

DISPUTE RESOLUTION SERVICE

D00021078

Decision of Independent Expert

Winmau Dartboard Company Limited

and

SEO Dundee

1. The Parties:

Complainant: Winmau Dartboard Company Limited
Address: Nodor House South Road
Bridgend Industrial Estate
Bridgend
Wales
CF31 3PT
United Kingdom

Respondent: SEO Dundee
Address: 18 James Street
Carnoustie
Angus
DD7 7JY
United Kingdom

2. The Domain Name:

winmau.co.uk (the "Domain Name")

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.

Definitions used in this decision have the same meaning as set out in the Nominet UK Dispute Resolution Service Policy Version 4, October 2016 (the “Policy”) unless the context or use indicates otherwise.

6 February 2019	Dispute received
6 February 2019	Complaint validated and notification of complaint sent to the parties
7 February 2019	Response received and notification of response sent to the parties
12 February 2019	Reply reminder sent
14 February 2019	Reply received and notification of reply sent to the parties
14 February 2019	Mediator appointed
14 February 2019	Mediation started
20 February 2019	Mediation failed
20 February 2019	Close of mediation documents sent
25 February 2019	Expert decision payment received

4. Factual Background

The Complainant was founded in 1946 and has been operating under the name Winmau Dartboard Company Limited since 1976. The Complainant produces and retails, through a network of authorised distributors, a range of products relating to the game of darts and clothing. The Complainant sponsors World Champion darts players such as Andy Fordham and products are endorsed by professional darts players.

The Respondent has established a website at the Domain Name with the intention of offering the Complainant’s products for sale.

The Respondent registered the Domain Name on 18 January 2019. The Whois snapshot provided by Nominet in the dispute papers states that “*Nominet was not able to match the registrant’s name and/or address against a 3rd party source*”.

5. Parties’ Contentions

The Complaint

Complainant’s Rights

The Complainant’s assertion of rights in the name WINMAU is that:

1. The Domain Name is identical to the Complainant’s European Trade Mark registration no. 14979751 registered on 27 June 2016. The Complainant owns trade mark registrations in other countries for marks consisting of, or containing, the word WINMAU (a list of undated registrations is provided in the dispute papers; the registration numbers in some cases indicate registration in 2011 and 2012).
2. Since its foundation in 1946, the Complainant has evolved into a global company and the WINMAU mark has developed substantial public recognition and a reputation for producing exceptional quality darts products. The Complainant

has acquired unregistered rights in the name WINMAU by virtue of its extensive use of the name and substantial reputation and goodwill under it.

3. The Complainant operates at www.winmau.com.
4. WINMAU dartboards are exclusively endorsed by the British Darts Organisation (the founding body of darts worldwide) since its inception in 1973.
5. WINMAU dartboards are exclusively used at the televised Lakeside World Professional Darts Championships and the Winmau World Masters (the world's oldest major darts tournament, established in 1974).
6. The Complainant's products are exported to more than 70 countries.
7. The Complainant sponsors World Champions including Dennis Priestley, Andy Fordham, Ted Hankey, Mark Webster and Trina Gulliver as well as Professional Darts Corporation stars such as Simon Whitlock, Daryl Gurney and Mervyn King.
8. In each of the past five years, the Complainant has sold over 1 million products (including accessories) under the WINMAU name. The Complainant's annual retained profit and net worth for the years 2013 to 2017 were:

Year	Annual Retained Profit	Net Worth
2013	£208,000	£1,234,000
2014	£298,000	£1,531,000
2015	£345,000	£1,877,000
2016	£470,000	£2,347,000
2017	£337,000	£2,683,000

Abusive Registration

The Complainant's assertions of Abusive Registration are:

