

DISPUTE RESOLUTION SERVICE

D00008520

Decision of Independent Expert

Cartridge Green Limited

and

Mr Francis O'Dwyer

1. The Parties

Lead Complainant: Cartridge Green Limited
111a Foster Avenue
Mount Merrion
Dublin
Ireland

Respondent: Mr Francis O'Dwyer
Rossmore
Cashel
Co. Tipperary
Ireland

2. The Domain Name

cartridgegreen.co.uk

3. Procedural History

Nominet checked that the complaint dated 22 April 2010 complied with its UK Dispute Resolution Service Policy ('the Policy') and the Procedure for the conduct of proceedings under the Dispute Resolution Service ('the Procedure'). It then notified the Respondent of the complaint, inviting him to file a response. The response is dated 14 May. The Complainant replied to the response on 24 May. Informal mediation was attempted but was not successful. On 25 August Nominet told both parties that, if it received the appropriate fee, the case would be referred for an expert decision.

On 2 September 2010 I, Mark de Brunner, agreed to serve as an expert under the Policy and Procedure. I subsequently confirmed that I am independent of each of the parties and that there are no facts or circumstances that might call into question my independence.

Evidence to be admitted

The Complainant's reply (to the Respondent's response to the complaint) includes material headed 'updated developments', based on the Respondent's reply to one of the Complainant's letters – and which arrived after the complaint was filed.

The Complainant would like that correspondence admitted as evidence, on the grounds that it was not available at the time of the complaint and that it justifies an assertion made in the complaint about the Respondent's motive in registering the domain name. But the Complainant's reply stage of the Procedure is not intended as a vehicle for introducing new material. Paragraph 6(b) of the Procedure says:

Any reply by the Complainant must be restricted solely to matters which are newly raised in the Respondent's response and were not raised in the Complainant's complaint as originally submitted to us. If an Expert is appointed and the reply extends to other matters, the Expert may declare it inadmissible to the extent that it deals with matters going beyond those newly raised in the Respondent's response.

The 'updated developments' here concern the Respondent's reaction to the offer made by the Complainant to reimburse his costs on the transfer of the domain name to the Complainant. The matter was not 'newly raised' by the Respondent. It was originally raised in the complaint. I do not see a case here for my taking note of this new material. As a result, I have ignored the 'updated developments' in the Complainant's reply.

4. Factual Background

From the complaint, the response and the reply - and having visited the Complainant's and the Respondent's websites - I accept the following as facts.

The Complainant was incorporated in Ireland on 10 July 2007. It sells, refills and 'remanufactures' printer cartridges – mostly through a network of franchisees - and now has 11 outlets in Ireland. It has been trading as Cartridge Green since September 2007. It holds Irish and Community Trade Marks, registered in August 2007 and February 2009 respectively, covering the words Cartridge Green and a logo.

The Complainant has registered the domain names cartridgegreen.ie, cartridgegreen.com, cartridgegreen.net and cartridgegreen.eu. The last three of these domain names point to content at web pages connected to the first of them. The Complainant originally registered the domain name at issue too, on 12 September 2007, but when the registration expired it missed the opportunity to renew automatically: it had not received the renewal invitation because it had not kept its email contact details up to date with Nominet.

The Respondent, an individual, is in the same line of business as the Complainant. Having started as Rite Price Ink, he now trades as Printer Planet. The Respondent registered the domain name at issue on 21 January 2010, soon after the Complainant inadvertently allowed its own registration to lapse.

At the time of writing, the domain name resolved to a landing page that said:

We've changed our name!

Ritepriceink.ie (Clonmel, Co.Tipperary) is now trading as www.printerplanet.ie

Please click on the link below to visit our new Printer Planet website.

www.printerplanet.ie

Printer Planet is not in any way affiliated with Cartridge Green

Following the link to www.printerplanet.ie leads to a homepage for a business selling cartridges, toner, paper and related supplies. The website shows the physical address as Ard Gaoithe Business Park, Clonmel, Co.Tipperary.

There has been a franchised Cartridge Green store operating from Clonmel since September 2007.

In the course of correspondence between the parties, the Respondent says he has no intention of trading under the Cartridge Green name and invites the Complainant to make him an offer for the domain name.

5. Parties' Contentions

Complaint

The Complainant says that it has rights in the name Cartridge Green and that the domain name is an abusive registration because:

- (i) it was registered for the purposes of selling at more than the cost of registration.
- (ii) it was registered in order to prevent the Complainant from re-registering the domain name.
- (iii) the Respondent's use of the domain name is causing unfair disruption to the Complainant's business.
- (iv) use of the domain name is likely to be confusing internet users into thinking that the Complainant and the Respondent are connected.
- (v) the Respondent can have no legitimate interest in a domain name ending .co.uk because he operates exclusively in Ireland.

