

**DISPUTE RESOLUTION SERVICE**

**D00010593**

**Decision of Independent Expert**

Box Clever Projects Ltd

and

Mr Garth Piesse

**1. The Parties**

Complainant: Box Clever Projects Ltd  
136 Tottenham Road  
London  
N1 4DY  
United Kingdom

Respondent: Mr Garth Piesse  
PO Box 181  
Palmerston North  
Manawatu  
4440  
New Zealand

**2. The Domain Name**

workbox.co.uk ("the Disputed Domain Name")

**3. Procedural History**

The Complaint was filed with Nominet on 30 November 2011. Nominet validated the Complaint on the same day and notified the Respondent by post and by email, stating that the Response had to be received on or before 21 December 2011. The Respondent filed a Response on 20 December 2011 and Nominet notified the Complainant that a Reply had to be received on or before 29 December 2011. The Complainant filed a Reply on 29 December 2011.

The Informal Mediation procedure failed to produce an acceptable solution for the parties and so on 30 December 2011 Nominet informed the Complainant that it had until 16 January 2012 to pay the fee for the decision of an Expert pursuant to paragraph 7 of the

Nominet Dispute Resolution Service Policy ("the Policy"). On 16 January 2012 the Complainant paid Nominet the required fee.

On 19 January 2012 the undersigned, Jane Seager ("the Expert"), confirmed to Nominet that she knew of no reason why she could not properly accept the invitation to act as an Expert in this case and further confirmed that she knew of no matters which ought to be drawn to the attention of the parties which might appear to call into question her independence and/or impartiality.

#### **4. Factual Background**

The Complainant is a UK limited company incorporated on 23 September 2009. It does not yet appear to have begun trading and does not have an active website.

On 9 May 2011 the Complainant filed for a UK trade mark in the term WORK BO X in Classes 41 and 43, which was registered on 19 August 2011. The trade mark consists of the word "work" followed by a green box on the upper right hand side which contains the letters BO and X (underneath).

The Complainant has also registered the following domain names:

workbox.co (registered on 26 August 2010)  
workbox.me (registered on 26 August 2010)  
workbox.biz (registered on 2 August 2011)

These domain names are not pointing to any active content.

The Respondent is an individual residing in New Zealand. He registered the Disputed Domain Name on 16 November 2011 when it expired after not being renewed by the former registrant.

The Disputed Domain Name is currently pointing to a website containing sponsored links and the statement *"This domain has recently been listed in the marketplace. Click here to inquire."* The link leads to the website [www.domainnamesales.com](http://www.domainnamesales.com) where it is possible to make an offer to purchase the Disputed Domain Name.

The Complainant attempted to negotiate with the Respondent after its backorder failed and made an initial low offer by email. The Respondent replied saying that he would not sell at that level. The Complainant then raised its offer to US\$400, but this was not accepted by the Respondent.

#### **5. Parties' Contentions**

##### **Complaint**

The Complainant was set up with the sole purpose of developing and launching a new concept for pay-as-you-go meeting and workspaces in the flexible managed office market. Research and development of the business plan took place over approximately one year and in September 2010 the Complainant decided to use the trade name "Workbox".

According to the Complainant, the first time the name "Workbox" was used publicly was

by its financial advisers, Envestors ([www.envestors.co.uk](http://www.envestors.co.uk)), in their quarterly bulletin in Autumn 2010 (attached as evidence). The Complainant's design company, IOR Group, was briefed on the name in October 2010 and used it in their proposals from that time (powerpoint presentation also attached as evidence). At that time the name "Workbox" was included in the Complainant's business plans and other marketing materials, and on employee business cards (copies of such materials attached as evidence).

The Complainant states that at that time it researched the availability of the Disputed Domain Name and discovered that it was registered to Hax Systems Ltd, a company that had been dissolved in 2008. The registration was due to expire on 16 August 2011 and so the Complainant made preparations to buy the Disputed Domain Name when the current registration expired. In the meantime the Complainant purchased <workbox.co>, <workbox.me> and <workbox.biz> (Whois reports attached) and registered the trade mark referred to in the Factual Background section above.

