

DISPUTE RESOLUTION SERVICE

D00010482

Decision of Appeal Panel

**Robert Steer
t/a Senate Grand Prix and t/a Ontrack Grand Prix**

and

Grand Prix Adventures Ltd

1. The Parties:

Complainant/Appellant: Robert Steer t/a Senate Grand Prix and t/a Ontrack
Grand Prix
PO Box 44
East Grinstead
West Sussex
RH19 4YG
United Kingdom

Respondent/Appellant: Grand Prix Adventures Ltd
4 Dunnottar Place
Broughty Ferry
Dundee
DD5 1PJ
United Kingdom

An unusual aspect of this appeal is that both parties are appellants. The Complainant at first instance is appealing the decision of the Expert to the extent that his complaint failed (i.e. in relation to the domain name

<ontrackgrandprix.co.uk>) and the Respondent at first instance is cross-appelling the decision of the Expert to the extent that the complaint succeeded (i.e. in relation to the domain name <senategrandprix.co.uk>).

The Panel proposes to maintain the terminology at first instance and refer to the Complainant as the Complainant and to the Respondent as the Respondent.

2. The Domain Names:

<ontrackgrandprix.co.uk> (the “ontrack domain name”)
<senategrandprix.co.uk> (the “senate domain name”)
(together the “Domain Names”)

3. Procedural History

The Complaint was received by Nominet on 4 November 2011 and notified to the Respondent on 7 November 2011. The Response was received and notified to the Complainant on 29 November. The Reply was received by Nominet and notified to the Respondent on 7 December 2011. Mediation ensued, but failed to result in settlement of the dispute. The Complainant having paid the appropriate fee, on 30 March 2012 the Expert was appointed to provide a full decision. On 3 April 2012 the Expert received at his request a non-standard submission from the Respondent. The decision was issued by the Expert on 14 May 2012. The decision was issued to the parties by Nominet on 15 May 2012.

Respondent's Appeal.

On 24 May 2012 the Respondent notified Nominet of its intention to appeal and paid the requisite 10% deposit. Nominet received the Respondent's Appeal Notice on 20 June 2012. The Complainant's Appeal Response was received by Nominet and notified to the Respondent on 3 July 2012.

Complainant's Appeal.

On 28 May 2012 the Complainant notified Nominet of its intention to appeal and paid the requisite 10% deposit. Nominet received the Complainant's Appeal Notice on 21 June 2012. The Respondent's Appeal Response was received by Nominet and notified to the Complainant on 5 July 2012.

Panel Appointment.

On 10 July 2012 Tony Willoughby, Ian Lowe and Philip Roberts (the undersigned, “the Panel”) were appointed to the Appeal Panel, each having individually confirmed to the Nominet Dispute Resolution Service that:

“I am independent of each of the parties. To the best of my 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 my independence in the eyes of one or both of the parties.”

These are Appeals against Decisions at first instance in favour of the Complainant in the case of the senate domain name; and in favour of the Respondent in the case of the ontrack domain name. The Panel was appointed to provide decisions on or before 21 August 2012. This process is governed by version 3 of the *Procedure for the conduct of proceedings under the Dispute Resolution Service* (“the Procedure”) and the Decisions are made in accordance with version 3 of the *Dispute Resolution Service Policy* (“the Policy”). Both of these documents are available for inspection on the Nominet website (<http://www.nominet.org.uk/disputes/drs>).

4. The Nature of These Appeals

The Policy §10a provides that: *“the appeal panel will consider appeals on the basis of a full review of the matter and may review procedural matters”*.

The Panel concludes that insofar as an appeal involves matters other than purely procedural complaints the appeal should proceed as a re-determination on the merits.

In addition to the decision under appeal, the Panel has read the Complaint (with exhibits), the Response (with Annex), the Reply, the Respondent’s non-standard submission, the Respondent’s Appeal Notice, the Complainant’s Appeal Notice, the Complainant’s Appeal Notice Response and the Respondent’s Appeal Notice.

5. Formal and Procedural Issues

Appended to the Complainant’s Appeal Notice was a schedule containing what the Complainant considered to be further documentary evidence of use of the ontrack domain name by the Complainant and/or his predecessor.

