

DISPUTE RESOLUTION SERVICE

D00010344

Decision of Independent Expert

The Wolseley Register

and

Mr David Ashburner

1. The Parties:

Complainant:

The Wolseley Register
Secretary of The Wolseley Register
Chantry House
Castle View Road
Easthorpe
Notts
NG13 0DX
United Kingdom

Respondent:

Mr David Ashburner
1 Ash Coppice
Preston
Lancashire
PR2 1RY
United Kingdom

2. The Domain Names:

wolseleyregister.co.uk
wolseleyworld.co.uk

3. Procedural History:

| | | |
|------------------|-------|---|
| 06 October 2011 | 17:19 | Dispute received |
| 07 October 2011 | 11:49 | Complaint validated |
| 07 October 2011 | 11:57 | Notification of complaint sent to parties |
| 26 October 2011 | 02:30 | Response reminder sent |
| 31 October 2011 | 06:19 | Response received |
| 31 October 2011 | 06:20 | Notification of response sent to parties |
| 03 November 2011 | 01:30 | Reply reminder sent |
| 07 November 2011 | 11:27 | Reply received |
| 07 November 2011 | 12:17 | Notification of reply sent to parties |
| 07 November 2011 | 12:23 | Mediator appointed |
| 10 November 2011 | 15:06 | Mediation started |
| 19 December 2011 | 16:16 | Mediation failed |
| 19 December 2011 | 16:16 | Close of mediation documents sent |
| 21 December 2011 | 12:08 | Expert decision payment received |

Dr Russell Richardson was appointed as Independent Expert as of 30 December 2011 and confirmed to Nominet that he was independent of the parties and knew of no facts or circumstances that might call into question his independence in the eyes of the parties.

In accordance with paragraph 13(b) of the Procedure, the Expert was forwarded an e-mail Nominet had received from the Respondent, dated 10 December 2011, which asked for further comments by it to be considered as part of the Complaint. The Expert decided to consider that non-standard submission as part of the process, and the Complainant was given the opportunity to reply to it.

4. Factual Background

- 4.1 The Complainant is a UK based classic car club organisation that was formed in September 1964. It has printed a club magazine called the *Wolseley World* for a period of time in excess of 30 years. It is run as an unincorporated association.
- 4.2 The Domain Names were registered by the Respondent on 3 January 2009.
- 4.3 The Respondent owns and controls the limited company *Wolseley Motors Limited* (incorporated 10 March 2011).
- 4.4 The Respondent is a Director and Shareholder of: *Wolseley Forum Limited* (incorporated 29 September 2011), *Wolseley Register Limited* (incorporated 1 July 2011) and the *Wolseley Owners Club Limited* (incorporated 10 March 2011).

5. Parties' Contentions

The Complaint:

- 5.1 In summary, the Complainant argued that the Domain Names should be transferred to it for the reasons set out below.

The Complainant has Rights in the Domain Names

- The Complainant has over 600 members throughout the UK and overseas, and it has a bank account in its name (but as an unincorporated association is not a registered company or charity and is not VAT registered). It already has used and uses domain names similar to the Domain Names (wolseleyworld.com, wolseleyregister.org.uk (not currently in active use)) to promote itself and has done so since 2007.

The Domain Names, in the hands of the Respondent, are Abusive Registrations

- The Domain Names were registered on the Complainant's behalf by the Respondent at the time he was the Complainant's Publicity Officer. The Respondent subsequently left that post in acrimonious circumstances and set up the *Wolseley Owners Club* which operates in competition with the Complainant.
- The websites linked to the Domain Names (the 'Websites') use the identity of the Complainant but have been set up to point to the website of the *Wolseley Owners Club*, albeit showing a warning that the organisation has no connection with the Complainant.
- Further, while the Respondent was still in the Complainant's Committee, it was minuted at a committee meeting on 8 May 2010 that he had agreed to change the registrant from his own name to that of the Complainant. It is evident to the Complainant that this was not done.

Respondent's response:

- 5.2 In summary, the Respondent argued that the Domain Names should not be transferred to the Complainant for the reasons set out below.

The Complainant does not hold Rights in the Domain Names.

