

DISPUTE RESOLUTION SERVICE

DRS 6828

Decision of Independent Expert

Greenrose Network (franchise) Limited

and

Rimvydas Karpavicius

1. The Parties:

Complainant: Greenrose Network (franchise) Limited
Address: 41 High Street
Baldock
Herts
Postcode: SG7 6BG
Country: UK

Respondent: Rimvydas Karpavicius
Address: BM 1774
London
Postcode: WC1N 3XX
Country: UK

2. The Domain Name:

www.countryproperties.co.uk

3. Procedural History:

The Complaint was lodged with Nominet on 5 February 2009. Nominet validated the Complaint and notified the Respondent. A Response was submitted in time on 27 February 2009. The Complainant submitted a Reply in time. The dispute was not resolved in mediation. On 7 April 2009 the Respondent paid Nominet the appropriate fee for a decision of an Expert pursuant to paragraph 7 of the Nominet Dispute Resolution Service Policy ("the Policy").

Sallie Spilsbury, the undersigned (“the Expert”) confirmed to Nominet that she knew of no reason why she could not properly accept the invitation to act as Expert in this case and further confirmed that she knew of no matters which ought to be drawn to the attention of the Parties which might appear to call into question her independence and impartiality.

4. Factual Background

The Complainant

The Complainant is an estate agency business. It trades as Country Properties and has done so since 1976 (its business having originally been established under a different name in 1974). Further information about the Complainant’s use of the COUNTRY PROPERTIES mark is set out in section 6 of this Decision.

The Complainant uses the domain name “country-properties.co.uk”. The date on which use of this domain name began is not given. The Expert visited the Complainant’s website on 26 April 2009 and confirmed its existence and content. On the website the Expert was also able to access a PDF version of the Complainant’s brochure.

The Respondent

A Nominet Whois search shows that the Respondent registered the Domain Name on 7 August 2004. The Respondent’s status is shown as “UK individual”. On 26 April 2009 the Domain Name did not resolve to any webpage, seemingly indicating that the Respondent does not currently use the Domain Name in the course of trade.

5. Parties’ Contentions

The Complainant asserts that the Domain Name is an Abusive Registration. It relies on the following submissions in support:

- The way in which the Domain Name is presently being seen means that it can be very confusing/misleading to the public and it is being exploited by the Respondent (wording taken from the Complaint).
- The Domain Name is currently for sale under a bidding scenario for offers over £5000. (No supporting evidence of this is provided.)
- There was an unfair motive when the Domain Name was registered. In this regard the Complainant relies on the offer for sale through the bidding scenario referred to above.
- The Respondent has a history of registering Domain Names which relate to trade marks in which he has no apparent rights. In support the Complainant refers to a previous DRS decision against the Respondent; *Alfendo Limited trading as Airline Warehouse v Rimvydas Karpavicius (DRS 01576)* and to a domain name, *bbcweather.co.uk*. On 26 April 2009 the Expert conducted a Whois search for *bbcweather.co.uk* which confirmed that the registrant is the Respondent who registered it on 17 November 2003.

The Respondent denies that the Domain Name is an Abusive Registration.

The Respondent describes himself as being in the business of buying, selling and monetising domain names. He registered the Domain Name in 2004 when he became aware that it was about to “drop” and he assumed that the (undisclosed) previous owner of the Domain Name no longer wanted it. He thought that it was a potentially attractive domain name because it reflected a common generic term relating to the property business. The Respondent owns a

number of other, what he terms, “generic”, property-related domain names which he registered in 2003-2007. By way of example, these include “englishcountrycottages.co.uk”, “ukproperties.co.uk” and “commercialproperties.co.uk”. He states that when acquiring these domain names he had in mind profiting from advertising links and ultimately sale of the domain names “at some point” to “someone with an interest in the area”. The Respondent states that shortly after registration of the Domain Name he connected it a parking page provided by a third party provider. The Complainant has not referred to any parking of the Domain Name in its submissions.

As stated in section 4 above, this parking arrangement no longer seems to be in place.

The Respondent relies on the legal case of *Office Cleaning Services v Office Cleaning Association (1946) 63 RPC 39*. The Expert is not inclined to take direct account of this authority. The Policy and Dispute Resolution Service are designed to be accessible to all; lawyers and no lawyers alike. To introduce complex legal concepts into decision making is inappropriate.

The Respondent relies on the following submissions in support of his position:

- The Complainant has no Rights in the term “Country Properties”. It is a generic and descriptive term referable to properties in the country. The Respondent relies on the earlier DRS decision in *DRS 00752 (datingagency.co.uk)* to support the submission that a descriptive name which would be understood to refer to a category of services rather than to a particular service provider does not confer Rights under the Policy.