Paragraph 18h of the Procedure provides that:

“The appeal panel should not normally take into consideration any new

evidence presented in an appeal notice or appeal notice response, unless they believe that it is in the interests of justice to do so.”

The Respondent contends that the scheduled documents should not be admitted into these proceedings on the basis that they comprise evidence which could and should have been produced by the Complainant with the original Complaint. The Complainant contends that it is in the interests of justice for the new evidence to be admitted because (i) the finding against the Complainant was on a very narrow point, (ii) the evidence goes to an existing issue, (iii) it is important that the issue is resolved once and for all.

The Panel agrees with the Respondent. The normal rule (per paragraph 18h) is that new evidence should not be admitted. It does not follow from the three points raised by the Complainant that it is in the interests of justice to admit the new evidence in this case, particularly where the Respondent's allegations were clearly made in the Response, leading the Complainant to introduce further evidence in his Reply. It would be unjust for the Complainant to be permitted to introduce yet further evidence, readily available at the outset, at this late stage.

The Panel accordingly declines to take into consideration the schedule to the Complainant's Appeal Notice.

6. The Facts

The parties are competitors. They each provide hospitality packages and related offerings in relation to Grand Prix motor racing events.

From 26 July 2006 (date of incorporation) to 18 January 2011 (date dissolved) the Complainant was sole shareholder of Ontrack Grand Prix Limited, a company of which he was also a director until he resigned his directorship in October/November 2010.

From 8 December 2006 (date of incorporation) to 8 March 2011 (date dissolved) the Complainant was sole shareholder of Senate Grand Prix Limited, a company of which he was also a director until he resigned his directorship in November 2010.

The Complainant is the subject of a disqualification order, disqualifying him from holding the office of a company director from 24 November 2010 until 23 November 2017. It is to be noted that the Complainant asserts that the disqualification order does not relate to any entity involved in these proceedings. This has not been challenged by the Respondent, although the Respondent maintains that the fact of the order is a relevant matter which the Panel should take into account generally.

The Complainant is the registrant of the corresponding '.com' domain names <ontrackgrandprix.com> and <senategrandprix.com>. The history of these domain names is complex and dealt with in greater detail below. The former was originally registered by the Complainant on 26 July 2006, then transferred in late 2006 to a web designer, Yann Sasportas, and transferred back to the Complainant on 31 March 2010. <senategrandprix.com> was originally registered on 31 August 2005 in the name of Robert James Limited, a company with which the Complainant is associated (the Complainant was listed as the technical contact). The registration expired on 31 August 2010. The Complainant registered the domain name on 2 September 2010.

The Respondent registered the Domain Names on 11 February 2011 and connected them to the Respondent's Grand Prix Adventures website.

7. The Parties' Contentions

The Panel gratefully adopts the Expert's summary of the parties' contentions, which is set out in the Expert's decision of 14 May 2012 and accessible at the Nominet website. The Appeal Notices and Appeal Responses (excluding the Schedule referred to in paragraph 5 above) do not introduce new arguments of any materiality.

In essence the Complainant contends that the names, Ontrack Grand Prix and Senate Grand Prix, are names in respect of which he owns common law trade mark rights, having traded under those names initially as a sole trader, then through his wholly-owned companies named Ontrack Grand Prix Limited and Senate Grand Prix Limited, and latterly, from 1 August 2010 when he acquired the goodwill and trading debts of those companies, again as a sole trader. The Complainant's trading names are identical to the Domain Names if one ignores the generic '.co.uk' domain suffix.

The Complainant contends that the Domain Names in the hands of the Respondent are abusive registrations. The Respondent is a competitor and in adopting the Complainant's names for the Domain Names and connecting them to the Respondent's website for its competing business, the Respondent is unfairly diverting business away from the Complainant.

The Respondent's case is simple. It accepts that it may be diverting business away from the Complainant, but it contends that when it registered the Domain Names the Complainant had no better right to the names Ontrack Grand Prix and Senate Grand Prix than the Respondent. It contends that the Complainant has produced no credible evidence to support his claim that he was the owner of any rights in those names as at 11 February 2011 when the Respondent registered the Domain Names. The Respondent contends that any rights in those names, which might have pre-existed, died with the

Complainant's companies when they ceased trading in July 2010. The Respondent contends that the commercial advantage he has taken is fair.