- The Complainant is an unincorporated organisation. As such it has no legal right or 'official' claim to the Names other than by common usage.
- The Names are generic and are made up of two words run together. The first of these is a well known, but now defunct, motor manufacturer, *Wolseley*. The second word in both cases is a commonly used generic word that is often used to describe a function or geographical coverage of an organisation. The Complainant cannot claim exclusivity to being the sole arbiter of a register of classic vehicles in general or *Wolseleys* in particular.
- For example, there are many motoring enthusiast clubs that use both of these words as it describes the nature of the organisation, and describes a common role of a club. Other clubs or organisations that claim to do the same include: *The Landcrab Owners Club International*, *The Elf and Hornet Register*, *The Wolseley Car Club Inc*, and the *The Wolseley Hornet Special Club*.
- According to information from the Driver and Vehicle Licensing Agency (DVLA), in January 2009 there were some 5718 *Wolseley* vehicles known to still exist in England, Scotland and Wales (which does not take into account vehicles

overseas). There may be other vehicles including those vehicles currently waiting restoration. There could be as many as 12,000 Wolseleys still in existence throughout the world. The Complainant states that it has 600 members in its organisation; given the above, this would represent around 5 % of the 12,000 vehicles in existence. Therefore, the Complainant cannot claim that the Name *Wolseley Register* is in common usage.

- The Respondent claimed Rights in respect of the Names on the grounds of his common usage of the Names and by virtue of him owning a company with a name that is identical to the Domain Names. In addition, the Respondent claimed a legitimate connection with an unregistered mark which is similar to the domain name *wolseleyworld.co.uk* in that he used the tag line 'The Wonderful World of Wolseleys', on his *Wolseley Forum* website (www.wolseleyforum.com), which has been so used since 13 November 2008.

The Respondent's Registration of the Domain Names is not Abusive

- The Respondent joined as a member of the Complainant in January 2008, following the purchase by him of a Wolseley car. He subsequently set up the *Wolseley Forum*, in order to find out more information about Wolseley cars in general and to facilitate an on-line community forum for owners and enthusiasts, to join and chat about their Wolseleys. The *Wolseley Forum* went live on 13 November 2008.
- The Respondent considered that the setting up by him of the *Wolseley Forum* was a problem with some of those on the Complainant's Committee, which in his view caused ill-feeling against him.
- The *Wolseley Forum* has a membership in excess of 1,290 members and has over 5,200 unique visitors per month. In addition, the site has had over 944,000 hits since its launch. The *Wolseley Forum* is a free on line resource for all Wolseley enthusiasts throughout the world. Part of its aim is to maintain a register of all Wolseley vehicles produced. Thus, the Respondent claims to have registered the Domain Name *wolseleyregister.co.uk* for the future implementation of this aim.
- The Respondent was a member of the Complainant's Committee from 7 February 2009 until 2 March 2011; holding the positions of Publicity Officer from 7 February 2009 to 13 June 2009, and North West Regional Representative from June 2009 until March 2011 when he resigned and was then subsequently asked to leave the Club.
- After the Respondent's resignation from the Complainant, *The Wolseley Owners Club Limited* was formed of which the Respondent is a member, one of the Directors and he holds a committee position.
- Although there was a relationship between the Complainant and the Respondent at one time, at no point were the Domain Names used exclusively by the Complainant.
- When on the Complainant's Committee, the Respondent advised the Complainant on various matters including the Complainant's on-line presence. In

particular, he suggested that the Complainant purchase and register domain names pertaining to the Complainant. He offered to do this on its behalf to strengthen its online presence and take ownership of the Complainant's domain name (wolseleyworld.com), but no action was taken regarding this. At no time has the Respondent ever been asked or instructed to do so. Circumstances have now changed and the Respondent now considers that he requires all the domain names registered to him (including the Domain Names) for use in connection with his companies.