The Complainant asserts that it has continued to use the Workbox trading name throughout the period detailed and it has been introduced to numerous suppliers, as well as potential investors.

Knowing that the Disputed Domain Name would not become available to the public for some weeks after the date of its expiration, one of the Complainant's directors opened a Snapnames account on 10 September 2011 in order to attempt to capture the Disputed Domain Name.

When the Complainant did not hear from Snapnames after the drop date of 16 November 2011, it checked the Whois to discover that the Disputed Domain Name had been registered to the Respondent on that day.

The Complainant states that it believes that the evidence provided demonstrates its rights in respect of the name "Workbox", which is identical to the Disputed Domain Name.

As far as abusive registration is concerned, the Complainant asserts that brief research on Google makes clear that Garth Piesse is a professional domainer (or domain squatter) and that he captures domain names that he considers valuable and then seeks to resell them through [DomainNameSales.com](http://DomainNameSales.com).

According to the Complainant, the Respondent has been in the domain resale business for some time as evidenced by an article in the NZ Herald of August 2004 (attached as evidence). In addition, in March 2005 Garth Piesse made a submission to the NZ Domain Name Commission in relation to dispute resolution processes (also attached as evidence). The Complainant states that the websites [www.informer.com](http://www.informer.com) and [www.websitelooker.com](http://www.websitelooker.com) list a large number of generic domains owned by Garth Piesse.

In the Complainant's opinion, the circumstances indicate that the Respondent has registered or otherwise acquired the Disputed Domain Name primarily *"for the purposes of selling, renting or otherwise transferring the Domain Name to the Complainant or to a competitor of the Complainant, for valuable consideration in excess of the Respondent's documented out-of-pocket costs directly associated with acquiring or using the Domain Name"*.

The Complainant asserts that it believes that the evidence it has supplied demonstrates

that the Respondent is engaged in a pattern of registrations where the Respondent is the registrant of domain names (under .UK or otherwise) which correspond to well known names or trade marks in which the Respondent has no apparent rights, and the Disputed Domain Name is part of that pattern.

The Complainant mentions its unsuccessful attempt to purchase the Disputed Domain Name for US\$400 and states that it also made the Respondent aware of the Complainant's registered trade mark in the UK.

The Complainant states that it can see no reasonable reason why the Respondent would wish to own the Disputed Domain Name since, as far as it can ascertain, all his businesses are domiciled in New Zealand.

The Complainant therefore requests transfer of the Disputed Domain Name.

### **Response**

The Respondent states that he has a company, Coherent Limited, which is a registrar and member of Nominet.

According to the Respondent, he drop caught the Disputed Domain Name on the 16 November 2011 within seconds of it being made available for registration by Nominet. Nominet operates domain registrations under a first come first served policy.

The Respondent states that he did not register the Disputed Domain Name for the purposes of selling, renting or otherwise transferring it to the Complainant or to a competitor of the Complainant.

The Complainant made first contact through the domain name aftermarket website [www.domainnamesales.com](http://www.domainnamesales.com) on 17 November 2011. As the Respondent's sales threshold was not met, the Respondent decided to reject the US\$400 offer.

The Respondent asserts that he did not register the Disputed Domain Name for the purpose of unfairly disrupting the business of the Complainant.

At the time the Disputed Domain Name was registered, the Respondent claimed to be unaware of the Complainant or any rights that it may or may not have.

The Respondent points out that the Complainant's registered trade mark is "work BO X" and underlines that there is a space between the O and X in "BO X". In addition, there are no registered trade marks in New Zealand for "workbox" or "work box".

The Respondent states that he is not using the Disputed 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.

The Respondent asserts that "workbox" or "work box" is a generic or descriptive term and lists the meanings for it found on Google, Wikipedia and an internet dictionary. According to these listings it can be described as "*A portable box used for storing or holding tools and materials for activities such as sewing.*"

The Respondent underlines that under the Nominet Policy it is acceptable to register generic or descriptive domain names, to park and to sell them, and sets out the relevant provisions in relation to these activities.

