

DISPUTE RESOLUTION SERVICE

DRS07539

Decision of Independent Expert

DE BRUS MARKETING SERVICES LIMITED

AND

DEGREES OF RISK

1 THE PARTIES

Complainant: De Brus Marketing Services Limited

Address: 31-33 Warwick Street
Leamington Spa
Warwickshire

Post Code: CV32 5JX

Country: United Kingdom

Complainant's Representative: Wynne-Jones, Laine & James LLP
Essex Place
22 Rodney Road
Cheltenham
Gloucestershire
GL50 1JJ
United Kingdom

Respondent: Degrees of Risk

Address: 197 Tottington Road
Bolton

Post Code: BL2 4DF

Country: United Kingdom

2 THE DOMAIN NAME

edusafe.co.uk (“the Domain Name”).

3 PROCEDURAL BACKGROUND

- 3.1 On 21 July 2009 the complaint was received and validated. On 3 August 2009 the response was received and on 10 August 2009 the reply was received. Following failure of mediation, on 18 September 2009 Nominet received the expert decision payment.
- 3.2 On 22 September 2009, Patricia Jones ("**the Expert**") confirmed to Nominet that she knew of no reason why she could not properly accept the invitation to act as expert in DRS07539 and further confirmed that she knew of no matters which ought to be drawn to the attention of the parties which might call into question her independence and/or impartiality.
- 3.3 The Expert was appointed on 22 September 2009.

4 THE FACTS

- 4.1 The Domain Name was registered on 2 March 2005.
- 4.2 The Complainant owns a registered trade mark for Edusafe in classes 16, 35, 40, 41 and 42 ("**the Trade Mark**") which was registered on 31 October 1997. The Complainant uses the mark Edusafe for advice and training on health and safety in the workplace, the protection of vulnerable adults and personal safety. The Complainant offers its Edusafe products and services at educare.co.uk as its house brand is Educare.
- 4.3 The Respondent is a risk consultant. The Respondent is the registrant of a number of 'X safe' domain names, where 'X' is a sector as follows:

	Domain Name	Date of Registration	Registrant	Status
1	edusafe.co.uk	2 March 2005	Degrees of Risk	Inactive. The Respondent states development work is 50 % completed.
2	edu-safe.co.uk	2 March 2005	Degrees of Risk	Inactive
3	caresafe.co.uk	22 June 2007	Degrees of Risk Limited	Inactive
4	carehomesafe.co.uk	10 March 2006	Degrees of Risk	Active online health and safety solutions for care homes
5	comeplecaresafe.co.uk			Included in the Respondent's evidence, but domain name is unknown.
6	nursinghomesafe.co.uk	7 April 2007	Degrees of Risk Limited	Active online health and safety solutions for nursing homes

	Domain Name	Date of Registration	Registrant	Status
7	restaurantsafe.co.uk	2 September 2005	Degrees of Risk	Holding page, displaying restaurant related links.
8	pubsafe.co.uk	2 September 2005	Degrees of Risk	Inactive
9	hoteliersafe.co.uk	2 June 2006	Degrees of Risk Limited	Inactive
10	clubsafe.co.uk	2 September 2005	Degrees of Risk	Inactive
11	guesthousesafe.co.uk	26 April 2006	Degrees of Risk	Inactive
12	officerisks.co.uk	29 September 2005	Degrees of Risk	Inactive
13	motortradersafe.co.uk	27 September 2005	Mr Gary Watts	Inactive
14	motortradesafe.co.uk	22 June 2007	Degrees of Risk Limited	Inactive
15	warehousesafe.co.uk	2 September 2005	Degrees of Risk	Inactive
16	gardencentresafe.co.uk	7 April 2007	Degrees of Risk Limited	Inactive
17	merchantsafe.co.uk	16 June 2009	Berybos Llc	Included in Respondent's evidence but does not appear to be owned by the Respondent. Route through to merchant-safe.com.
18	golfclubsafe.co.uk	7 April 2007	Degrees of Risk Limited	Inactive

- 4.4 On 18 March 2009, the Complainant's representatives, Wynne-Jones, Laine & James LLP wrote to the Respondent notifying it of the Trade Mark and inviting the Respondent to transfer the Domain Name to the Complainant.

