

## **DISPUTE RESOLUTION SERVICE**

**D00022440**

### **Decision of Independent Expert**

**SKIP NETS UK LTD**

and

**Ratchet Straps UK Ltd**

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

Lead Complainant: SKIP NETS UK LTD  
Lower Spews Pout Barn  
Off School Lane, Guide  
Blackburn  
Lancashire  
BB1 2LW  
United Kingdom

Respondent: Ratchet Straps UK Ltd  
2 Madox Brown End  
COLLEGE TOWN  
SANDHURST  
GU47 0GJ  
United Kingdom

#### **2. The Domain Name(s):**

skipnet.co.uk (“the Disputed Domain”)

### **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 being of a such a nature as to call in to question my independence in the eyes of either party.

09 March 2020 19:49 Dispute received  
10 March 2020 15:04 Complaint validated  
10 March 2020 15:08 Notification of complaint sent to parties  
27 March 2020 01:30 Response reminder sent  
01 April 2020 13:09 Response received  
01 April 2020 13:10 Notification of response sent to parties  
02 April 2020 09:44 Reply received  
09 April 2020 10:00 Notification of reply sent to parties  
09 April 2020 11:00 Mediator appointed  
09 April 2020 12:19 Mediation started  
04 May 2020 10:11 Mediation failed  
04 May 2020 10:11 Close of mediation documents sent  
12 May 2020 15:50 Expert decision payment received

### **4. The Legal Framework**

4.1 The complaint is brought under the Nominet DRS Policy which applies to all .uk registrations by virtue of the terms and conditions of registration. By clause 9.1 of those terms and conditions all registrants agree to be bound by the DRS Policy and by clause 13.6 that Policy forms part of the terms and conditions of registration of a .uk domain.

4.2 The DRS Policy applicable to this dispute is Version 4 in force since 1 October 2016. Paragraph 1 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) 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”.

In the same paragraph Rights are defined 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”.

4.3 Paragraph 2 of the DRS Policy provides as follows:

**“2 Dispute to which the DRS applies**

2.1 A Respondent must submit to proceedings under the DRS if a Complainant asserts to us, according to the Policy, 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.

2.2 The Complainant is required to prove to the Expert that both elements are present on the balance of probabilities.”

4.4 Paragraph 5 of the DRS Policy contains a non-exhaustive list of factors which may be evidence that a domain name is an Abusive Registration. They include the following factor which is implicitly relied upon by the complainant in the present case:

“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 by, or otherwise connected with the Complainant.”

**5. Factual Background**

5.1 The facts set out in this section are taken primarily from the parties’ submissions. As will become clear, however, the submissions on both sides contain very little information. I have therefore taken the relatively unusual step in a DRS dispute of looking at the parties’ respective websites and of carrying out searches for the term “skip net” on Bing, Google and Yahoo in order to provide me with some information to assist in determining the complaint. As will be seen, those researches have confirmed the conclusions I would have reached had I relied upon the limited information in the submissions.

5.2 The complainant is a company registered in England in 2006. It has a number of domains which include the term “skip net” in a variety of forms. The complainant says that it acquired the domains skipnets.co.uk and skipnets.com in 2006. It explains that it registered these domains “due to being the main products we sell in the uk”. It also says that it has the following further domains registered for similar terms:

uk-skipnets.co.uk  
skipnet-uk.co.uk

ukskipnets.co.uk  
uk-skipnet.co.uk  
skipnets-uk.co.uk  
skip-net.co.uk  
skip-nets.co.uk

5.3 The complainant says that it has used the name “skipnets” for 14 years to bring traffic to its website. It says that it has by a great deal of hard work secured page one listings on Google and other search engines. My searches have confirmed the accuracy of that claim. For each search the complainant was the first or second organic search result for the search term “skip net”. The complainant says that it registered the domain skip-nets.co.uk to prevent what it calls others “piggy backing to gain and mislead customers in the past”. The complainant has provided no information about its advertising or its turnover or the extent to which it has promoted the name skipnet as being a trade mark rather than a description of a particular kind of product. The summary in this paragraph sets is essentially all the information I have been given by the complainant.