At Exhibit 1 to the Response the Respondent attaches a Google UK search carried out on 24 February 2009 against the term “country properties” showing the first 10 out of 46,100 results. One (the first) refers to the Complainant. The other results refer to more generic references unconnected to the Complainant. The Google search also reveals two other estate agents trading under the name “Country Properties” or similar. Printouts of the homepages of both websites are attached at Exhibit 2. It should however be noted that these two businesses operate outside the Complainant’s region. The first is based in Leicestershire and the second in Kent.

In the same vein Exhibit 3 is a list taken from Yell.com of some property businesses which use the names “Country Property” or “Country Properties” in their trading names. There are 18 businesses listed in the exhibit. Of the three which appear to trade in the same region as the Complainant, one is Country Properties Lettings and the other two business use prefixes alongside the phrase in question, namely “Phoenix Country Properties” and “Prestige Town and Country Properties”.

The Respondent concludes this first submission by noting that the public has no reason to associate the name with the Complainant rather than with its generic meaning or with the many other UK property businesses using the same or a similar name. Accordingly he denies that the term is capable of generating Rights for the purposes of the Policy or, alternatively, that the Complainant has not demonstrated that the term has acquired what lawyers would call a secondary meaning because of the use that the Complainant has made of the mark in the course of its business. The Expert will elaborate on the concept of secondary meaning below in section 6 of this Decision.

The Respondent makes the following additional submissions;

- The Policy provides that trading in domain names for profit and holding a large portfolio of domain names are not of themselves unlawful activities (Paragraph 4d). The Respondent’s business of trading in domain names is not therefore abusive in itself. The Respondent appears to accept that the Domain Name is for sale.

- The Respondent was not aware of the Complainant when he registered the Domain Name in 2004 or when he used the Domain Name. The Complainant only came to the Respondent's attention when it asserted this claim against him. There was no reason why the Respondent should be expected to know of the Complainant. He does not live in their catchment area and is not in the property business himself. The Respondent relies on the Appeal Panel Decisions in *Verbatim .co.uk (DRS 4331)* and *Maestro.co.uk (DRS 4884)* in this regard.
- Being unaware of the Complainant at the time of registration of the Domain Name the Respondent could not have registered it for the purposes of sale to the Complainant. There is nothing objectionable about offering a domain name for sale where it was not acquired with the intention of sale to the Complainant (relying on the DRS decisions in *parmaham.co.uk DRS 359* and *ghd.co.uk DRS 3078 (Appeal Panel)*).
- There is no explanation from the Complainant about how the Respondent's use of the Domain Name is confusing or misleading. Paragraph 4e of the Policy clarifies that connecting domain names to parking pages and earning click-per-view revenue is not of itself objectionable. Relying on the Appeal Panel decision in *wiseinsurance.co.uk DRS 4889* the Respondent submits that given the lack of goodwill (or at best its limited nature) generated by the Complainant's mark the likelihood of confusion is very low.
- The Policy requires the Complainant to establish that the Respondent is engaged in a pattern of Abusive Registrations (Paragraph 3aiii). This is not the case here, because
 - The Domain Name does not correspond to a well known name or trade mark and therefore cannot form part of a pattern of well known names or trade marks,
 - The domain name that the Respondent was required to transfer was not a well known name or trade mark (*airlinewarehouse.co.uk*) and so could not form part of a pattern,
 - *bbcweather.co.uk* is a single domain name and cannot form part of a pattern (the illegitimacy of the registration is not admitted by the Respondent),
 - The Domain Name is known as much for its ordinary English meaning as anything else and is part of an entirely different legitimate pattern of generic property-related domain names.

In its Reply the **Complainant** notes the following:

- It challenges the Respondent's statement that it was not aware of the Complainant at the time of registering the Domain Name. The Complainant suggests that a party in the same business as the Respondent would have entered the proposed domain name into a search engine "to see what came up" before buying it. If the Respondent had done so, he would have been aware of the Complainant (the Complainant submits that this is evidenced by Exhibit 1 to the Response- the printout of the Google search results as at February 2009 showing the Complainant as first result).
- It also states that it is clear that the Domain Name was purchased to profit from "by holding to ransom against those who had a vested interest in the name" (sic). It records that one of the Complainant's competitors has recently made an unsuccessful bid for the Domain Name.
- The Complainant refers to Paragraph 4 of the Policy which gives a non-exhaustive list of factors that the Respondent can show to displace an initial finding of Abusive Registration. Paragraph 4aii states that if the Respondent can establish that the Domain Name is generic or descriptive and that the Respondent is making fair use of it then a registration may not be abusive. The Complainant states as follows: "I can only agree that the [domain] name on its own is generic but for the reasons I have stated above and the fact that the respondent is certainly not making fair use of it I can only see it as an abusive registration".