- 4.5 On 8 April 2009, Mr Watts of the Respondent responded stating he took the view that he had a right to use the Domain Name in connection with his business as a safety consultant.
- 4.6 Mr Watts stated "*We have registered a series of domains for business purposes Xsafe.co.uk refer www.nursinghomesafe.co.uk, www.carehomesafe.co.uk. These are for delivery of health and safety and related risk management services to niche markets. This includes pubsafe, hoteliersafe, restaurantsafe, which are shortly to go live. Material for the domain in question [the Domain Name] a health and safety website portal for education sector has already been developed.*" Mr Watts also pointed out that the Complainant could have registered the Domain Name before the Respondent.

5 THE PARTIES CONTENTIONS

The Complaint

- 5.1 The Trade Mark details were available on the UKIPO¹ website register from 1997 and would have been retrieved by a basic search for Edusafe. It is incumbent on a person selecting a new name to take reasonable steps to establish that it is free for use and not to do so is an act of bad faith. A google search would also have revealed the Complainant's usage of the mark.
- 5.2 The Respondent's reply of 8 April 2009 demonstrates its intention to use the Domain Name for the purposes of providing information on health and safety for the education sector which would be in direct conflict with the Trade Mark.
- 5.3 If the Respondent was being consistent with the naming of its sub-categories, the applicable term for the education sector would be 'educationsafe', rather than 'edusafe', bearing in mind that all other prefixes are complete and descriptive words, such as 'pub', 'restaurant' and 'hotelier'.
- 5.4 The abbreviation of the word 'education' juxtaposed to the word 'safe' gives the Trade Mark a high degree of distinctive character. The identical reproduction of this distinctive mark in the Domain Name, offering identical services to those of the Complainant, would be considered trade mark infringement.
- 5.5 The Respondent intends to activate the Domain Name and at this time, consumers will be confused leading to damage of the Complainant's business and trade mark rights.
- 5.6 As the terms 'pubsafe', 'hoteliersafe', 'restaurantsafe' and 'edusafe' have not yet been used by the Respondent, it is unable to claim that a 'family of marks' is owned.
- 5.7 If the Domain Name becomes active and offers the services, as described by Mr Watts, then this use would infringe the rights of the Complainant. Under those circumstances, the actions of the Respondent in respect of the Domain Name are abusive in preventing the legitimate trade mark right owner from using the Domain Name and also in confirming its intention to infringe the Claimant's trade mark rights.