5.4 The respondent says that the term skip net, whether in the form of one word, two or hyphenated, singular or plural “is an industry standard term and refers to a type of covering used primarily to cover refuse skips of varying sizes, and also other objects such as cars, post pallets, cages and roll cages.”. The respondent then says “It is a generic terms which applies to many different cover constructions, supplied by many different companies globally”.

5.5 The respondent says that the Disputed Domain relates to the product being offered on its site which is a skip net. It points out that its identity is clearly stated on its website which has terms and conditions and gives contact details. This is not quite correct. The site certainly does identify the person behind it but it gives a company called Matthews Direct Imports Limited of Unit 1 Kendall Court, 4 Doman Road, Camberley GU15 3DF as both the operator of the website and the person with whom customers are doing business. Given that the individual who is the contact for the Disputed Domain is a Mr Matthews, it seems to me that it is reasonable to assume that all three are closely connected. The complainant asserts that the Disputed Domain simply hosts a website. There is no registered company, address location or landline number. It is clear from my review of the site as it now is that that is currently not so (even if it was when the complaint was lodged). There is also a landline number (0333 772 1869) albeit that this is non-geographic code.

5.6 The respondent says that a simple Google search reveals many companies advertising skip nets. The results of my searches accord with this submission and indicate that the term “skip net” is used to describe a net for covering a skip. The searches bring up a number of websites offering “skip nets” for sale, as well as many offering skips for hire. I attach as Annex 1 a print of the first page of a Google search for the term “skip net” to illustrate what one sees. It is immediately obvious that there is considerable use of the term descriptively in many of the listings.

5.7 The complainant's website itself lists a range of products on different pages, one of which is headed "skip nets". Others have different products on them such as "hook loader nets", "sheeting parts", "sheeting systems", "skip loader nets" and "tarps". I have not attempted to discover what all these different products are or what are the differences between them. Similarly the respondent's website offers products called "skip nets" with a large heading saying "Welcome to the home of the Skip Net Full website coming soon".

5.8 Finally under this section of the decision, and for completeness only, I note that the respondent has pointed out that it reserves the right to pursue a copyright infringement claim for use of some of the photographs used on the complainant's website which it has identified in links to the complainant's website listed in the response. The complainant's answer in the reply is that it uses photographs supplied by its own product suppliers. I am not asked or in a position to comment on this dispute and I mention it only because it has been raised and responded to by the parties. It is plainly irrelevant to anything I have to determine.

## **6. Parties' Contentions**

6.1 The complainant says that the Disputed Domain "is being used to confuse internet users and steal potential customers from us as they are selling the exact same products we sell". It is worth noting that in the reply, the complainant (having noted that the respondent also sells ratchet straps) puts the complaint in these terms:

"I would not dream of using a similar domain of theirs to sell or advertise the ratchet straps we sell.

If they were selling guitars this would not bother our company but in this case they are selling the same products as we do mainly skip nets."

6.2 The complainant says that it has done all the hard work and that the respondent is now seeking to reap the benefit, having seen that the complainant has a good online presence. The complainant asserts that the respondent will pick up customers that the complainant has worked to gain.

6.3 The complainant says that the respondent is advertising in the same magazine as the complainant and believes that this is being done deliberately to cause confusion. The complainant has not suggested that there has been any actual confusion or given me a copy of the allegedly confusing advertisement(s) so that I cannot determine whether there is any substance in this allegation. I should note that the complaint says that "in the past" someone using the first name of the individual behind the complainant had been trying to sell to some of its customers. I have disregarded this allegation as it does not seem to concern the respondent.

6.4 In answer the respondent says that there is no attempt to confuse internet user or customers and points out that the companies have very different locations

and presentation styles. There is no response to the allegation about advertising in the same magazine.

6.5 The respondent also points out that there are many companies advertising skip nets and asserts that advertisements will be triggered by variations of the spellings of the product name. Unfortunately, the respondent has provided no examples of this so again I cannot determine the validity of this claim, although it would seem to be consistent with the variations that the complainant has registered as domains. My searches do, however, confirm that a number of listings advertising skip nets are triggered in response to a search for “skip net” (see Annex 1 to this decision).