- The Respondent made no secret of the fact that he had registered the Domain Names in his name and had even facilitated the use of the Domain Name wolseleyregister.co.uk for email purposes for a short while.
- In February 2009, at a meeting held by the Complainant's Committee in which the Respondent took part, a proposal was aired to change the name of the organisation because it was thought that it was confusing to any potential new members and did not describe the activities of the club. Therefore, with a prospect of the Complainant changing its name, the Respondent secured the domain wolseleyregister.com for a future project. [Though following a WHOIS search, the Expert notes that that domain name was registered by the Respondent on 3 January 2009.]
- The Complainant made two assertions, both without providing any evidence:
 - o First, that the Domain Names were registered by the Respondent on its behalf. This is wholly untrue. The Domain Names were registered by the Respondent in his own right and funded by the Respondent at a time prior to the Respondent being involved with the Complainant in an official capacity. Since purchasing the Domain Names, the Respondent has renewed them when necessary. At no time was he asked to register any domain names on behalf of the Complainant.
 - o Secondly, that the Domain Names are being directed to a 'competing' club (*The Wolseley Owners Club*), inferring that the Domain Names are being used in a manner likely to lead to confuse users. In fact, the Websites point to a holding page which clearly states that the Domain Names have no connection to the Complainant. Users are then re-directed to *The Wolseley Forum*. Therefore, there is no circumstance that would indicate that the Domain Names are being used in a threatening manner or in a way which has, or is likely to, confuse people, or businesses, into believing that it is connected with the Complainant.
- In May 2010, at a meeting of the Complainant's Committee, it was minuted that the Respondent was, "willing to change ownership [of the domain wolseleyregister.com] to the [Complainant] in order to protect the name". The Respondent would have been happy to do that, but no action regarding this was ever initiated by the Complainant, until some 6 months after the Respondent had resigned from the Complainant.
- The Respondent is making legitimate non-commercial and fair use of the Domain Names in that he has made preparation for the use of the Domain Names prior

to being made aware of the Complainant's cause for complaint on 26 September 2011 (when the Complainant wrote to the Respondent asking for the transfer of the Domain Names to it).

- In this regard, the Respondent claimed that the Domain Name *wolseleyregister.co.uk* is for use with an online database which aims to register all Wolseley vehicles in connection with the Respondent's on-line community forum. The Domain Name *wolseleyworld.co.uk* is in connection with an on-line marketing campaign to re-launch the *Wolseley Forum* when it has been upgraded from the current version, to the latest version, of its operating software.
- In addition, the Respondent stated that communication has already taken place with an agency of the DVLA in January 2009 regarding the purchase of DVLA data to populate an online register of Wolseley vehicles. Also, email communication took place between the Respondent and his web-designer in April 2011 regarding an online database and new website.

Complainant's Reply:

5.3 In summary, the Complainant replied as set out below.

The Complainant has Rights in the Domain Names

- The allegation that the Names are generic terms and cannot be claimed by the club is nonsense. The Wolseley mark as a logo is owned by the *Nanjing Automobile (Group) Corporation* in respect of class 12 motor vehicles, and the Wolseley mark as a word is owned by *Wolseley Plc* for a number of classes including class 41 entertainment, sporting and cultural services. However, the juxtaposition of the words *Wolseley* and *World*, and *Wolseley* and *Register*, were unique to the Complainant until the Respondent's use of the Domain Names.
- There is no evidence submitted by the Respondent that anyone, other than the Complainant, used the combination of words identical to the Domain Names (until the Respondent started using them). The combination of words is not generic and not a usual combination in common parlance in the English language. The Respondent made claims for his intended use of the Domain Names but provided no evidence of this stated intention.

The Domain Names, in the hands of the Respondent, are Abusive Registrations

- The Respondent was a member of the Complainant from January 2008 and as such cannot claim not to be fully aware of the Complainant's use of the Names as names associated with the Complainant and their extensive common law rights arising from that use on a national basis.
- The Complainant is a not-for-profit organisation; it is commercial in that it charges membership fees in exchange for which it organises events and provides information to members both over the Internet and through paper publications. The Respondent's enterprise to which the potential visitors to the Complainant's website are redirected is not a "non-commercial website" as it includes links to product sales made through the activities of the website.