8. Discussion and Findings

The factual background to the reasoning below is to be found in section 6 above.

In order for the Complainant to succeed it must (pursuant to Paragraph 2 of the Policy) prove to the Panel, on the balance of probabilities, in relation to each of the Domain Names **both** that:

it has Rights in respect of a name or mark which is identical or similar to the Domain Name; and

the Domain Name, in the hands of the Respondent, is an Abusive Registration as defined in Paragraph 1 of the Policy.

Rights (as defined in paragraph 1 of the Policy) *means rights enforceable by the Complainants, whether under English law or otherwise, and may include rights in descriptive terms which have acquired a secondary meaning;*

Abusive Registration (as defined in paragraph 1 of the Policy) *means a Domain Name which either:*

i. was registered or otherwise acquired in a manner which, at the time when the registration or acquisition took place, took unfair advantage of or was unfairly detrimental to the Complainant's Rights; or

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

Does the Complainant have Rights in names or marks which are identical or similar to the Domain Names or either of them? The Complainant claims Rights in respect of the name "Ontrack Grand Prix", which plainly is identical or similar to the ontrack domain name. The Complainant also claims Rights in respect of the name "Senate Grand Prix" which plainly is identical or similar to the senategrandprix domain name.

The first question for the Panel is whether the Complainant has Rights in those names as he claims. The Respondent says that he does not, or at any rate has no better rights to the names than the Respondent. The Expert found that the Complainant had Rights to the "Senate Grand Prix" name, but that the Complainant had failed to satisfy him that he had Rights in respect of the "Ontrack Grand Prix" name.

For the purpose of this question, the date upon which the Complainant

acquired his Rights is not directly in point. It suffices if the Complainant has Rights as at the date of the Complaint. Moreover, the test imposes a low threshold. As stated in paragraph 2.3 of the Expert's Overview accessible on the Nominet website:

"The wording of the Policy is broader and less restrictive [than the UDRP], which matches the reality that the first hurdle (i.e. proving the existence of rights in a relevant name or mark) is intended to be a relatively low-level test... The objective behind the first hurdle is simply to demonstrate a bona fide basis for making the complaint."

Although the date on which the Complainant acquired any Rights he may have in the names, "Ontrack Grand Prix" and "Senate Grand Prix" is of little significance to the first hurdle (provided he acquired them prior to filing the Complaint), the issue as to whether or not he acquired them prior to the registration of the Domain Names could be material to the second hurdle. It is convenient to consider at this stage and in some detail the Complainant's history in relation to those names.

As can be seen from section 6 above the history surrounding the names and their use is not entirely straightforward and this is largely down to the Complainant's failure to come forward with an accurate and coherent story at the outset.

While the Complainant claims to have traded under the names since 2003, he has produced no evidence of any kind to support that claim and the Panel takes no account of any use that he may have made of the names prior to incorporation of his companies, Ontrack Grand Prix Limited and Senate Grand Prix Limited, on 26 July 2006 and 8 December 2006 respectively. Nonetheless, it appears to the Panel highly likely that those companies conducted some trade, although the Complainant's evidence is very sparse, particularly in relation to Ontrack Grand Prix Limited.

The Complainant claims that he and his companies have traded continuously online under the domain names, <ontrackgrandprix.com> and <senategrandprix.com>, which were first registered by him (or on his instruction) on 31 August 2005 in the case of the latter and on 26 July 2006 in the case of the former. In response to criticisms made by the Respondent of the Complainant's claim in the Complaint that he has owned those domain names at all material times (at times they have been registered to third parties), the Complainant has provided an explanation.

In the case of <ontrackgrandprix.com> he says that he was required by the webdesigner he was employing to design and maintain his Ontrack Grand Prix website to transfer the domain name to that designer, which he did shortly after having first registered it in his own name. It was transferred back

to the Complainant on 31 March 2010. In the case of <senategrandprix.com> he instructed another website designer he was using to register the domain name, but for some reason it was registered not in the Complainant's name, but in the name of another company with which he was associated. The registration expired on 31 August 2010 and the Complainant re-registered the domain name in his own name on 2 September 2010.