## **7. Discussions and Findings**

### ***Rights***

7.1 The first question in any DRS dispute is to determine whether the complainant has “Rights” as defined by the DRS Policy (see paragraph 4.2 above). As noted in the definition, this may include rights in a descriptive term which has acquired a secondary meaning. Secondary meaning is a term used in the law of passing off to identify a term which, although having a primary meaning descriptive of a kind of product or a characteristic thereof, has come to mean also goods coming from a specific trade source. The right to make a claim for passing off in such circumstances was first recognised in the case of *Reddaway v Banham* [1896] AC 199, a case in which the plaintiff succeeded on this basis in establishing passing off by the use of the term “camel-hair belting”.

7.2 The classic formulation of this kind of passing off claim was given by Parker J (as he then was) in the case of *Burberrys v Cording* (1909) 26 RPC 693 at 704 where he said:

“If [the word] has come to distinguish [the plaintiffs’] goods from those of others, it has done so by acquiring a secondary meaning without losing its descriptive character. Though I do not agree with the argument that a word cannot be at the same time both descriptive and distinctive, I think that the fact that it retains its *prima facie* descriptive signification increases the difficulty of proving that it is distinctive of the goods of any particular manufacturer.”

This formulation makes clear that to succeed in a claim for passing off on the ground that a descriptive term has acquired such a secondary meaning does not require the word to have lost its primary descriptive connotation but that, if it has not, considerably greater evidence will be required to demonstrate the existence of the secondary meaning. The reason for this is self-evident: if the term retains its descriptive meaning, then it has to be shown that the use of which complaint is made is such as not merely to describe the goods but to associate them with the trader claiming to have created the secondary meaning.

7.3 In the present case, it seems to me that that the complainant is indeed alleging that the term “skip net” has come to denote its products rather than simply being used as a term to describe that particular kind of article.

7.4 Both common sense and my internet searches confirm the respondent’s claim that the term “skip net” is the term used in trade to describe a net for covering a skip. The complainant’s own website uses the term in precisely this way. Indeed, it is clear from the quotations from the complaint set out above that the complainant uses the term descriptively in order to explain why it is making the present complaint. That being so, it is necessary for the complainant to demonstrate that the term has come to identify either the complainant’s business and/or goods connected in the course of trade with the complainant.

7.5 For the complainant to do so, it would be necessary to provide evidence showing that purchasers and prospective purchasers of skip nets regard the term as identifying goods supplied by the complainant rather than just as a particular kind of product. The complainant has produced no such evidence. On the contrary, the information the complainant has provided indicates that it uses the term descriptively on its own website to distinguish skip nets from the other products that it sells.

7.6 The complainant relies on its clearly very effective search engine optimisation (SEO) activity which has resulted in its site being the first or second organic search result on three major search engines. However, it seems to be that this is beside the point. What that shows is that the complainant has successfully linked its website to the descriptive term “skip net” so that it appears in response to a search for that term. This undoubtedly brings in significant trade but it does nothing to demonstrate the required secondary meaning. In my view it probably demonstrates the reverse: that the complainant has found a way of ensuring that internet users searching for a particular kind of product (i.e. using the term skip net descriptively) are directed to its site.

7.7 In these circumstances it seems to me to be clear that the complainant has failed to establish that it has the Rights as defined in the DRS Policy which are required to enable it to claim that the Disputed Domain is an Abusive Registration.

### ***Abusive Registration***

7.8 It is accordingly unnecessary for me to determine whether the respondent is acting in such a way as to make the Disputed Domain an Abusive Registration within the meaning of the DRS Policy. I comment for completeness only that I can see nothing in the material provided to me or which I have seen during the course of my researches that would suggest that this is the case. The respondent seems to me to be using the Disputed Domain descriptively, presumably with the intention in due course of using SEO to attract in potential customers in the same way that the

complainant has been doing for many years. There is no evidence that anyone has been or is likely to be confused by the respondent's activities into believing that the parties are connected or associated with each other.

7.9 The complainant has to accept that, having itself chosen a descriptive term to generate its SEO success, others may see that success and try to emulate it. That is the difficulty with using such terms as the primary means of attracting custom, particularly when advertising on the internet.

## **8. Decision**

8.1 For the reasons set out above I reject the complaint and direct that no action is taken on it.

**Signed** Michael Silverleaf      **Dated** 30 May 2020