- The Respondent admitted that he has set up a number of companies using names identical to the Names; they are neither designated not-for-profit companies under the *Industrial and Providence Society's Act* nor are they charities, social enterprises or companies limited by guarantee. They are not indicative of any future intention for “non-commercial” use of the Domain Names.
- Furthermore, the Respondent has not mentioned that a company with a Registration Number 7559588 which he set up having been incorporated on 10th March 2011 as *The Wolseley Owners Club Limited* changed its name to *The Wolseley Owners Club (Trading) Limited* on 4 May 2011. The sole Director and sole shareholder is the Respondent. There is clearly an intention to undertake trading,
- Although the Respondent stated that he was not “involved with the Complainant in an official capacity” when he registered the Domain Names, he admitted that at the pertinent time of purchase he was a member of the Complainant's Committee.
- The Respondent agreed to transfer the Domain Names and as such acknowledged that they were the property of the Complainant, which in law, he held on trust. Members hold Complainant property individually on trust for the club members. The Complainant expected the Respondent to take the agreed action to transfer the Domain Names. As they were not being used by the Respondent at that time, it did not become apparent that he had not done so until he started to use them to point to his rival website.
- On being made aware by the Respondent that he had registered the Domain Names, the Complainant asked the Respondent to transfer the names to it. The Respondent agreed to do so, which is both evidenced in the Complainant's Committee minutes and also admitted by him in his Response. This was not done. The Respondent admitted he “facilitated the use” of the Domain Names for emails intended for the Complainant: further evidence of their purchase on trust by a Committee Member for the purposes of the Complainant - not for the purposes of the Respondent as an individual and certainly not for the purposes of a rival organisation.
- The Respondent indicated that he feels aggrieved after having left the Complainant and his motives for using and keeping the Domain Names can only be seen as purposely intending to interrupt the activities of the Complainant. That is the obvious and natural conclusion to the “changing of mind” that he referred to in relation to the retention of the Domain Names, having clearly indicated while he was a member his willingness to transfer them to the Complainant.
- The Respondent admitted that the circumstances have changed since he purchased the Domain Names, which confirms that the position was different at the time of purchase. It is only since he left the Complainant and set up a rival that the situation has changed. The re-direction of Internet visitors who access the Websites and those entering searches for them, notwithstanding he states that activity is interrupted by a 'notice' page setting out that the visitor is not reaching their intended site, would lead potential visitors to the Complainant's

activities from their website to those of its rival, owned by the Respondent.

Respondent's Non-standard Submission

5.4 In summary, the Respondent stated that:

- the Names have not been registered by the Complainant as trademarks and as such the Complainant cannot be afforded the protection that such a measure would take. By their own words, the Complainant admitted that it has no rights in the word Wolseley as these are held by the *Nanjing Automobile (Group) Corporation* and *Wolseley PLC*.
- The Respondent was not a member of the Complainant's Committee at the time he purchased the Domain Names. He first became a co-opted member of the Complainant's Committee on the 7 February 2009, more than a month after the registration of the Domain Names.
- The Respondent never agreed to transfer the Domain Names which are the subject of the Complaint: he only stated he may be 'willing' to transfer the domain name wolseleyregister.com, which is not the subject of the Complaint.
- The domain names thewolseleyregister.com and thewolseleyregister.co.uk were registered by the Complainant's representatives on the 27th November 2010, some 10 months before initiating any complaint or request for transfer. This action would suggest that it was at least in the mind of the Complainant that ownership of the Domain Names was unclear and that, as such, the Complainant acted to cover itself in such circumstances.
- The *Wolseley Forum* is not a rival website, or a car club, it is an on-line community and a not for profit voluntary organisation. The Complainant has made profit and has reserves in its accounts from membership fees and other income, including Regalia sales.

Complainant's Reply

5.5 In summary, the Complainant replied that:

- it has never claimed to represent any or a large proportion of the Wolseley car owners registered with DVLA.
- At no time prior to this additional response to the Complaint has the Respondent suggested that his purchase of the Domain Names was "for a future project". In fact, he stated in his original response that he "changed his mind" about handing over of the Domain Names to the Complainants indicating that the Domain Names were purchased for the purposes of his activities with the Complainant.
- The registration of company names provides the Respondent with no protection in law in relation to the names chosen for those companies. Also, the fact that the Respondent admits that he is using the Domain Names should not create a right if that use infringes the Complainant's earlier rights.

- The Respondent stated that the *Wolseley Forum* is not a rival to the Complainant. He does not say the same of the *Wolseley Owners Club* of which he is a founder member and which clearly is a competitor to the Complainant.
- The Respondent admitted that he gave advice to the Complainant regarding the purchase of Domain Names and that he tried to encourage the Complainant to become more conversant with the Internet and its potential uses for the Complainant. He admitted that he purchased the Domain Names at a time when he was Publicity Officer and at a time when he was suggesting purchase of these very Domain Names for and on behalf of the Complainant.
- The reason why the Complainant requires others to register Domain Names for it is because it is an unincorporated association and, as such, its members must hold ownership of all assets in their names for the benefit of the organisation. Whilst the Respondent was a member of the Complainant there was no need for the Complainant to seek recovery of the Domain Names, that was not necessary until the Respondent left the association and indicated that he had “changed his mind” about handing over the Domain Names.
- The Respondent’s reasons for wanting to retain the Domain Names are clear from his responses. He purchased them at a time when he was a member of the Complainant and when he left he started using them for his competing projects. There is no evidence adduced to show that he purchased the Domain Names for any reason other than for the benefit of the Complainant and until he left the Complainant all activity relating to the use of the Domain Names was provided for the benefit of the club (e.g. using it to facilitate email correspondence for the club).