1. The Respondent is using the Domain Name to direct to a commercial website which purports to retail a range of WINMAU branded darts equipment, including dartboards, darts, dart accessories and clothing.
2. The Respondent has registered or otherwise acquired the Domain Name primarily for the purpose of unfairly disrupting the business of the Complainant (paragraph 5.1.1.3 of the Policy):
 - a. The unfair disruption relates both to the confusion caused and to the Respondent's use of the Domain Name to sell direct-to-consumer.
 - b. The Complainant does not sell any of its WINMAU products to the public directly.
 - c. The Complainant has invested considerable resources over many years in building the WINMAU brand into a global leader and a large part of its success is attributed to its network of worldwide distributors.
 - d. The Complainant's distributors invest significant time, money and effort into promoting the WINMAU brand via their sales channels and various

- marketing initiatives and they do so in the knowledge that the Complainant does not sell direct to the consumer and so will not undermine their efforts.
- e. The site at winmau.co.uk will have a potentially damaging effect on the Complainant's entire sales structure and possibly jeopardising relationships with channel partners and thus the Complainant's own revenues.
3. The Respondent is using the Domain Name in a way which 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 (paragraph 5.1.2 of the Policy):
 - a. The Respondent is not, and never has been, an authorised distributor of the Complainant, despite the Respondent's claim to be an "Official Retailer".
 - b. There is a serious risk that (a) a search engine, which is being asked for the Complainant, will produce on its list the URL for the website connected to the Domain Name, and (b) an Internet user guessing the URL for the Complainant's website will use the Domain Name for that purpose.
 - c. Registration of the Domain Name will undoubtedly result in initial interest confusion.
 - d. The nature, appearance and content of the website to which the Domain Name is linked compounds the false impression that it is registered to, operated or authorised by, or otherwise connected with the Complainant. In particular, the Respondent is using the Complainant's registered trade mark, together with its renowned strapline "THE FORCE BEHIND DARTS" on that site.
 4. The Respondent may try to raise in defence of its actions that it has used the Domain Name in connection with a genuine offering of goods (under paragraph 8.1.1.1 of the Policy). Such a defence has no merit. Deliberately trading off the Complainant's Rights and setting up a situation where the public will be deceived into believing that they are dealing with the Complainant or a party connected to it cannot amount to a "genuine" offering.
 5. The Domain Name is an exact match (within the limitations of the character set permissible in domain names and discounting the domain suffix as it is of no relevant significance and wholly generic) for the name or mark in which the Complainant has Rights. The Complainant's mark has a reputation and the Respondent has no reasonable justification for having registered the Domain Name (paragraph 5.1.6 of the Policy).
 6. The name/mark WINMAU is inherently highly distinctive and exclusively attributable to the Complainant. The Respondent is plainly aware of the Complainant's reputation, having stated, in small print at the bottom of its home page:

"We are of the opinion that Winmau are without doubt the premium brand in Darts"

The Response

The Respondent says that the Complaint should not succeed because:

1. The Domain Name was available for a number of years prior the Respondent's purchase. The Respondent says that if the Domain Name was of interest the Complainant would have purchased it.
2. The Respondent says that emails from his Winmau Agent confirm authorisation to use all information and branding on the website at the Domain Name.
3. The Respondent has a trade price list enabling the population of the website at the Domain Name with a good retail price structure and is, therefore, not undervaluing the brand. The Respondent says it is not discounting the products whereas many other Winmau retailers are heavily discounting the brand online.
4. The website at the Domain Name is a professional ecommerce system which has 1024bit Encryption (SSL).
5. The website at the Domain Name clearly states in the contact section that the Respondent is a Winmau Retailer.
6. The Domain Name has been registered before a number of times as evidenced by https://web.archive.org/web/*/winmau.co.uk and <http://www.hosterstats.com/historicaldns.php?domain=winmau.co.uk>.
7. The Respondent asks whether a complaint has been lodged regarding the Domain Name on previously registered owners. If there was abuse of registration it would have been during that period of public 'for sale' (<https://web.archive.org/web/20140228161453/http://www.winmau.co.uk/>).