The Respondent then includes some extracts from various previous decisions under the Policy as follows:

In the Appeal panel decision DRS 03733, the panel stated:

*“The indication on the Respondent’s website that the Respondent was willing to sell the Domain Name for a sum in excess of its registration expenses is of itself of no assistance to the Complainant. Trading in domain names for profit is a well-established business and unexceptionable. To get off first base the Complainant must ordinarily at the very least produce something to show that the Respondent had (or is likely to have had) the Complainant in mind at the relevant time. Even then, that may not be enough in all cases to demonstrate an abusive intent, but it will ordinarily be an essential pre-requisite.”*

In the Dispute decision DRS 04331, the expert stated:

*“I am not convinced the Complainant’s reputation is leveraged by the PPC use. Further, PPC and affiliate revenue earning are not of themselves abusive practices; rather the determining factors are motive at registration and in use. See DRS 03733 Mercer. The findings on motive at registration are dealt with above and there is no evidence to suggest the Respondent is leveraging the Complainant’s goodwill or reputation and I am not prepared to assume it.”*

In the Dispute decision DRS 00359, the expert stated:

*“(Paragraph 3 a i A reads as follows: Circumstances indicating that the Respondent has registered or otherwise acquired the Domain Name: A. primarily for the purposes of selling, renting or otherwise transferring the Domain Name to the Complainant or to a competitor of the Complainant, for valuable consideration in excess of the Respondent’s documented out-of-pocket costs directly associated with acquiring or using the Domain Name;”)*

*“The Respondent operates a web-site offering domain names for sale. There is nothing inherently wrong with that. The question is did the Respondent register the Domain Names for the purposes of selling them to the Complainant or one of its competitors for more than the cost of acquiring or using them. It is not disputed that the Respondent offered to sell the Domain Names to the Complainant for a substantial sum when the Complainant challenged the Respondent. However, there are probably many people or businesses, other than competitors of the Complainant, who might be interested in acquiring the Domain Names for perfectly legitimate reasons, which would not infringe the Complainant’s rights. On the evidence before him, the Expert cannot conclude that the requirements of Paragraph 3 a i A are satisfied in this case.”*

*“In the context of the disputed Domain Names, the Expert therefore considers that the term “Parma ham” is indeed generic. In view of the comments already made by the Expert above, the Expert is also satisfied that the Respondent is making fair use of the Domain Names on its web-site as registering generic terms with a view to selling them for a market value is perfectly fair.”*

The Respondent therefore requests that transfer of the Disputed Domain Name be denied.

### **Reply**

The Complainant asserts that any domain name reseller who drop catches a domain name such as the Disputed Domain Name must only be doing so for the purposes of selling, renting or otherwise transferring it, otherwise what would be the purpose of his/her business? Furthermore, the only likely purchasers are businesses trading with that domain name or competitors of said business. In the Complainant's opinion, for the Respondent to suggest that he did not register the Disputed Domain Name for the purpose of selling it to the Complainant or a competitor does not follow logically, given that the Respondent is in the business of domain name reselling.

In the Complainant's opinion it is inevitable that any domain name reseller who drop catches a domain name which is identical to the trading name of an existing business is going to disrupt the business of that existing business. In the Complainant's view this is, in and of itself, an unfair practice.

The Complainant states that trade marks in the UK protect the whole of the text and image as one item, howsoever structured, and it is clear from the image protected at the UK's Intellectual Property Office that WORKBOX is the protected trade mark (as previously evidenced by the Complainant).

According to the Complainant, it is not relevant that the "workbox" trade mark is not registered in New Zealand as the Complainant is seeking to secure a domain name under .CO.UK and not under .NZ.

In the Complainant's opinion, whilst, at the present time, the Respondent is not using the Disputed Domain Name in a way which may confuse people or businesses that it is registered to the Complainant, as the Respondent is a domain name reseller it is most likely that any purchaser (other than the Complainant) will cause said confusion amongst customers for the Complainant's products and services.