6. Discussions and Findings

General

6.1 To succeed in the Complaint, the Complainant has to prove pursuant to paragraph 2 of the DRS policy (the ‘Policy’), on the balance of probabilities (that the Complainant’s case is more likely than not to be the true version¹), that:

(i) it has Rights in respect of a name or mark identical or similar to the Domain Name (paragraph 1 of the Policy); and,

(ii) the Domain Name, in the hands of the Respondent, is an Abusive Registration (paragraph 1 of the Policy).

6.2 Addressing each of these limbs in turn:

i) Complainant’s Rights

6.3 Paragraph 1 of the Policy defines ‘Rights’ as:

¹ <http://www.nominet.org.uk/disputes/drs/legalissues/>.

“[...] 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, the Complainant must have the Rights at the time of the complaint (see Nominet Appeal decision, *ghd*, DRS No. 03078).

- 6.4 The Complainant is an unincorporated association. As discussed by the Expert in the Nominet DRS Decision 10067, *SavoySingers*, it is possible for an authorised member of an unincorporated association to bring legal proceedings in the English courts on behalf of the association: there is no reason why this should not also be possible in the case of proceedings under the Policy.
- 6.5 In assessing whether or not the Complainant has Rights for the purposes of the Policy, it is legitimate to consider the position of the Complainant as a whole rather than the position of the individual member, Mr Rob Dewing, who brought the Complaint on the Complainant's behalf. Therefore, the question for the Expert is whether or not in his opinion, and on the evidence before him, the Complainant has Rights in the Domain Names.
- 6.6 The Expert notes that the Complainant has not obtained registered trademark protection for the names in consideration, *Wolseley Register* or *Wolseley World* (collectively the 'Names'); a registered trademark being an enforceable right as understood by the above definition.
- 6.7 As the definition of Rights does embrace other enforceable rights than just registered trade (or service) marks, the Expert has considered whether such a non-registered enforceable right arises in respect of the Names (the Names being identical to the Domain Names, not counting the generic *.co.uk* suffix). The Expert considers that relevant to this consideration is whether:
- (a) the Complainant has used the Names in question for a not insignificant period and to a not insignificant degree; and,
 - (b) the Names in question are distinctive by the purchasing public (including trade purchasers) as indicating the goods or services of the Complainant.

Addressing each of these considerations in turn:

- 6.8 In relation to consideration (a), the Expert notes that the Complainant was formed in 1964 and has carried on its activities under the name '*The Wolseley Register*' since that date. It has been publishing its Club magazine, the '*Wolseley World*', for over 30 years. Therefore, the Expert considers that the Complainant has used the Names for a 'not insignificant' period.
- 6.9 In addition, the Expert considers that the use of the Names by the Complainant has been to 'a not insignificant degree'. The Complainant claims to have over 600 members throughout the UK and overseas, which the Expert has no reason to disbelieve. As set out in para. 5.2 above, the Respondent considers this number as being roughly 5% of all possible members in the UK and overseas – relying on this to suggest that the Complainant's use is 'insignificant'.