The Response

¹ United Kingdom Intellectual Property Office

- 5.8 'X safe' and other registered domains are being used, developed or registered as a family of 'www domains'. They are a trading style for delivery of risk management support to chosen markets. Some of these are 'white labelled' for trade associations.
- 5.9 The domains describe 'sector specific' solutions. They were registered in accordance with business plans. The websites deliver operational risk management guidance and advice including health and safety, fire safety, food hygiene and business continuity. They are all pre-fixed 'X' describing the occupation or profession followed by 'safe.co.uk'.
- 5.10 Much work has been completed on the Domain Name, an online risk management website for the education sector. As time and opportunity permits, this will go live, as in line with other 'Xsafe' family of domains.
- 5.11 Edusafe Limited, a company incorporated in 2007 and which has no relationship with the Complainant, has registered edusafe.ltd.uk. The Respondent queries whether Edusafe Limited can use this domain name.
- 5.12 The Complainant registered the Trade Mark in 1997 and could have registered the Domain Name before the Respondent.
- 5.13 At no time has there been any attempt to defame, copy or otherwise, the Complainant or Edusafe Limited.
- 5.14 There are other domains associated with 'edusafe' which are available for registration by the Complainant. The Complainant could also call their product Educare in line with their existing products.
- 5.15 carehomesafe.co.uk has over 600 pages of searchable reference material with self audits and form tools to aid compliance. The development lead time was approximately 2 years.
- 5.16 The Domain Name was purchased to support the health and safety needs of the education sector. Discussions were held in 2003/2004 with Nord Anglia plc to develop a health and safety support website for Nord Anglia's 'group' schools, which was to be an internet solution. It was also proposed to support the compliance needs of other independent and local authority run schools via an internet website at the Domain Name. At that time Edusafe Limited was available as a company name. A joint venture proposal was put forward but the project did not progress, due to the core school disposal programme by Nord Anglia. However, development work had been completed and the medium term business plans of the Respondent include a risk management website to support the needs of the education sector using the Domain Name.
- 5.17 The Respondent's development of care and the hospitality sector websites currently dominate. In early 2010 it is planned to launch hoteliersafe.co.uk, pubsafe.co.uk, restaurantsafe.co.uk, guesthousesafe.co.uk and clubsafe.co.uk, in conjunction with Food North West.

The Reply

- 5.18 The Complainant denies the Respondent has a right to use the Domain Name in connection with risk consultant services, as this would conflict with the Trade Mark.
- 5.19 The Respondent has failed to demonstrate that it owns a protectable trading style in 'safe' composite marks. None of these 'safe' composite names are registered as trade

marks nor are they subject to pending trademark applications, they are merely a group of domain names which in themselves cannot be protected on an unregistered basis without substantial use and exposure of all the marks to the relevant public. This has not been demonstrated. The Complainant submits that even if a 'family' of marks were owned, that a registered trade mark preceding the 'family' of marks would supersede the 'family' of marks right to use if one of the 'family' of marks infringed the registered mark.

- 5.20 The Complainant is not concerned by the use of the other 'safe' composite domains as these are not likely to infringe the Trade Mark, which the Domain Name would. The Complainant queries why the domains educationsafe.co.uk or educationalsafe.co.uk were not adopted as opposed to the distinctive edusafe.co.uk.
- 5.21 In the Response, the Respondent has confirmed its intention to use the Domain Name to offer the services of risk consultancy under the name 'edusafe', which would be contrary to the Complainant's rights. Having been warned that this would constitute an infringement, the very act of continuing with the commercial plans, keeping the Domain Name and admitting that the Domain Name will go live for conflicting services all constitute an act of bad faith in the ownership and use of the Domain Name.
- 5.22 The Complainant does not deny that Edusafe Limited was available for purchase from Companies House during 2003 and 2004. However, at this time a basic trademark search at the UKIPO database as well as the Company House database would have located the Complainant's rights. Not performing the most cursory of checks before adopting a new trademark and registering a new domain name is an act of bad faith. Additionally, continuing with the development of a website, owning the Domain Name, confirming the intended use of the Domain Name all add up to the Respondent acting in bad faith with regard to the Domain Name.
- 5.23 The mere appearance of other company names or domain names is immaterial to the current proceedings.
- 5.24 The appearance of other available edusafe domain names is immaterial to the current proceedings. It is not for the Complainant to register all the domain names that it feels might infringe its rights if used for similar services. It is submitted that use of any of these domain names for risk consultant services would infringe the rights of the Complainant.

6 DISCUSSIONS AND FINDINGS

- 6.1 I should say at the outset, that whilst the Complainant refers to trade mark infringement and to the concept of 'bad faith' in its complaint, these are both not matters for the DRS policy.
- 6.2 Instead Paragraph 2 of the Nominet Dispute Resolution Policy ("**the Policy**") sets out that for the Complainant's complaint to succeed, it must prove to the Expert 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.
- 6.3 The Complainant is required to prove to the Expert that both elements are present on the balance of probabilities.