The Complainant asserts that to suggest that the Respondent does not have the Complainant in mind (whether personally or any similarly named business) when registering a domain name for the purpose of reselling it does not follow logically from the fact that the Respondent is in the business of domain name reselling - otherwise who is going to purchase the domain names that the Respondent parks?

## **6. Discussions and Findings**

### **General**

Under paragraph 2(a) of the Policy, for the Expert to order a transfer of the Disputed Domain Name the Complainant is required to demonstrate, on the balance of probabilities, both of the following elements:

- "(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."*

### **Complainant's Rights**

The Complainant has demonstrated that it holds a UK trade mark in the term WORKBOX (the fact that the trade mark is semi figurative and that there is a space between BO and X is not material given all the surrounding circumstances). The Expert is therefore satisfied that the Complainant has Rights in this term under the Policy (which defines Rights as including, but not limited to, rights enforceable under English law).

Furthermore, the Policy stipulates that the name or mark in which the Complainant has Rights (WORKBOX) must be identical or similar to the Disputed Domain Name (workbox.co.uk). It is accepted practice under the Policy to discount the ".co.uk" suffix, and so the Complainant's mark and the Disputed Domain Name are thus identical to one another.

As a result, the Expert finds that paragraph 2(a)(i) of the Policy is satisfied and the Complainant has Rights in respect of a mark which is identical or similar to the Disputed Domain Name.

### **Abusive Registration**

Moving on to paragraph 2(a)(ii) of the Policy, "Abusive Registration" is defined in paragraph 1 of the Policy to mean a domain name which:

- "(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."*

In the Expert's opinion the Complainant has not succeeded in proving limb (i) above. The Respondent asserts that when he acquired the Disputed Domain Name he was not aware of the Complainant or its Rights and, in view of all the surrounding circumstances, the Expert is prepared to accept that. In particular, the Complainant does not appear to have started trading at the time when the Disputed Domain Name was registered, did not have an active website and only had a trade mark valid in the UK. Given that the Respondent is resident in New Zealand, there is no reason for the Respondent to have been aware of the Complainant at the time he registered the Disputed Domain Name. The items that the Complainant attaches in evidence (such as the investor bulletin) do not assist the Complainant in this regard, as it is extremely unlikely that the Respondent would have seen them.

In the Expert's view, the Respondent's lack of knowledge of the Complainant and/or its Rights at the time of registration of the Disputed Domain Name is quite simply fatal to a successful finding under limb (i) (and in this regard the Expert agrees with the reasoning of the Appeal Panel in *Verbatim Ltd v Michael Toth*, DRS 04331).

Turning to limb (ii) of the definition of Abusive Registration and the Respondent's subsequent use of the Domain Name, the Expert also finds that the Complainant has not succeeded in proving this. The Respondent has been using the Disputed Domain Name to point towards a website providing sponsored links and also offering it for sale. As the

Respondent points out, such activities are not necessarily prohibited under the Policy. Paragraphs 4(d) and (e) of the Policy read as follows:

- "(d) *Trading in domain names for profit, and holding a large portfolio of domain names, are of themselves lawful activities. The Expert will review each case on its merits.*
- (e) *Sale of traffic (i.e. connecting domain names to parking pages and earning click-per-view revenue) is not of itself objectionable under the Policy. However, the Expert will take into account:*
  - (i) *the nature of the Domain Name;*
  - (ii) *the nature of the advertising links on any parking page associated with the Domain Name; and*
  - (iii) *that the use of the Domain Name is ultimately the Respondent's responsibility."*

In this regard it is important to note that the nature of the Disputed Domain Name is key. The Respondent asserts that the Disputed Domain Name is a generic or descriptive term and the Expert would agree, not only that the term WORKBOX is generic, but that the Respondent is using, and intends to use, such term in its generic sense. Nothing would suggest that the Respondent is specifically targeting the Complainant in an effort to take unfair advantage of (or be unfairly detrimental to) the Complainant's Rights, as required by the Policy. As a result, the Respondent's use cannot be said to be abusive.