The Reply

The Complainant replies to the Response as follows:

1. The Respondent's assertion that the Domain Name had been freely available to purchase for a number of years and the Complainant did not register it does not demonstrate that the Domain Name is not an Abusive Registration. All complaints must be directed at domain names which were originally available to, but not acquired by, the legitimate brand owner.
2. The Respondent's assertion that it received approval from its Winmau agent to use "all information and branding" on its website relies on part of an email exchange between the Respondent and Mr Paul Towriss. The Complainant has now seen a full copy of this exchange which it presents in evidence. The Complainant denies that it consented to use and registration of the Domain Name:
 - a. Mr Towriss is an external authorised sales agent for the Complainant and is authorised by the Complainant to deal with matters relating to the sale of the Complainant's products only, including setting up accounts, dealing with sales, pricing, stock queries and so on. However, Mr Towriss is not an employee of the Complainant and is not responsible for the trade mark WINMAU.
 - b. In the e-mail exchange between Mr Towriss and the Respondent, it is clear that Mr Towriss only became aware of the registration of the Domain Name on 7 February 2019, the day after the Complaint was submitted.

- c. In his e-mail dated 20 January, Mr Towriss says “*you can use anything on web site. And you can use any branding from the web site*”.
Mr Towriss would have been directing the Respondent to the media portal page on the Complainant’s own website to use the photos and graphics it contains and he did so without knowledge that the Respondent had registered the Domain Name.
The evidenced printout of that page shows that a number of marketing and other materials are available for download, including website banners for particular products and product catalogues. Mr Towriss would facilitate the use of the Complainant’s advertising materials on the understanding that would naturally help sales of the Complainant’s products.
However, the exchange of e-mails does not support the Respondent’s contentions. Mr Towriss could not, and did not provide, consent to registration and use of the Domain Name.
 - d. Mr. Towriss’s emails do not in any way constitute consent by the Complainant to use the Domain Name, nor consent to use the Complainant’s registered trade marks in such a way so as to cause confusion and mislead the public into believing that the Domain Name is registered to, operated or authorised by, or otherwise connected with the Complainant.
3. In reply to the Respondent’s assertion that the contact section “*clearly states that we are a Winmau Retailer*” the Complainant submits that this qualification would likely go unnoticed by the average user and initial interest confusion would nevertheless have occurred prior to the statement being noticed.
Furthermore, the fact that the Respondent felt it necessary to include such a qualification is telling; the Respondent included it because it knew full well that the average consumer would quite naturally, but erroneously, assume that the website hosted at the Domain Name was operated by the Complainant.

6. Discussions and Findings

General

To succeed in this Complaint, the Complainant has to prove to the Expert on the balance of probabilities, pursuant to §2.1 and 2.2 of the Policy, both limbs of the test that:

2.1.1 The Complainant has Rights in respect of a name or mark which is identical or similar to the Domain Name; and

2.1.2 The Domain Name, in the hands of the Respondent, is an Abusive Registration.

Complainant's Rights

Rights is defined in §1 of the Policy 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*”.

The wholly generic suffix “.co.uk” may be discounted for the purposes of establishing whether a complainant has Rights in a name or mark which is identical or similar to a domain name.

The Complainant has evidenced extensive registered and unregistered rights in the name WINMAU. Accordingly, I find that the Complainant has Rights in the name WINMAU which is identical to the Domain Name.

Abusive Registration

Abusive Registration is defined in §1 of the Policy 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.*

A non-exhaustive list of factors which may be evidence that a domain name is an Abusive Registration is set out in §5.1 of the Policy of which the Complainant cites the following:

5.1.1 Circumstances indicating that the Respondent has registered or otherwise acquired the Domain Name primarily:

.....

5.1.1.3 for the purpose of unfairly disrupting the business of the Complainant;

5.1.2 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;

.....

5.1.6 The Domain Name is an exact match (within the limitations of the character set permissible in domain names) for the name or mark in which the Complainant has Rights, the Complainant’s mark has a reputation and the Respondent has no reasonable justification for having registered the Domain Name.