Response

The Respondent says the domain name is not an abusive registration because:

- (i) at the point of registration, the Respondent had no intention of seeking to profit from the sale of the domain name.
- (ii) the Respondent acquired the domain name in accordance with Nominet's procedures and could not know, at the point of registration, that the Complainant still had an interest in the domain name. Indeed, the Complainant's having let its original registration lapse is evidence that it no longer had such an interest.
- (iii) there is no unfair disruption because the Respondent and the Complainant have completely different business models. In particular, the Complainant uses the internet to attract custom but, unlike the Respondent, does not actually transact any business online – so the two are not online competitors.
- (iv) there is no risk of confusion because the re-direction page is clear and the link leads to the Respondent's website which is branded completely differently from the Complainant's.
- (v) the Complainant has no presence in the UK and its rights are exercised only in Ireland.

The Respondent then makes two other points:

- (vi) the choice of domain name reflects his web developer's advice that the words 'cartridge' and 'green' would maximize internet search hits.
- (vii) in threatening High Court proceedings but not following through with that, the Complainant is attempting to bully the Respondent into releasing the domain name.

Reply

(The numbering here corresponds to the numbering in the *Response* section above.)

In reply, the Complainant:

- (ii) accepts making a mistake in allowing the original registration to lapse, but rejects the suggestion that the error demonstrates how little the domain name meant to it.
- (iii) agrees it does not transact business online but questions the relevance of the point, given that there are other legitimate commercial reasons for a web presence.
- (iv) agrees with the Respondent that searches on 'cartridge' and 'green' will take internet users to what is very clearly the Respondent's website but argues that – as they will be looking for the Complainant's website rather than the Respondent's – that fact adds weight to the Complainant's case.
- (v) accepts it has no physical UK presence currently but says it is taking steps to establish such a presence.
- (vi) doubts the explanation that the domain name was selected to maximize hits from the search terms 'cartridge' and 'green' – on the basis that these terms would have to be a prominent part of the content of the site and its metatags, and that they are not.
- (vii) explains that it is reserving its position on what action to take beyond proceedings under Nominet's Dispute Resolution Service but that mentioning the possibility of future legal action is entirely routine and not evidence of bullying tactics.

6. Discussion and Findings

To succeed in this complaint, the Complainant must prove, on the balance of probabilities, 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.

Rights

The Complainant has been trading as Cartridge Green since 2007 and has registered the name as a trademark in Ireland and in Europe more widely. It evidently has both registered and unregistered rights in Cartridge Green.

Section 2.3 of the *Experts' Overview* explains that:

a name or mark will ordinarily be regarded as identical to the domain name if, at the third level, and ignoring the ... absence of spaces...they are the same.

Ignoring the .co.uk suffix, and the absence of a space, then, the domain name is also cartridge green.

There is a territorial question raised by both parties. It is not framed as a question about the Complainant's rights so much as a suggestion by both the Respondent and the Complainant that the other party cannot have a legitimate interest in a domain name ending .co.uk because neither trades in the UK. But, for completeness, it is worth pointing out here that a right is not rendered irrelevant for the purposes of the Policy merely because it is a non-UK right, as the *Overview* (section 1.5) makes clear:

Can an overseas right constitute a relevant right within the definition of Rights? Yes. The rights must be enforceable rights, but there is no geographical/jurisdictional restriction. If the Upper Volta Gas Board can demonstrate rights in respect of its name enforceable in Upper Volta, the Policy is broad enough to deal with a cybersquatter, for example, registering <uppervoltgasboard.co.uk>. If it was otherwise, the '.uk' domain would be likely to become a haven for cybersquatters.

I accept that the Complainant has rights in respect of a name that is identical to the domain name.

Abusive registration?

As defined by the Policy, an abusive registration is a domain name which:

- 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
- has been used in a manner which has taken unfair advantage of or has been unfairly detrimental to the Complainant's rights.

The Policy contains a non-exhaustive list of factors that may be evidence that a domain name is an abusive registration. The Complainant's main arguments reflect those factors: that the Respondent registered the domain name in order to sell it at a profit; that the registration is intended to block the Complainant's use of a name in which it has rights; that the Respondent is attempting unfairly to disrupt the Complainant's business; and that the Respondent's use of the domain name is likely to confuse internet users into believing that it is connected with the Complainant.

The Respondent says he had no intention of seeking to profit from the sale of the domain name. That is not wholly free from doubt but, even if such an intention were clear, it would not be conclusive. Setting out to make a profit from the sale of a domain name is not of itself illegitimate. If it were otherwise, there could be no legitimate secondary market in domain names. Paragraph 4(d) of the Policy says

Trading in domain names for profit, and holding a large portfolio of domain names, are of themselves lawful activities.