The Panel has no reason to doubt the Complainant's explanation, but it is regrettable that the Complainant has not put before the Panel any examples or illustrations of his or his companies' use of the <ontrackgrandprix.com> domain name prior to February 2011 - the examples in Schedule 3 to the Complaint are dated November 2011 - when the Domain Names were registered. The first dated reference to any use of the <senategrandprix.com> domain name that the Panel has been able to find in the evidence is a double page advertisement for Senate Grand Prix appearing in the April 2010 issue of the magazine, F1 Racing, which was repeated in the following month's issue (Schedule 2 to the Complaint). Accordingly, the only direct documentary substantiation for the Complainant's contentions as to the use of the names prior to registration of the Domain Names dates back only to April 2010 and is restricted to the Senate Grand Prix name.

However, the Complainant has produced in evidence a witness statement of Nicolas Belton, an accountant, whose firm were the accountants for the Complainant's companies and who himself was company secretary to those companies from 7 February 2008 until their dissolution on 18 January 2011 and 8 March 2011 respectively. The statement, verified by a statement of truth, is very brief and the Respondent correctly observes that it is nothing like as informative as it might have been. For example, it gives no indication of the extent of the companies' trading activity. However, Mr Belton confirms that the companies traded until 31 July 2010, whereupon the Complainant acquired their goodwill and trading debts and that the Complainant then commenced trade as a sole trader under the names Ontrack Grand Prix and Senate Grand Prix.

While it is conceivable, of course, that this is all a smokescreen and that the companies never conducted any proper commercial activity under their names, the Panel would have to conclude that Mr Belton, knowing of the reason for which the statement was being made, has deliberately set out to deceive the Panel. That conclusion could only be justified by compelling evidence and there is nothing before the Panel to justify such a conclusion.

While it is for the Complainant to prove that he has Rights in respect of the names Ontrack Grand Prix and Senate Grand Prix, the Panel is entitled to take into account what is and is not said by the Respondent. There is no dispute that the parties are competitors in a niche area of business providing *inter alia* hospitality packages for major motor racing events. Accordingly, the

Respondent is well placed to know of the existence, identity and trading names of its competitors in that market. The Panel has noted that while in its various submissions the Respondent has been meticulous in pointing out the defects in the Complainant's evidence, nowhere is there to be found any denial that a business known as Senate Grand Prix and a business known as Ontrack Grand Prix were trading in competition with the Respondent at the date of the Complaint. Nor has the Respondent suggested that there is or was anyone else in the market using those names.

Relying primarily on Schedules 1 and 2 to the Complaint and the witness statement of Mr Belton, the Panel is satisfied that the Complainant has overcome the low threshold presented by the first hurdle, albeit by a small margin. He has established to the Panel's satisfaction on the balance of probabilities that he had Rights in respect of the names Ontrack Grand Prix and Senate Grand Prix at the date of the Complaint.

The next question for the Panel is whether the Domain Names were registered unfairly, taking unfair advantage of the Complainant's Rights or being unfairly detrimental to the Complainant's Rights. Alternatively, has the Respondent's subsequent usage of the Domain Names taken unfair advantage or been unfairly detrimental to the Complainant's Rights?

Once again it is necessary to analyse the nature and extent of the Complainant's Rights in order to gauge whether there has been unfair advantage or detriment. Here, it is convenient to start with the Respondent's statement of its position, which is identical in relation to both Domain Names. The relevant paragraphs of the Response are identically framed save for the name being addressed. The wording is as follows:

"Following the dissolution of OGPL [SGPL] and the name of "Ontrack Grand Prix" ["Senate Grand Prix"] being available for use (as no one owned it as its previous owner (OGPL) [SGPL] was dissolved), it appears that both Mr Steer and the Respondent have used the name "Ontrack Grand Prix" ["Senate Grand Prix"]. However, simply because the Respondent has used it at the same time as Mr Steer does not mean that that has caused unfair detriment to Mr Steer. It may well have caused commercial detriment to Mr Steer, but where both Mr Steer and the Complainant have a seemingly equal opportunity to use the name, simply because one party has caused detriment to the other in terms of possibly taking away business, this does not mean such matters should be treated as being unfairly detrimental."