The crux of this Complaint is the use of the Complainant’s registered trade mark in the Domain Name unadorned by any other terms and which is being used by the Respondent to resolve to a website that will, the Respondent says, offer the Complainant’s products for sale.

The use of a trade mark in a domain name has been considered by experts many times and is the subject of a number of appeal panel decisions.

In *World Wrestling Entertainment, Inc. -v- Daniel Raad* (DRS 16416) “WWE panel” the panel said:

*“As a starting point simply using the name of another trader is likely to be objectionable. See 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”. The reason this is objectionable, so far as the Policy is concerned, is that it is likely to fall within ... [Paragraph 5.1.2 of the Policy]”*

.....

“It has also been generally accepted that where the Domain Name in question is in substance an unadorned reproduction of a Complainant’s trade mark (or a minor variant thereof) without any additional modifying terms, that will suffice to establish such confusion [as referred to in Paragraph 5.1.2 of the Policy], even if a visitor to the website linked to the Domain Name would realise once they got there that the site itself was nothing to do with the Complainant.”

In this Complaint, the Respondent clearly knows that WINMAU is the Complainant’s name but nevertheless he chose to register that name without any adornment. On the papers before me I cannot envisage any reason for doing so other than with the intention that it is recognised as the Complainant’s name in order to attract buyers to purchase products at the Respondent’s website. The Respondent says that he had permission to do so, the Complainant says that he didn’t.

The Respondent relies on his email exchange with Mr Towriss to establish that he had permission. However, at no time during this exchange does the Respondent ask for permission to register and use the Domain Name; the exchange concerns the opening of an account, pricing, supply, the setting up of an unnamed website selling only WINMAU products and the use of the Complainant’s product branding. The Respondent may say that he alluded to it by reference to “setting up a winmau website” in an email that he sent 2 days after registering the Domain Name, but Mr Towriss does not appear to have read anything into that. In any event it occurred after the registration of the Domain Name so it can hardly be taken as seeking permission.

The first time that the Respondent mentioned the Domain Name by name was in his email of 7 February 2019 in which he tells Mr Towriss that he has received this Complaint.

It is clear from the papers before me that the Respondent did not ask for permission, and Mr Towriss did not give permission, to use the Domain Name. In any case, the Complainant says that Mr Towriss does not have the authority to give such permission. Given the speed in which the Complainant raised the Complaint, just over 2 weeks after the Domain Name was registered, it is apparent that the Complainant does not take such use of its trade mark lightly and on that basis I cannot believe that the Complainant would have given Mr Towriss authority to give permission to register the Domain Name.

The Respondent's registration of the Domain Name thus falls squarely into the "*high risk activity insofar as the DRS Policy is concerned*" referred to by the WWE panel and is therefore likely to fall within §5.1.2 of the Policy.

The Domain Name is an unadorned use of the Complainant's trade mark WINAU. As the WWE panel says, this will suffice to establish the confusion required by §5.1.2 of the Policy, even if "*a visitor to the website linked to the Domain Name would realise once they got there that the site itself was nothing to do with the Complainant*".

That an unadorned use of the Complainant's trade mark is sufficient to establish confusion was also confirmed by the appeal panel in *Toshiba Corporation -v- Power Battery Inc* (DRS 07991) who said:

"..... So far as the name itself is concerned, the majority Panel believes that the Domain Name in this case falls into a very different category from cases involving the "unadorned" use of a trade mark (e.g. <toshiba.co.uk>), where Internet users may be presumed to believe that the name belongs to or is authorised by the complainant."

The WWE panel, in considering the Toshiba appeal, said:

"When addressing whether it would be fair to offer competing goods, the [Toshiba] Panel said the following:

"The further issue, however, is whether the fact of the offering of competitive products on the Respondent's website is sufficient to render the registration abusive, even in the absence of "initial interest confusion". On this question, the Panel unanimously considers that, if and insofar as it is fair for a retailer to incorporate a trade mark into its domain name without the trade mark owner's consent, to accord with the principles stated above that fairness is likely to be dependent upon the retailer only selling the trade mark owner's genuine products. To do otherwise is likely to take unfair advantage of the Complainant's rights by "riding on its coattails" for the benefit of the Respondent. This element of unfair advantage remains, even where little or no detriment to the Complainant has been demonstrated."

