

DISPUTE RESOLUTION SERVICE

D00013528

Decision of Independent Expert

Protocol Education Ltd

and

Ben Tagg

1. The Parties

Complainant: Protocol Education Ltd
247 Tottenham Court Road
London
W1T 7QW
United Kingdom

Respondent: Ben Tagg
Taylor Lane
Loscoe
DE75 7TA
United Kingdom

2. The Domain Name

<protoleducation.co.uk> (“the Domain Name”)

3. Procedural History

14 November 2013 13:23 Dispute received
14 November 2013 14:13 Complaint validated
14 November 2013 14:24 Notification of complaint sent to parties

03 December 2013 01:30 Response reminder sent
06 December 2013 09:15 No Response Received
06 December 2013 09:16 Notification of no response sent to parties
13 December 2013 11:17 Expert decision payment received

The Expert has confirmed that he is independent of each of the parties and that to the best of his 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 a such a nature as to call in to question his independence in the eyes of one or both of the parties.

4. Factual Background

The Complainant is a recruitment agency which provides teachers and support staff to schools and nurseries. It has traded under the name “Protocol Education” since 2005.

The Domain Name was registered by the Respondent on 12 October 2010.

At the date of Nominet’s formal compliance check, 14 November 2013, the Domain Name resolved to a website at www.derbyshireeducationsupply.com, which appeared to be operated by a company named “Derbyshire Education Supply” and to offer recruitment services in the education sector.

5. Parties’ Contentions

Complainant

The Complainant states that it has traded as “Protocol Education Limited” since 2005, having previously traded as “Protocol Teachers”. It produces a Certificate of Incorporation on Change of Name to that effect.

The Complainant submits that it has since 2005 established itself as one of the largest agencies within the education recruitment sector and that it has won numerous awards, accreditations and accolades including DfE Quality Mark (awarded 2003), the REC’s Audited Status (Awarded 2006), the Recruiter Award for Best Marketing Campaign (2005) and Best Temporary Agency (2010). However, the Complainant produces no documentary evidence in support of these submissions.

The Complainant submits that it has “the right to be solely associated with any URL containing the words Protocol Education.” It states that it has operated the URL www.protocol-education.com for numerous years and also owns numerous similar domain names. It produces a list of domain name registrations or renewals from which it appears that it has owned the domain name <protocol-education.com> since at least August 2006 and the name <protocol-education.co.uk> since at least September 2006.

The Complainant produces copies of its logo and two regional newspaper advertisements concerning its services, the dates of which are not clear. However, it produces no further evidence concerning the extent of its business under the name “Protocol Education” or in support of any contention that members of the public would associate that name with the Complainant or its commercial services.

The Complainant points to the use of the Domain Name for the “Derbyshire Education Supply” website referred to above and contends that this use of the Domain Name is abusive. It submits that, given the nature of the industry, the Respondent and/or the operators of the website must have been aware of the Complainant when they registered the Domain Name and directed it to the website. This can only have been done in order to benefit from the extensive marketing activity undertaken by the Complainant and to ride on the coat-tails of a larger and much more established competitor.

The Complainant seeks a transfer of the Domain Name.

Respondent

The Respondent did not respond to the Complaint.

6. Discussions and Findings

This matter falls to be determined under the Nominet Dispute Resolution Service Policy (“the Policy”) and the Nominet Dispute Resolution Service Procedure (“the Procedure”). Under paragraph 2 of the Policy:

“(a) *A Respondent must submit to proceedings under the Dispute Resolution Service if a Complainant asserts to [Nominet], 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.”*

Under paragraph 1 of the Policy the term “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.”

Also under paragraph 1 of the Policy, the term “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 took unfair advantage of or was unfairly detrimental to the Complainant's Rights.”*

Paragraph 3 of the Policy sets out a non-exhaustive list of factors that may be evidence that a domain name is an Abusive Registration. Paragraph 3.a.ii of the Policy refers to:

“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.”

Rights

There is no contention that the Complainant owns any registered trade mark rights in the name “Protocol Education”. Therefore, the Complainant must establish that it owns unregistered rights in that name, by virtue of public recognition of that name as an indicator of the Complainant’s business. In particular, because the term “Protocol” is generic and the term “Education” is descriptive of the business sector in which the Complainant operates, the Complainant must show that these terms in combination have acquired a “secondary meaning” that is distinctive of the Complainant and its business.

The Complainant has produced little evidence of any public recognition of its business under the name “Protocol Education”. The Expert is not assisted by the

fact that the Complainant adopted this name in 2005, that it owns domain names related to the name or that it has placed advertisements in regional newspapers. Of much greater assistance would have been evidence of matters such as the Complainant's turnover, the number of staff it has placed and the number and nature of the clients it has serviced. However, despite these deficiencies, the Expert accepts on the evidence that the Complainant has operated a business under the name "Protocol Education" for a substantial period of time and that the business has received recognition including the industry awards to which the Complainant refers. While the Complainant has not produced any documentary evidence in support of these awards, its assertions in this regard are not disputed by the Respondent and the Expert is prepared to accept them.

In the circumstances, the Expert finds on the balance of probabilities that the Complainant has established a sufficient level of public recognition of its business under the name "Protocol Education" to give rise to Rights for the purposes of paragraph 1 of the Policy.

The Domain Name comprises the term "protoleducation" with no adornment other than the formal suffix ".co.uk". Accordingly the Expert finds for the purposes of paragraph 2 of the Policy that the Complainant has Rights in respect of a name or mark which is identical or similar to the Domain Name.

Abusive Registration

While the term "Protocol" is generic and the term "Education" descriptive, the Expert considers that the combination of these two terms is distinctive in nature and that is certainly not commonplace. The Expert further accepts that the name "Protocol Education" would be understood by a substantial number of people in the education sector to refer to the Complainant and its business.

The Expert finds that the Respondent has used the Domain Name, <protoleducation.co.uk>, to resolve to a website operated on behalf of Derbyshire Education Supply. The website appears to offer services competitive with those provided by the Complainant.

While the Respondent has had an opportunity to explain its choice of the Domain Name for this purpose, it has failed to file any Response in these proceedings. Furthermore, there is no other evidence before the Expert of why the Respondent should wish to use the Domain Name for the purpose of the website of a business having no apparent connection with that name.

In the circumstances, the only inference that the Expert can reasonably draw is that the Respondent registered and has used the Domain Name in the knowledge of the Complainant's established trading name, "Protocol Education", and with the

intention of taking unfair advantage of the Complainant's goodwill in that name. In particular, the Expert infers that by using the Domain Name the Respondent is seeking to divert internet users who are looking for the Complainant's website to a competing website operated by the Respondent. While it may be apparent to an internet user who reaches the Respondent's website that it is not operated by the Complainant, that user will have been lured to the site in the first place by virtue of the "initial interest confusion" caused by the Domain Name. Accordingly, the Expert finds for the purposes of paragraph 3.a.ii of the Policy that the Respondent is using 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.

7. Decision

The Complainant has established that it has Rights in respect of a name or mark which is identical or similar to the Domain Name and that the Domain Name in the hands of the Respondent is an Abusive Registration. The Complaint therefore succeeds and the Expert directs that the Domain Name, <protoleducation.co.uk>, be transferred to the Complainant.

Signed Steven Maier

Dated 03 January 2014