When the Response was drafted, the Respondent had not seen Mr Belton's witness statement in which he confirmed the Complainant's claim to have acquired the goodwill and trading debts of the companies on 31 July 2010

prior to their dissolution the following year. The Respondent casts doubt on the veracity of Mr Belton and contends in any event that nowhere is it asserted that in acquiring the goodwill of the companies, the Complainant acquired the names.

The Panel rejects this view of the matter. From the outset, the Complainant's position has consistently been that he has traded under the names all along - either as a sole trader or through his companies of which he was sole shareholder and a director. The many defects and inconsistencies in the Complainant's evidence stem largely from his failure to distinguish adequately his businesses from those of his companies. From the Complainant's standpoint, "Ontrack Grand Prix" and "Senate Grand Prix" have operated continuously throughout under his management and control. The Panel is satisfied on the balance of probabilities that the sale which took place on 31 July 2010 included transfer of all rights in respect of the names, "Ontrack Grand Prix" and "Senate Grand Prix". It would have been extraordinary if that were not the case.

The Panel has little difficulty in accepting that as at the date of registration of the Domain Names the Complainant had Rights in respect of "Senate Grand Prix". The Panel has rather more difficulty in relation to "Ontrack Grand Prix", but is ready to accept on the balance of probabilities that his Rights in respect of that name existed at that time, albeit that the rights may have been much weaker than his rights in "Senate Grand Prix".

The Respondent accepts that in registering and using the Domain Names it "may well have caused commercial detriment to the [Complainant] in terms of possibly taking away business from the [Complainant]". But the only way the Respondent could have been causing commercial detriment to the Complainant by taking away business from the Complainant was if, contrary to the Respondent's contentions, the Complainant did in fact have a reputation and goodwill in respect of the names "Ontrack Grand Prix" and "Senate Grand Prix". In the view of the Panel the most obvious method by which the Respondent will be taking away business from the Complainant is the diversion to the Respondent's website of customers and potential customers looking for the Complainant's businesses by reference to the names under which the Complainant trades. For those people the names of the Complainant's businesses will have an attractive force giving rise to goodwill in the hands of the Complainant.

The Respondent claims to have commenced use of those names simultaneously with the Complainant, but even if the Complainant had no prior rights, there is no question but that the Complainant has Rights in respect of those names now, and the Respondent's 'use' of the Domain Names can scarcely be regarded as a genuine *bona fide* commercial use of the Complainant's names. The only 'use' of the Domain Names has been to

connect them to its competing Grand Prix Adventures website. It has never traded as either “Ontrack Grand Prix” or “Senate Grand Prix”.

From its position as a participant in the market for the provision of Grand Prix hospitality packages, the Respondent has at all times been well placed to deny the existence of – or its knowledge of the existence of – “Ontrack Grand Prix” and “Senate Grand Prix” in the relevant marketplace. It has not done so. It has simply sought to draw attention to the deficiencies of the Complainant’s evidence and to argue that whatever rights existed prior to February 2011 did not rest with the Complainant.

The Panel concludes that on the balance of probabilities the Respondent was aware of the Complainant’s businesses in February 2011 and consciously chose to register the ‘.co.uk’ equivalents of the Complainant’s ‘.com’ domain names, knowing and intending that it would be diverting business from the Complainant. Were it otherwise, why select those names in preference to others? Seemingly it never had any intention of trading as either “Ontrack Grand Prix” or “Senate Grand Prix”.

The Respondent has now disconnected the Domain Names from its Grand Prix Adventures website, but were it to re-connect them or make any other commercial use of them, as its case claims it is entitled to do, it would in the view of the Panel inevitably cause unfair disruption and damage to the Complainant’s businesses.

For these reasons the Panel is satisfied that each of the Domain Names in the hands of the Respondent is an Abusive Registration.

9. Decision

The Panel affirms the decision of the Expert in relation to the senate domain name and allows the Complainant’s appeal in relation to the ontrack domain name. The Panel directs that the Domain Names, <senategrandprix.co.uk> and <ontrackgrandprix.co.uk> be transferred to the Complainant.

Signed

Tony Willoughby

Ian Lowe

Philip Roberts

Dated: 31 July 2012