- 6.10 However, on the facts before him, the Expert considers that having 600 members for what is a specialised car club is sufficient to show that the Names have been used by the Complainant to a *not insignificant degree*. Also relevant, and as discussed below at para. 6.15 is that external advertisers use the Complainant’s magazine to advertise their goods/services.
- 6.11 In relation to consideration (b), the Expert considers that the Names are distinctive by the purchasing public as indicating the goods or services of the Complainant.
- 6.12 The Respondent in this regard considers that each of the Names are not distinctive, being made up of a “defunct” motor manufacturer “*Wolseley*” and a word in common usage associated with many classic car clubs “*Register*” and “*World*”. However, the Expert considers that the Names by the addition of the second word to the *Wolseley* word are of themselves distinctive.
- 6.13 Further, and in agreement with the Complainant’s submission, the Expert considers that the juxtaposition of the words *Wolseley* and *World*, and *Wolseley* and *Register*, were unique to the Complainant until the registration by the Respondent of the Domain Names. Also, these combination of words is not “generic” and not a usual combination in “common parlance” in the English language.
- 6.14 The Expert considers that the Complainant has generated goodwill in the Names, similar to an action in passing off (‘Goodwill’).² Relevant to this is that the Complainant has been ‘in business’, albeit as an unincorporated association, since 1964 and has published its magazine, the *Wolseley World*, for over 30 years. Also, the Complainant has used the domain (wolseleyworld.com) as its home domain since 2007.
- 6.15 In addition, the Expert considers relevant the fact that that the Complainant’s magazine takes commercial adverts as well as those from its members (the Expert was provided with a copy of the Complainant’s magazine No. 153, *Wolseley World* where an advert for insurance services had been placed). Such placing of adverts indicates to the Expert that those outside the Complainant consider there is Goodwill in the Names and that it is worthwhile to associate themselves with the Complainant.
- 6.16 There is some discussion by both Parties as to what is meant by the ‘purchasing public’ in this context. However, the Expert does not consider such a forensic exercise is necessary on these facts. The Complainant is commercial in that it charges membership fees in exchange for which it organises events and provides information to members both over the Internet and through paper publications. It also sells Regalia through its website. Therefore, the Club does generate monies in order to run its day-to-day activities. The Expert considers this sufficient for these purposes.
- 6.17 Given the reasoning above, as well as the fact that the requirement to demonstrate ‘Rights’ is not a particularly high threshold (Nominet appeal panel decision, *Seiko-shop* DRS 00248), the Expert considers that the Complainant has Rights in respect of the Name.

² Goodwill has been defined as: “the benefit and advantage of the good name, reputation and connection of a business. It is the attractive force which brings in custom - *Inland Revenue Commissioners v Muller & Co Margarine Ltd* [1901] A.C. 217 at 223,224.

ii) Abusive Registration

6.18 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 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;”

6.19 *In relation to i. above* – the Respondent registered the Domain Names on the 3 January 2009, roughly a year after he had become a member of the Complainant. It is not alleged by the Complainant that there was an Abusive Registration at this time, and there is no evidence before the Expert that persuades him that the intention of the Respondent by registering the Domain Names was to disrupt unfairly the Complainant’s Rights.

6.20 Indeed, on the balance of probabilities, the Expert considers that the Respondent first registered the Domain Names at least with the idea of them being used by the Complainant. Relevant to this is that:

- the Respondent registered the Domain Names while being a member of the Complainant;

-the Expert considers that the Domain Names were registered by the Respondent in contemplation of him taking the role of Publicity Officer on the Complainant’s Committee (there is discussion in the submissions of the Respondent that he was approached in August 2008 to stand as the Publicity Officer for the Complainant and he expressed an interest in doing so at this time, approximately five months before the Domain Names were registered);

- the Respondent facilitated the use of the *wolseleyregister.co.uk* Domain Name for email purposes for the Complainant (albeit for a short while); and,

- the Respondent in his response stated that “circumstances have now changed” and that he “now require[s] all those domain names registered to [him], for use in connection with [his] companies” thus giving the impression that the Respondent had intended them to be held on behalf of the Complainant but then changed his mind.

6.21 *In relation to ii. above* – the Expert considers that the Domain Names have been used in a manner which took unfair advantage of and was unfairly detrimental to the Complainant’s Rights.

6.22 There is much in both Parties’ submissions that discusses a breakdown in their relationship culminating in the Respondent resigning from the Complainant’s Committee and then no longer being a member of the Complainant. The Expert does not consider much of this relevant to the Complaint and in his summary of the very

extensive submissions made by both sides has chosen not to refer to the more subjective comments made.