Complainant's Rights

- 6.4 Paragraph 1 of the Policy states that "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"*.
- 6.5 It is well accepted that the question of Rights falls to be considered at the time that the Complainant makes its complaint.
- 6.6 The Complainant has owned the Trade Mark since 1997. From the evidence presented to me I am satisfied that the Complainant has been using Edusafe for advice and training on health and safety in the workplace and protecting vulnerable adults (from at least 2007) and on personal safety (from at least 2008). I do not consider that the mark Edusafe is descriptive of the services being offered by the Complainant under that mark.
- 6.7 I am therefore satisfied on the basis of the Trade Mark and the use made by the Complainant of the Edusafe mark, that the Complainant has Rights in respect of a name or mark which is identical or similar to the Domain Name.

Abusive Registration

- 6.8 The question is therefore whether the Domain Name, in the hands of the Respondent, is an Abusive Registration? 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 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.
- 6.9 I will consider each limb of the definition of Abusive Registration, Paragraphs 1(i) and 1(ii), in turn. It is sufficient to satisfy either of these limbs for there to be a finding of an Abusive Registration.

Abusive Registration under Paragraph 1(i) of the Policy

- 6.10 For there to be an Abusive Registration under paragraph 1(i) of the Policy, it must be established that the Respondent had knowledge of the Complainant and/or its rights at the time of registration of the Domain Name.
- 6.11 The Complainant owned the Trade Mark at the time of registration of the Domain Name and the Complainant states that it has been using Edusafe since at least filing of the Trade Mark in 1997.
- 6.12 The Complainant has provided the following evidence:
- (a) Educare brochure dated November 2008 which describes the Edusafe Personal Safety, Edusafe Safety in Business and Edusafe Protecting Vulnerable Adults as "New Programmes".

- (b) Brochures and documentation for these Edusafe programmes from 2007 and 2008.
 - (c) Statistics of use that Edusafe Personal Safety was first registered in August 2008, Edusafe Protecting Vulnerable Adults was first registered in November 2007 and Edusafe Safety in Business was first registered in November 2007.
 - (d) A variety of invoices from 2002 headed Edusafe, but with no indication of what these relate to.
- 6.13 The Complainant's evidence does not establish that it was using Edusafe in connection with advice and training on health and safety in the workplace, personal safety and protecting vulnerable adults at the time of registration of the Domain Name. I consider there is no evidence to support the Complainant's assertion that a google search at the time of registration of the Domain Name would have revealed the Complainant's usage of the Edusafe mark. Nor do I accept the Complainant's contention that a company search at the time of registration of the Domain Name would have alerted the Respondent to the Complainant's rights to Edusafe. The Complainant's corporate name is unconnected to Edusafe.
- 6.14 The Complainant alleges that a trade mark search at the UKIPO at the time of registration of the Domain Name would have located the Trade Mark. There is no evidence that the Respondent made such a search and I reject the Complainant's contention that a failure by the Respondent to perform a trade mark search before the registration of the Domain Name means that the registration is abusive.
- 6.15 In the circumstances, I do not consider that the Complainant has established on the balance of probabilities that the Respondent had knowledge of the Complainant's rights to Edusafe at the time of registration of the Domain Name. I am also satisfied with the Respondent's explanation that its registration of the Domain Name was related to its discussions with Nord Anglia plc on a school health and safety support site. I therefore do not consider that the Complainant has established that there is an Abusive Registration under Paragraph 1(i) of the Policy.