6. Discussions and Findings

Paragraph 2 of the Policy provides as follows;

- a. A Respondent must submit to proceedings under the DRS if a Complainant asserts to us, according to the Procedure, 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.
- b. The Complainant is required to prove to the Expert that both elements are present on the balance of probabilities.

Rights

The Domain Name and the Complainant's COUNTRY PROPERTIES mark (and country-properties domain name) clearly satisfy the test of similarity under the Policy. The real question is whether the Complainant owns Rights in the COUNTRY PROPERTIES mark such as to engage the Policy.

Rights are partially defined in the Policy in the following terms;

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;

There is no evidence that the Complainant owns a registered trade mark in the COUNTRY PROPERTIES mark.

The Complainant is an estate agent business doing business in the Home Counties. It was the first estate agency business to be recognised as a franchise by the British Franchising Association (BFA) in 1984. It has since expanded to a 20-branch network across Hertfordshire, Bedfordshire and the borders of Cambridgeshire. The Complaint states that the client base is strong with a sizeable amount of repeat business and that the business is well regarded across the region it covers. No direct supporting evidence is produced in respect of this claim. A sheet of the Complainant's headed notepaper is annexed to the Complaint. It shows information indicating that among other matters the Complainant is a full member of the BFA and has been awarded the title "Estate Agents of the Year" by the Guild of Professional Estate Agents. The Respondent does not dispute this status. Also attached to the Complaint is an undated marketing leaflet. This features text and a photograph of the Complainant's signage. It describes the Complainant as "Leading the Way for Over 30 Years". It is notable that on the homepage of the Complaint's website, in the photograph appearing on the Complainant's marketing leaflet and on its headed notepaper, the name "Country Properties" is written in a stylised font in green and it is accompanied by a figurative device mark (or logo) modelled on what appears to be a flower. The letters "TM" often appear beneath the flower (but not the words) indicating that the device is used as a trade mark. The Country Properties mark also seemed to be used in conjunction with the logo (rather than on its own) in photographs throughout the Complainant's online brochure. It was only in the text of the marketing leaflet that the Complainant is referred to as "Country Properties" without any elaboration. This indicates that there is only limited use of the unembellished word mark in a trade mark context.

The Country Properties mark clearly refers to a type of service- the sale of houses in the country. To that extent it is descriptive (the Complainant appears to accept this in its Reply where it agrees that the Domain Name on its own is generic). The descriptive nature of the mark is confirmed to some extent by exhibits 1-3 to the Response which demonstrate that a number of property-related businesses use the phrase "Country Properties" (alone or in conjunction with other words) in relation to their business.

However it must be kept in mind that the Complainant has used the mark since 1976 (over 30 years). It is possible, as the Policy envisages, for a mark that is descriptive or otherwise non-

distinctive on its face to acquire distinctiveness through the use that the owner has made of the mark. In effect, a trader can overcome the inherent lack of distinctiveness and make the mark something that customers associate with that trader. This acquired distinctiveness is what is known as secondary meaning, as referred to in the definition of Rights in the Policy. It arises through use of the mark rather than from any inherent distinctive quality.

Has the Complainant been able to establish on the balance of probabilities that over the past 30 years or so it has traded in such a way as to make the Country Properties a brand that is associated with the Complainant in particular rather than functioning as a generic reference to a type of trader?

There is relatively little evidence about the way that the COUNTRY PROPERTIES mark has been used by the Complainant. In addition to the significant length of trade, the Complainant makes an unsupported statement that it has a healthy customer base. There are also references on its notepaper to the fact that it has been awarded the title Estate Agent of the Year. As noted above where the COUNTRY PROPERTIES mark *is* used, it is generally in a stylised form in combination with a figurative logo. This suggests that the Complainant itself recognises that the COUNTRY PROPERTIES mark lacks sufficient distinctiveness to function as a trade mark on its own. Nevertheless there is some limited use of the mark to refer to the Complainant business (for example in the marketing leaflet attached to the Complaint).

The Complainant's domain name, country-properties.co.uk is in active use and obviously functions without stylisation. There is no evidence before the Expert about the amount of hits and custom that the domain name has generated.