For the sake of completeness, it should be noted that a list of five factors which may be evidence that the Disputed Domain Name is an Abusive Registration is set out at paragraph 3(a) of the Policy. The Complainant argues that factor 3(a)(i)(A) is satisfied, namely:

- "(i) *Circumstances indicating that the Respondent has registered or otherwise acquired the Domain Name primarily:*
  - (A) *for the purposes of selling, renting or otherwise transferring the Domain Name to the Complainant or to a competitor of the Complainant, for valuable consideration in excess of the Respondent's documented out-of-pocket costs directly associated with acquiring or using the Domain Name."*

It may well be that the Respondent acquired the Disputed Domain Name primarily for the purposes of selling it, but, given that he was unaware of the Complainant at the time of registration, it is difficult to see how this could have been to the Complainant or to a competitor of the Complainant. The Expert is of the opinion that the Respondent acquired the Disputed Domain Name to sell it to anyone who offered him the right price, and not specifically to the Complainant or to another company operating in the same field as the Complainant (namely one of the Complainant's competitors). Thus factor 3(a)(i)(A) is not found.

In addition, the Complainant argues that factor (3)(a)(iii) is satisfied, as follows:

- "(iii) *The Complainant can demonstrate that the Respondent is engaged in a pattern of registrations where the Respondent is the registrant of domain names (under*



*.uk or otherwise) which correspond to well known names or trade marks in which the Respondent has no apparent rights, and the Domain Name is part of that pattern."*

However, no evidence has been supplied to show that the Respondent is the registrant of domain names that correspond to well known trade marks, only generic names. Thus factor 3(a)(iii) is not found. The Expert has also reviewed the additional factors listed at paragraph 3(a) of the Policy and finds that none of them have been satisfied.

Furthermore, a list of five factors which may be evidence that the Disputed Domain Name is not an Abusive Registration is set out at paragraph 4(a) of the Policy, and the Expert finds that paragraph 4(a)(ii) is of assistance to the Respondent, as follows:

*"(ii) The Domain Name is generic or descriptive and the Respondent is making fair use of it."*

In conclusion, the Expert has considered the admissibility, relevance, materiality and weight of the evidence as a whole and is not satisfied that the Complainant has succeeded in proving, on balance of probabilities, that the Domain Name is an Abusive Registration in accordance with paragraph 2(a)(ii) of the Policy.

### **Reverse Domain Name Hijacking**

Reverse Domain Name Hijacking is defined under paragraph 1 of the Nominet Dispute Resolution Service Procedure as use of the Policy in bad faith in an attempt to deprive a registered domain name holder of a domain name.

However, the Expert does not believe that the Complainant necessarily acted in bad faith in bringing the Complaint, given the nature of its submissions (although given the Complainant's filing of a Complaint only after a failed attempt to buy the Disputed Domain Name for a low price, this could be disputed).

The Complainant appears not to have received any legal advice and seems to honestly believe that offering a domain name for sale when another third party just happens to have trade mark rights in that particular term is wrong, and this is the case in and of itself without any further analysis pertaining to the nature of the domain name and the trade mark rights at issue. Clearly this cannot be correct as, if so, it would be possible to attack virtually any domain name on the sole basis that a trade mark had been registered corresponding to that particular domain name, whether or not the registrant in question was aware of that.

Indeed, a very brief search on the UK trade mark register would indicate that the Complainant is not the only owner of a trade mark in the term WORKBOX, and an cursory internet search would indicate that it is a popular trading name, both in the UK and abroad, used in many different fields. Thus it would not be appropriate for the Expert to order transfer of the Disputed Domain Name to the Complainant over and above any other third party who may have reason to want it, given that the Respondent has not been found to have specifically targeted the Complainant and to have abused the Complainant's Rights in particular.

However, the Expert does not believe that the Complainant was aware of this and so Reverse Domain Name Hijacking is therefore not found.

## **7. Decision**

The Expert finds that the Complainant has Rights in a name which is identical to the Domain Name, but is not satisfied that the Domain Name, in the hands of the Respondent, is an Abusive Registration. No action should therefore be taken in relation to the Domain Name. The Expert declines to make a finding of Reverse Domain Name Hijacking against the Complainant.

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Jane Seager  
7 February 2012