Abusive Registration under Paragraph 1(ii) of the Policy

- 6.16 I consider the issue to focus on is whether the Domain Name in the hands of the Respondent is an Abusive Registration under Paragraph 1(ii) of the Policy.
- 6.17 There is a non-exhaustive list of factors under the Policy which may be evidence that the Domain Name is an Abusive Registration which include:
- (a) Paragraph 3(a)(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.
- 6.18 Paragraph 3(b) states that failure on the Respondent's part to use the Domain Name for the purposes of email or a website is not in itself evidence that the Domain Name is an Abusive Registration.
- 6.19 There is also a non-exhaustive list of factors under the Policy which may be evidence that the Domain Name is not an Abusive Registration including:

- (a) Paragraph 4(a)(i): Before being aware of the Complainant's cause for complaint (not necessarily the complaint under the DRS), the Respondent has:
 - (A) used or made demonstrable preparations to use the Domain Name or a domain name which is similar to the Domain Name in connection with a genuine offering of goods or services.
 - (B) been commonly known by the name or legitimately connected with a mark which is identical or similar to the Domain Name.
 - (b) Paragraph 4(a)(ii): the Domain Name is generic or descriptive and the Respondent is making fair use of it.
- 6.20 Paragraph 4(d) states that holding a large portfolio of domain names is a lawful activity. The Expert will review each case on its merits.
- 6.21 The Respondent is not currently using the Domain Name. However, in its response to the Complainant of 8 April 2009, and in the Response, the Respondent makes it clear that it intends to use the Domain Name in connection with an online risk management and health and safety website for the education sector. The Respondent states that the development of the care and hospitality sector websites currently dominate, but *"as time and opportunity permits this [the Domain Name] will go live as in line with other "X-safe" family of domains"*. The Respondent states that *"Development work has been completed and medium term business plans of Degrees of Risk Ltd., include risk management website to support needs of education sector:edusafe.co.uk"*.
- 6.22 I consider that the evidence establishes that the Respondent intends to use the Domain Name at some point to provide risk management and health and safety services for the education sector with knowledge of the Complainant's Rights. Paragraph 3(a)(ii) of the Policy makes it clear that I can consider whether such threatened use will take unfair advantage or is unfairly detrimental to the Complainant's Rights. Under this Paragraph a factor which may be evidence that the Domain Name is an Abusive Registration is that the threatened use 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. If I am to rely on this, I must conclude there is such a likelihood of confusion on the balance of probabilities.
- 6.23 Whilst the Complainant asserts that there will be confusion if the Respondent uses the Domain Name as threatened, its complaint focuses on its trade mark rights to prevent such use (and as I have said the DRS Policy is not concerned with trade mark infringement), rather than to explain how such confusion will arise. Nevertheless I consider one can take a common sense approach when assessing likelihood of confusion relating to threatened use.
- 6.24 The Complainant offers advice and training on health and safety in the workplace, personal safety and the protection of vulnerable adults. These can be broadly described as risk management and health and safety services and are similar to the type of services the Respondent intends to offer using the Domain Name, namely risk management services for the education sector. I will consider the position assuming that the Respondent is using the Domain Name for these services, as it intends.
- 6.25 The Domain Name is identical to the Trade Mark and to the trading name of the Complainant's business (excepting the .co.uk suffix). It is therefore likely that the

Respondent's site will feature high up on the results list of a search engine request for 'edusafe' made by internet users looking for the Complainant. When the search engine results are returned I consider it likely that internet users will expect the Complainant's site to be found at the Domain Name, because the Domain Name is identical to the 'edusafe' business they are looking for. They are therefore likely to visit the Respondent's website with the expectation that it is the Complainant's website.

