discovered it;
- it has legal grounds for "*passing off*" and "*trademark infringement*" against the Respondent, but no legal proceedings will be actioned until it has concluded the Complaint;
- the Domain Name had been "*sitting on a holding page until Summer 2018*" and is now "*pointing to the website [www.giftvoucherbrilliance.co.uk](http://www.giftvoucherbrilliance.co.uk)*";
- "*[i]ndependent SEO analysts have confirmed that [the Respondent] pay[s] to advertise keywords "Gift Voucher Solutions"*" which is "*a direct attempt to confuse potential clients and generate sales leads from our potential customers*";
- it considers it has rights to the Domain Name, noting that it has developed a reputation in the marketplace, so goodwill is attached to its Name;
- its customers are misled (or might be misled) into thinking that the Respondent and the Complainant "*are the same business as we are both in the same industry sector*"; and,
- the Respondent "*acquired the domain in bad faith, and not as a key search term of the services they offer, or they would not have offered to sell the domain to us for £20,000.*"

## 6. Discussions and Findings

### General

6.1 To succeed in the Complaint, the Complainant has to prove that, pursuant to paragraph 2 of the Policy, on the balance of probabilities:

*i. [it] 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.*

6.2 Addressing each of these limbs in turn:

### **Rights in respect of a name or mark which is identical or similar to the Domain Name**

6.3 The Expert considers that, for the reasons set out below, the Complainant has shown it has Rights in a name or mark which is identical to the Domain Name.

6.4 Paragraph 1 of the Policy defines "Rights" as:

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

6.5 The Expert considers that, at the time of the Complaint, the Complainant had Rights in the Mark which is identical to the Domain Name. In concluding the above, the Expert has disregarded the Domain Name suffix "co.uk".

6.6 The Expert also notes that the Complainant provided evidence of it having a reputation in the Name/Mark, having provided various business invoices and promotional material which reference the Complainant and the services it provides.

6.7 Indeed, the Expert considers that, while the Name might at first sight seem descriptive of the Complainant's business (as suggested by the Respondent), the UKIPO has registered the Name as a trade mark, and the duration and extent of trading is sufficient to support a finding of "Rights".

### **Abusive Registration**

6.8 For the reasons set out below, the Expert considers that the Domain Name is an Abusive Registration as understood by the Policy.

6.9 Paragraph 1 of the Policy defines "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. is being or has been used in a manner which has taken unfair advantage of or has been unfairly detrimental to the Complainant's Rights;*

6.10 In relation to the definition of Abusive Registration in sub paragraph (i), the Policy, at paragraph 5, sets out a non-exhaustive list of factors which may be evidence that the Domain Name is an Abusive Registration.

6.11 Specifically, the Expert considers that the factor set out at paragraph 5.1.1.3 of the Policy (*registered for the purpose of unfairly disrupting the business of the Complainant*) is relevant.

- 6.12 Both the Complainant and Respondent provide services in the same market, the provision of online shopping pages for the sale of gift vouchers, and both did so prior to 2014. Therefore, the Expert considers that the Respondent would have been well aware of the Complainant, and the Name, prior to registering the Domain Name.
- 6.13 Indeed, on the balance of probabilities, the Expert considers that the Respondent specifically chose to register the Domain Name at that time with the intention of benefitting from the Complainant's Mark and reputation and goodwill – in order to use the Domain Name to link to its website, [www.giftvoucherbrilliance.co.uk](http://www.giftvoucherbrilliance.co.uk), the consequence of which being to disrupt unfairly the business of the Complainant.
- 6.14 Therefore, for the reasons set out above, the Expert considers that the registration of the Domain Name took unfair advantage of, and was unfairly detrimental to, the Complainant's Rights.
- 6.15 So far as the definition of Abusive Registration in sub paragraph (ii) is concerned, the Expert considers that the Domain Name was and is an Abusive Registration as a result of its manner of use by the Respondent, for the reasons explained below.
- 6.16 Specifically, the Expert considers that the factor set out at paragraph 5.1.2, 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*), is relevant.
- 6.17 As evidenced to the Expert, the Respondent uses the website connected to the Domain Name (the '**Website**') to provide competing services to the Complainant via its linked website - [www.giftvoucherbrilliance.co.uk](http://www.giftvoucherbrilliance.co.uk). The Expert also notes the reference by the Complainant that the Respondent has previously paid to advertise keywords "*Gift Voucher Solutions*", and positioned their Google keywords and advertising accordingly.
- 6.18 The Expert considers that anyone accessing the Website would likely be confused, at least initially (see DRS Experts' Overview (version 3 – para. 3.3)), into thinking that the Website and the services offered therein are the Complainant's or are somehow connected with the Complainant, with the Complainant potentially losing business opportunities by such confusion.
- 6.19 The Expert is not persuaded by the argument that a person accessing the Website would soon realise the mistake that the Website is not the Complainant's (e.g. because the look of the Website is different to that of the Complainant's or there is a disclaimer); the damage to the Complainant's business would already have been done, particularly given the overlapping nature of the Parties' respective businesses.



- 6.20 Indeed, the Expert considers that it is likely that at least some persons accessing the Website would have done so only because of the Complainant's goodwill and reputation in the Name/Mark.
- 6.21 In addition, the Expert considers the paragraph 5.1.6 of the DRS Policy is relevant as:
- a) the Domain Name is an exact match for the Name and Mark;
  - b) the Complainant's Mark has a reputation (see paragraphs 6.3 *et seq.* above); and
  - c) the Respondent has no reasonable justification for registering the Domain Name.
- 6.22 In relation to c) above, the Respondent submitted that "*gift voucher solutions*" is a descriptive term and, therefore, it is justified in using that term as part of the registration and use of the Domain Name. However, the Expert refers to his findings as set out in paragraphs 6.5 to 6.7 in this regard.
- 6.23 Noting the goodwill and reputation the Expert considers that the Complainant has in the Name/Mark, and that the Respondent is using the Domain Name to offer competing services, the Expert does not consider that the Respondent has reasonable justification for having registered the Domain Name.
- 6.24 The Expert has considered whether there is any other evidence before him to demonstrate that the Domain Name is not an Abusive Registration, including whether the Respondent is making fair use of the Domain Name, but does not consider there is.
- 6.25 In particular, the Expert notes that the Domain Name is identical to the Complainant's Name/Mark, registration of the Domain Name by the Respondent post-dates the Complainant's reputation, and the Respondent uses the Website to provide competing services to those of the Complainant.
- 6.26 Therefore, for the reasons set out above, the Expert considers that the use of the Domain Name took unfair advantage of, and was unfairly detrimental to, the Complainant's Rights.

## **7. Decision**

- 7.1 The Expert finds that, on the balance of probabilities, the Complainant has Rights in respect of a name or mark which is identical to the Domain Name and that the Domain Name, in the hands of the Respondent, is an Abusive Registration. Therefore, the Expert directs that the Domain Name be transferred to the Complainant.

**Signed: Dr Russell Richardson**

**Dated: 22 February 2019**