The Respondent, in his email exchanges with Mr Towriss, says that he is "looking to build a winmau website selling only winmau products". Whilst the website at the Domain Name at this time only presents WINMAU branded products for sale, it states on the "About Us" page the list of brands "supplied by us" and immediately following short description of the WINMAU brand is the announcement:

"More Brands to Come!"

I take this to be a clear intention that the Respondent is planning to offer competing products to the WINMAU products in the future.

Notwithstanding the stated intention to sell competing products, where a domain name is used to sell only a complainant's products, the WWE panel concluded that:

“... as a matter of broad principle, the Panel considers the position to be as follows in relation to cases where the complaint concerns a domain name where the alleged abuse is said to arise in respect of a website which is used to sell only the genuine goods or services of the complainant.

If:

- 1. a website is linked to a domain name; and*
- 2. the website is used to sell only the genuine goods or services of a third party; and*
- 3. the third party alleges the domain name is an Abusive Registration; and*
- 4. the third party has relevant Rights in respect of a name or trade mark.*

Then:

- 5. Use of the name or trade mark concerned in unadorned form as a domain name is likely to amount to an Abusive Registration.*

.....

In stating these principles the Panel would add as follows:

- 8. These are not absolute rules, hence the use of the terms “likely” and “less likely” – all relevant circumstances need to be taken into account and other factors may be relevant and result in a different conclusion being reached.*

..... such factors could include for example: the strength or fame of the name or trade mark in question; the nature and price of the goods or services being offered; the sophistication or otherwise of the likely consumers of such goods or services; questions of licence or permission; and any relevant contractual arrangements between the parties. Further factors such as the nature, appearance and content of the website to which the domain name is linked, and the extent to which any disclaimers are used on that website, may also be relevant in a given case if it appears appropriate to consider the case on the basis of matters beyond initial interest confusion.

- 9. As stated above these principles apply where the website in question is selling only the goods or services of the owner of the name or trade mark concerned. If competing or counterfeit products are also or alternatively being sold then still further considerations may apply and a given domain name which would not amount to an Abusive Registration in accordance with these principles may nevertheless be found to be so when such additional considerations are taken into account.*

I find on the papers before me that the Respondent's registration and use of the Domain Name at this time satisfies the principles set out by the WWE panel in paragraphs 1 to 4 above and, taking all of the circumstances into account, namely:

- the strength, fame and distinctiveness of the WINMAU mark;
- the absence of permission to use the mark in the Domain Name;
- the absence of any contractual arrangement being presented by either party;
- the nature and appearance of the website at the Domain Name being entirely WINMAU products apart from the announcement in the "About us" section, which purchasers are in my view unlikely to visit;
- the only disclaimer is in the "Contact" section which states the Respondent is a Winmau Retailer is again in a section of the website that purchasers are unlikely to visit;
- the Respondent could have selected other names as a business start-up;
- given the high profile of the name WINMAU in relation to darts products and the sponsorship of professional darts players, any darts enthusiast is likely to type in the Domain Name thinking it would take them to the Complaint's website,

I also find that the Respondent's registration and use of the Domain Name falls into paragraph 5.

Accordingly, the use of the Complainant's mark WINMAU unadorned in the Domain Name does amount to an Abusive Registration and there are no circumstances presented in the papers before me that would lead me to find otherwise.

In light of the overriding nature of the foregoing, I do not consider it necessary to consider the parties' respective submissions any further.

7. Decision

In light of the foregoing findings, namely that the Complainant has Rights in a name which is identical to the Domain Name, and that the Domain Name, in the hands of the Respondent, is an Abusive Registration, I direct that the Domain Name be transferred to the Complainant.

Signed

Steve Ormand

Dated: 15 March 2019