The Expert is mindful that the Rights requirement of the Policy is not intended to be a high threshold as stated in the guidance produced by Nominet for parties to complaints (accessible at www.nominet.org.uk/disputes/drs/rights/). Its objective is to ensure that a Complainant is a party with a proper interest in the Complaint. Nevertheless, the definition of Rights in the Policy makes it clear that they have to be enforceable at law.

Having reviewed the evidence the Expert finds that the Complainant has made out its case that it has Rights in the COUNTRY PROPERTIES mark through acquisition of a secondary meaning. In other words, the COUNTRY PROPERTIES mark is on the balance of probabilities associated by relevant customers in the Complainant's region of trade with the Complainant. The Expert acknowledges that because of the lack of supporting evidence this is a finely balanced judgement. The Expert places particular emphasis on the following factors in her decision;

- The length of time that the Complainant has traded under the COUNTRY PROPERTIES mark,
- the use of a domain name comprising "country properties" without stylisation to link to the Complainant's website,
- the reference in marketing literature to the unstylised word mark in order to refer to the Complainant and
- the fact that the Complainant is a clearly differentiated entity having won the estates agency award referred to above.

Accordingly the Expert finds that the Complainant has Rights in a name or mark which is identical or similar to the Domain Name for the purposes of the Policy.

Abusive Registration

Abusive Registration is defined in the following terms in paragraph 2 of the Policy:

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 has taken unfair advantage of or has been unfairly detrimental to the Complainant's Rights;

Paragraph 3 of the Policy contains guidance about applying the Abusive Registration test.

The following are of relevance to this Complaint:

a. A non-exhaustive list of factors which may be evidence that the Domain Name is an Abusive Registration is as follows:

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

A. for the purposes of selling, renting or otherwise transferring the Domain Name to the Complainant or to a competitor of the Complainant, for valuable consideration in excess of the Respondent's documented out-of-pocket costs directly associated with acquiring or using the Domain Name;

B. as a blocking registration against a name or mark in which the Complainant has Rights; or

C. for the purpose of unfairly disrupting the business of the Complainant;

ii. 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;

iii. The Complainant can demonstrate that the Respondent is engaged in a pattern of registrations where the Respondent is the registrant of domain names (under .uk or otherwise) which correspond to well known names or trade marks in which the Respondent has no apparent rights, and the Domain Name is part of that pattern.

The Complainant asserts:

- o that the Domain Name was registered with a view to profit,
- o that the Respondent has been using it in a way that is likely to confuse or mislead people or businesses,
- o that the Respondent has a previous DRS decision made against him and has registered a domain name with an apparent connection to the BBC and that together these give rise to a pattern of Abusive Registrations.

The Respondent denies all of the above and asserts that it was unaware of the Complainant's identity until this dispute arose. The Complainant suggests that this position is implausible.

Awareness

The Respondent's awareness of the Complainant is crucial because of a previous DRS decision. In the DRS appeal decision in *Verbatim Limited v Toth (DRS 04331)*, the Appeal Panel noted that some knowledge of the Complainant and/or its brand/Rights is a prerequisite for a successful Complaint. The Appeal Panel noted that the DRS is a "first-come, first-served system" and suggested that a registrant who was wholly unaware of the Complainant and its Rights could not be said to be taking unfair advantage of or causing unfair detriment to those Rights.

It must be remembered that the burden of establishing Abusive Registration is on the Complainant which must establish awareness on the part of the Respondent on the balance of probabilities.

The Domain Name was registered in 2004. There is no evidence before the Expert about the extent of the Complainant's business or Internet presence at that time. The Google search at Exhibit 1 to the Response is from February 2009 and gives no indication of the position 5

years ago. The Expert agrees with the Complainant that it is probable that a party such as the Respondent whose business is profiting from domain name registrations, would be likely to carry out an Internet search before registering a domain name. But the lack of evidence before the Expert does not allow for any finding that having carried out such a search the Respondent would have been on notice of the Complainant or its Rights. The Complainant has not discharged its burden of proof on this issue.

The Expert therefore finds that it has not been proven that the Respondent was aware of the Complainant at the time he registered the Domain Name.

Indeed, in the absence of evidence to the contrary, the Expert finds that there is nothing to displace the Respondent's assertion that it only became aware of the Complainant when this dispute arose (which seems to have been in February 2009). In the wake of the *Verbatim* decision the Respondent's activities cannot be classed as Abusive until the Respondent became aware of the Complainant. Nor could any continuation of use that began before the Respondent became aware of the Complainant be rendered abusive. Only a new type of use postdating February 2009 could amount to Abusive Registration.