- 6.26 Internet users are also known to make 'educated' guesses on domain names when looking for a web-presence. In this case, I consider that the Domain Name is likely to be associated by internet users with the Complainant, because the Domain Name is identical to 'edusafe'. I would therefore expect the Respondent's site to receive traffic from internet users visiting the site through educated guesswork in the reasonable hope of finding the Complainant.
- 6.27 My conclusions are founded on the association and connection that I consider internet users are likely to make between the Domain Name and the Complainant and their likely expectations when they visit the Respondent's site at the Domain Name. In this respect, I have also considered whether the Domain Name is descriptive and accordingly whether internet users would be likely to visit the Domain Name because they are looking for the type of goods or services described by 'edusafe', rather than for the Complainant.
- 6.28 However, I do not consider that 'edusafe' is descriptive of the services to be offered by the Respondent from the Domain Name. In my view, the majority of the Respondent's other 'X safe' domains, such as 'carehomesafe', 'nursinghomesafe', 'pubsafe', 'restaurantsafe' etc. have a descriptive element. They arguably describe services for a 'safe' 'carehome', 'nursing home', 'pub', 'restaurant' etc. By analogy, the Domain Name relates to services for a 'safe' 'edu' which, in my opinion, is not descriptive, as 'edu' is not a recognisable sector in the way 'carehome', 'nursinghome', 'pub' and 'restaurant' are. In my opinion the Domain Name does not have a descriptive element because of the abbreviation of 'education' to 'edu'. I therefore consider it likely that internet users will visit the Respondent's website in the hope or expectation of finding the Complainant, rather than to find a type of service described by the Domain Name.
- 6.29 Once at the Respondent's website, internet users will find services very similar to those of the Complainant. Some visitors may continue to believe that because of the similarity of the services, the Respondent's business is operated or authorised by or connected with the Complainant. Even if the Respondent's website made it entirely clear that it has no connection whatsoever with the Complainant, internet users would have been initially confused into believing the website is operated or authorised by or otherwise connected with the Complainant, when they visited it as a result of their search or educated guess. I therefore consider that the Respondent's threatened use of the Domain Name would be likely to attract traffic from internet users to the Respondent's website who visit it in the expectation that they would be visiting the Complainant's site, which in my opinion takes unfair advantage of or is unfairly detrimental to the Complainant's Rights.
- 6.30 For the reasons set out above, I therefore consider that the Respondent's threatened use of the Domain Name is likely to cause people or businesses to believe that the Domain Name is registered to, operated or authorised by or otherwise connected with the Complainant and I find that the Domain Name will be used in a manner which will take unfair advantage of or be unfairly detrimental to the Complainant's Rights.

- 6.31 In reaching this conclusion I have also considered the relevant non-exhaustive factors set out in the Policy which may be evidence that the Domain Name is not an Abusive Registration.
- 6.32 I would note that whilst the Respondent did make some preparations to use the Domain Name for education safety services around the time of registration of the Domain Name, it does not appear, on its evidence, to have done anything in relation to the use of the Domain Name for some time. The Respondent is not currently using the Domain Name and its intention is in the "*medium term*" to use the Domain Name. The Respondent makes it clear that it is currently concentrating on its care and hospitality sectors, rather than on education advice services from the Domain Name.
- 6.33 I therefore do not consider the Respondent has used or made demonstrable preparations to use the Domain Name in connection with a genuine offering of goods or services as required by Paragraph 4(a)(i)(A) of the Policy. Any preparations were done a considerable time ago and on the Respondent's evidence are incomplete (the development work at the Domain Name is only 50% completed). Nor is the Respondent commonly known by the name or legitimately connected with a mark that is identical or similar to the Domain Name as required by Paragraph 4(a)(i)(B). Again any legitimate connection was some considerable time ago. I also do not consider Paragraph 4(a)(ii) of the Policy is satisfied as the Domain Name is, in my opinion, not generic or descriptive and the Respondent is not making any use of it.
- 6.34 For completeness I should clarify that I have referred in this Decision only to those matters raised by the parties which I consider are relevant to the application of the Policy. I do not consider it relevant to the application of the Policy whether there are other edusafe domain names which the Complainant can register or whether Edusafe Limited is entitled to use the domain name edusafe.ltd.uk.

7 DECISION

- 7.1 I find that the Complainant has Rights in a name or mark which is identical or similar to the Domain Name.
- 7.2 I find that the Domain Name in the hands of the Respondent is an Abusive Registration.
- 7.3 I direct that the Domain Name be transferred to the Complainant.

Dr Patricia Jones
13 October 2009