- 6.23 There are also submissions before the Expert as to whether or not the Respondent agreed to transfer the Domain Names to the Complainant. Again, the Expert does not consider this relevant for the purposes of the Decision. What is relevant is the use made of the Domain Names after their registration.
- 6.24 The Expert considers that, after there had been an irrevocable breakdown in the Parties' relationship, the Respondent acted to gain legal protection over the Names and disrupt the business of the Complainant. In this regard, the Expert notes that the Respondent set-up *Wolseley Register Limited* after he had left the Complainant, and he is connected with the other companies referred to at paragraph 4.4 above – all of which were incorporated after the Respondent had resigned from the Complainant's Committee.
- 6.25 Also relevant to this is the fact that the Respondent currently uses the Websites to point to his *Wolseley Forum* and to a competing club of which he is a Director (*Wolseley Owners Club*).
- 6.26 Paragraph 3 of the Policy sets out a *non-exhaustive* list of factors which may be evidence that the Domain Name is an Abusive Registration. In this case, the Complainant refers in substance to the factor set out at Paragraph 3 (a) (ii) of the Policy, which states that:
- “[there may be evidence of an Abusive Registration if there are] Circumstances indicating 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.”*
- 6.27 Given the evidence before him, the Expert considers that the Respondent chose not to transfer the Domain Names after he left the Complainant's Committee in order to use them for his own purpose: to attract web-users who access the Websites because of its perceived connection with the Complainant. The Expert considers that, on the balance of probabilities, it was done by the Respondent to disrupt the general business of the Complainant.
- 6.28 The Expert considers this relevant to the Decision because the Respondent's continued use of the Domain Names is potentially confusing to those visiting the Websites expecting to find the services of the Complainant on offer (to find out, for example, information about the Complainant such as how to become a member or what Wolseley cars/spares are for sale).
- 6.29 While the Websites do carry a clear message that they have no connection with the Complainant, the 'disclaimer' does not address the initial confusion of those who access the Websites assuming they are connected with the Complainant. The consequence of such confusion is that, for example, potential Complainant members or car/spare purchasers might then browse the Websites and take the Respondent's services instead (such as becoming a member of the *Wolseley Owners Club*), all of

which the Expert considers takes unfair advantage of and is unfairly detrimental to the Complainant's Rights.

- 6.30 The Expert has also considered whether any other factors support the Complainant's case, in particular whether Paragraph 3 a. v. of the Policy is relevant on these facts, which states that:

"[there may be evidence of an Abusive Registration if t]he Domain Name was registered as a result of a relationship between the Complainant and the Respondent, and the Complainant: A. has been using the Domain Name registration exclusively; and B. paid for the registration and/or renewal of the Domain Name registration."

- 6.31 However, there is no evidence before the Expert that the Complainant has used the Domain Names or paid for their registration and/or their renewal.

- 6.32 The Respondent tries to claim Rights in respect of the Names on the grounds of his common usage of the Names and by virtue of him owning a company with a name that is identical to the Domain Names (*Wolseley Register Limited*). In addition, the Respondent claims a legitimate connection with an unregistered mark similar to the domain name wolseleyworld.co.uk in that he used the tag line 'The Wonderful World of Wolseleys', on his *Wolseley Forum* website (www.wolseleyforum.com), which has been so used since 13 November 2008.

- 6.33 However, the Expert considers that the Respondent has shown insufficient evidence that he has Rights in the Names. The Respondent only started to use the Domain Names within the last year and in the Expert's opinion is relying on the Complainant's prior Goodwill in order to generate interest in the Websites. In addition, while the Respondent owns a company with a name identical to the Name *Wolseley Register*, the mere registration of a company name does not of itself give rise to any Rights.

- 6.34 The Respondent in reply argued that his use of the Domain Names is not an Abusive Registration, in particular by reference to *Paragraph 4 a. i. of the Policy*, which states that:

"[b]efore 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 [...] 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; C. made legitimate non-commercial or fair use of the Domain Name;"

- 6.35 However, the Expert does not consider this helps the Respondent. For the reasons set out at paragraph 6.20, the Expert considers that the Respondent registered the Domain Names at least with the idea of them being used by the Complainant. Therefore, when the Respondent then decided to use them for his own purposes (as referred to in paragraph 6.20 above), the Respondent would have been aware of the Complainant's cause for complaint prior to him then using them - rather than, as the Respondent suggested, when the Complainant requested the return of the Domain Names.

6.36 Lastly, the Expert hopes that both Parties can find a solution to their disagreement whereby both Clubs, the *Wolseley Register* and the *Wolseley Owners Club*, can co-exist amicably for the benefit of the Wolseley car mark.

7. Decision

7.1 Accordingly, the Expert finds, on the balance of probabilities, that the Complainant has Rights in names which are identical to the Domain Names; and that the Domain Names, in the hands of the Respondent, are Abusive Registrations. Therefore, the Expert directs that the Domain Names be transferred to the Complainant.

Signed Dr Russell Richardson

Dated 24 January 2012