Registration

It follows from the above that the Expert finds that the registration of the Domain Name in 2004 was in ignorance of the Complainant and was not abusive.

The Complaint on registration accordingly fails.

Use

There is very limited evidence before the Expert about what the Respondent's use of the Domain Name amounts to.

Parking

The *Respondent* (not the Complainant) refers to having parked the Domain Name. The Complainant makes no reference to this activity at all-not even in its Reply to the Response. The Expert therefore makes a primary finding that the Complainant does not base its Complaint on the parking of the Domain Name and that the parking is not relevant to the Complaint.

If this is incorrect then it must be remembered that only a new parking use that postdates February 2009 can be taken into account, as explained above. There is nothing to show when the parking activity first began, although the Response indicates that it was shortly after the initial registration in 2004. Accordingly the Complainant has not established that parking activity began after the Respondent was aware of the Complainant. The Complaint fails on this second ground.

In any event paragraph 4e of the Policy states as follows;

e. Sale of traffic (i.e. connecting domain names to parking pages and earning click-per-view revenue) is not of itself objectionable under the Policy. However, the Expert will take into account:

- i. the nature of the Domain Name;
- ii. the nature of the advertising links on any parking page associated with the Domain Name; and
- iii. that the use of the Domain Name is ultimately the Respondent's responsibility.

Given the lack of information about the nature of the parking, there is nothing that would displace the presumption that parking pages are not of themselves objectionable.

Offer to Sell the Domain Name

The Complainant appears to base its case on abuse on the Respondent's offer to sell the Domain Name. Its submission is brief. There is no real information about when and how the offer is made, save for a reference in the Complaint to the consideration being in excess of £5,000 and in the Reply to an offer to buy the Domain Name having been made by a competitor of the Complainant.

Paragraph 3aiA of the Policy only refers to registering or otherwise acquiring the Domain Name for the purpose of selling it. Given the lack of information about use the Expert cannot pinpoint whether the offer to sell postdates the Respondent's awareness of the Complainant or whether it has changed significantly since the Respondents became aware of the Complainant in February 2009. On this basis alone the Complainant fails to make out its case on the balance of probabilities.

Even if this were not the case, paragraph 4d of the Policy provides as follows;

d. Trading in domain names for profit, and holding a large portfolio of domain names, are of themselves lawful activities. The Expert will review each case on its merits.

There is nothing to suggest that in offering the Domain Name for sale, the Respondent is attempting to take unfair advantage of the Complainant's Rights or to cause unfair detriment to those Rights. The fact that a competitor of the Complainant has apparently expressed an interest in purchasing the Domain Name (but seemingly has not actually purchased it) does not on its own give rise to a finding of abusive conduct on the part of the Respondent.

Pattern of Abusive Registrations

Paragraph 3aiii of the Policy provides that evidence pointing to an Abusive Registration can arise where;

The Complainant can demonstrate that the Respondent is engaged in a pattern of registrations where the Respondent is the registrant of domain names (under .uk or otherwise) which correspond to well known names or trade marks in which the Respondent has no apparent rights, and the Domain Name is part of that pattern;

The Expert agrees with the Respondent that one previous adverse finding under the Policy is not indicative of a pattern, nor is an isolated registration with no apparent connection to the Respondent (bbweather.co.uk). The mere fact that a registrant has some objectionable domain names in his portfolio cannot of itself be enough to render the Domain Name an Abusive Registration. The Appeal Panel decision in *DRS case 4884 (maestro.co.uk)* suggests that a Complainant must provide evidence to justify linking the Domain Name to the other objectionable domains. This has not been provided in this case.

In all the circumstances the Expert finds that on the balance of probabilities the Domain Name in the hands of the Respondent is not an Abusive Registration.

In the Reply the Complainant suggests that the Respondent has failed to satisfy paragraph 4aii of the Policy. This is a misunderstanding of the Policy. The Respondent does not have to prove anything. Paragraph 4 simply sets out circumstances that may demonstrate that the Domain Name is not an Abusive Registration. In this case the Complainant has not on balance established any basis for an Abusive Registration and there is accordingly no case for the Respondent to answer.

7. Decision

Whilst the Complainant has established Rights in a name that is identical or similar to the Domain Name, it has not proved on the balance of probabilities that the Domain Name in the hands of the Respondent is an Abusive Registration.

Accordingly, the Expert directs that no action be taken in respect of the Complaint.

Signed Sallie Spilsbury

Dated 5 May 2009