What counts, of course, is whether the prospect of profit arises unfairly at the expense of another's rights – which is just another way of asking whether the Respondent's actions take unfair advantage of the Complainant's rights. On its own, this factor here does not point clearly in either direction.

The Respondent argues it is reasonable to infer that the Complainant had lost interest in the domain name because it allowed the registration to lapse. That strikes me as disingenuous. The Complainant was still trading as Cartridge Green, so it seems unlikely that the Respondent could genuinely conclude that the Complainant was positively renouncing interest in the domain name that it had once registered. It seems to me more probable that the Respondent noticed what he saw as an opportunity and reacted quickly to what the Complainant has since admitted was a mistake – either to block renewal or to make commercial use of the domain name himself. Domain names are offered 'first come, first served', so the fact that the Respondent followed Nominet's procedures here neither confers legitimacy on the registration nor helps determine its character.

The Respondent suggests that his use of the domain name cannot unfairly disrupt the Complainant's business because they have different commercial models – in particular, because the Complainant advertises on the internet but does not directly sell online. I have to say I do not regard that as a material distinction here: both parties ultimately rely on attracting customers for printing supplies and the potential for disruption to the Complainant's business is obvious. The key question is whether that disruption is fair. The Respondent perhaps has in mind one element in the Policy's non-exhaustive list of factors that may be evidence that a domain name is not an abusive registration – where,

before being aware of the Complainant's cause for complaint, the

Respondent has used the domain name in connection with a genuine offering of goods or services.

The Respondent's offering of goods is clearly genuine. But the underlying question remains whether making that offering through the domain name here takes unfair advantage of the Complainant's rights.

The Respondent says there is no risk of confusion because the redirection page makes clear that internet traffic is being diverted to his own website, which looks very different from the Complainant's. But by then it is too late. Section 3.3 of the *Overview* says:

Commonly, Internet users will visit web sites either by way of search engines or by guessing the relevant URL. If the domain name in dispute is identical to the name of the Complainant and that name cannot sensibly refer to anyone else, there is bound to be a severe risk that a search engine, which is being asked for the Complainant, will produce high up on its list the URL for the web site connected to the domain name in issue. Similarly, there is bound to be a severe risk that an Internet user guessing the URL for the Complainant's web site will use the domain name for that purpose.

In such cases, the speculative visitor to the registrant's web site will be visiting it in the hope and expectation that the web site is a web site 'operated or authorised by, or otherwise connected with the Complainant'. This is what is known as 'initial interest confusion' and the overwhelming majority of Experts view it as a possible basis for a finding of Abusive Registration, the vice being that even if it is immediately apparent to the visitor to the web site that the site is not in any way connected with the Complainant, the visitor has been deceived. Having drawn the visitor to the site, the visitor may well be faced with...a commercial web site, which may or may not advertise goods or services similar to those produced by the Complainant. Either way, the visitor will have been sucked in/deceived by the domain name.

Both the Complainant and the Respondent regard it as relevant that the other party currently has no physical presence in the UK. I do not agree. Nor do I regard possible plans for expansion into the UK as material. Both parties have a physical presence in Ireland and are competing for attention online. This dispute centres on one aspect of that competition.

I can now turn to the Respondent's final two arguments.

There is no detailed evidence here on search engine optimization. I do not rule out that the mere registration of the domain name would increase hits from traffic in search of 'cartridge' or 'green', but the question remains whether any increase would be unfairly at the expense of the Complainant's rights.

The allegation of bullying raises the suggestion that the Complainant has been acting in bad faith (and the possibility, under Paragraph 16(d) of the

Procedure, of making such a finding in this decision). Parties in dispute commonly threaten legal action – proceedings which may or may not issue. Doing so – if only to reserve a position – seems to me both routine and legitimate. I draw no adverse inference here from the Complainant's conduct in referring to the possibility and do not find that the complaint was brought in bad faith.

In summary, the parties run competing printer supplies businesses, vying for online attention, both with a presence in Clonmel, County Tipperary. The Complainant has registered the domain name cartridgegreen under the top level domains .ie, .com, .net and .eu but let the .co.uk variant drop. The Respondent has picked up the dropped variant and uses it to direct traffic to his own website.

It seems to me very clear that the Respondent is using a name in which the Complainant has rights to win business that might otherwise have gone to the Complainant. In my judgement, the advantage taken of the Complainant's rights – both at registration and in use of the domain name - can only be unfair.

7. Decision

I find that the Complainant has rights in respect of a name which is identical to the domain name and that the domain name, in the hands of the Respondent, is an abusive registration.

In the light of that, I direct that the domain name be transferred to the Complainant.

Mark de Brunner

23 September 2010