

**DISPUTE RESOLUTION SERVICE**

**D00010999**

**Decision of Independent Expert**

**DAPA**

and

**DAPA Productions Ltd**

**1. The Parties:**

Lead Complainant: DAPA  
The Wharf Studios, Eanam Wharf  
Blackburn  
Lancashire  
BB1 5BY  
United Kingdom

Respondent: DAPA Productions Ltd  
122 Caraway Apt, Cayenne Court, Curlew St  
London  
SE1 2PP  
United Kingdom

**2. The Domain Name(s):**

dapa.co.uk

**3. Procedural History:**

01 March 2012 16:42 Dispute received  
02 March 2012 07:48 Complaint validated  
02 March 2012 07:53 Notification of complaint sent to parties  
26 March 2012 08:03 Response received

26 March 2012 08:04 Notification of response sent to parties  
29 March 2012 13:47 Reply received  
29 March 2012 13:50 Notification of reply sent to parties  
29 March 2012 13:50 Mediator appointed  
03 April 2012 09:56 Mediation started  
19 April 2012 15:21 Mediation failed  
19 April 2012 15:22 Close of mediation documents sent  
25 April 2012 11:39 Expert decision payment received

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

The Complainant is identified as 'DAPA', and was founded in August 1993. I understand it to be a business run by Mr Graham Vernon and his wife. The word DAPA is an acronym for 'dance and performing arts', and the Complainant runs academies providing tuition therein. It is a national accredited examination centre for professional examinations, a registered children's university learning destination, recognised by the Council for dance education and training and an advice centre for governing bodies relating to child protection and child welfare.

Mr Vernon is the registered proprietor of several trade marks, including No 2351729 for a logo incorporating the word 'DAPA' in class 41 and registered in December 2003. This mark has a restriction, such that it does not apply in Surrey, East Sussex, West Sussex or Kent. This is because of rights that were formerly held by an unrelated third party, Dorking Academy of Performing Arts. Mr Vernon is also the registered proprietor of mark No 2580936 registered in May 2011 for the word 'DAPA' and also mark No 2549503 registered in June 2010 for the same logo as referred to above, both in Class 41 and neither with any geographical restriction.

The Respondent was incorporated in January 2008. It and/or related entities have traded as 'Deal Academy of Performing Arts' since 1998, providing dance classes in the town of Deal in East Kent, and have since 2001, or earlier, been known by the acronym 'DAPA'. Related entities are DAPA (Deal) Limited, DAPA Canterbury Limited, Dover Academy of Performing Arts Ltd, and Mr Kevin Wood the secretary of the Respondent who initially traded as a sole trader.

The Respondent registered the Domain Name in October 2009.

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

The Complainant asserts that it has Rights in the Domain Name and relies upon its registered trade marks and the length of its use of the name DAPA. It claims that the registration and/or use of the Domain Name is an Abusive Registration because:-

- (i) The Respondent has no right or earlier right to use the name 'DAPA' and their use is misinforming the public that the Respondent is connected to the Complainant.
- (ii) The use by the Respondent is having a detrimental effect on the Complainant, because the Respondent does not have adequate qualifications to teach children.
- (iii) The Respondent use of the Domain Name is causing it to be confused with the Complainant.

In response to these contentions the Respondent asserts that:-

- (i) The Respondent's use of the Domain Name is legitimate and has not been registered for the purpose of disrupting the Complainant's business.
- (ii) The Respondent has been commonly known as 'DAPA' in the East Kent area since 1998.
- (iii) Some of the rights relied upon by the Complainant post date the registration of the Domain Name by the Respondent;
- (iv) The only registration which pre-dates the registration, specifically excludes the geographical location(s) in which the Respondent is active;
- (v) The Complainant's marks are invalid.

## 6. Discussions and Findings

### General

To succeed in this Complaint, the Complainant must, in accordance with paragraph 2 of the Dispute Resolution Policy (the "Policy"), prove to the Expert on the balance of probabilities that:

- (i) it has Rights (as defined in paragraph 1 of the Policy) in respect of a name or mark identical or similar to the Disputed Domain Name; and
- (ii) the Disputed Domain Name in the hands of the Respondent is an Abusive Registration (as defined in paragraph 1 of the Policy).

The Complainant must make out its case to the Expert on the balance of probabilities.

### Complainant's Rights

The Policy defines Rights as follows –

***"Rights means rights enforceable by the Complainant, whether under English law or otherwise, and may include rights in descriptive terms which have acquired secondary meaning."***

In my view the existence of the registered trade marks owned by the Complainant and the historical use of the name 'DAPA' by the Complainant would be such as to give rise to goodwill, and together qualify the Complainant as having 'Rights' under the Policy. The fact that the Complainant's trade mark No 2351729 for a logo incorporating the word 'DAPA' is subject to a geographic restriction does not alter this assessment, although it may be a relevant consideration when determining whether the registration of the Domain Name was Abusive.

The Policy requires such Rights to be in a name or mark identical or similar to the Domain Name. For the purpose of analysing whether the Domain Name is identical or similar to the name or mark in which rights are claimed, one may ignore the .co.uk suffix. The comparison is therefore between 'DAPA' on the one hand, and 'DAPA' on the other. I conclude that the Complainant has established that it has Rights in a name or mark identical to the Domain Name.

#### Abusive Registration

I now go on to consider whether the Domain Name is an Abusive Registration as defined in the Policy.

The Complainant asserts that the registration of the Domain Name is an Abusive Registration for the reasons identified above. The Policy defines an 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"*

and goes on to set out a (non-exhaustive) list of factors which may be evidence that a domain name is an Abusive Registration.

In most circumstances where a Respondent has registered a domain name that is identical or similar to a name or mark in which the Complainant has rights, and the Complainant's name or mark was known to the Respondent, one would be unlikely to have a great deal of difficulty in concluding, as many Experts have previously, that the relevant domain name would be an abusive registration.

However, in the current dispute the Respondent alleges that it has been legitimately using the name 'DAPA' for an extensive period of time and has, for the purposes of these proceedings a legitimate right to use the disputed domain name. The Policy provides at paragraph 4a, that the registration/use of a domain name might not be Abusive where:-

*“i. Before being aware of the Complainant's cause for complaint (not necessarily the 'complaint' under the DRS), the Respondent has:*

*A. used or made demonstrable preparations to use the Domain Name or a domain name which is similar to the Domain Name in connection with a genuine offering of goods or services;*

*B. been commonly known by the name or legitimately connected with a mark which is identical or similar to the Domain Name;*

*C. made legitimate non-commercial or fair use of the Domain Name”;*

In light of the evidence provided to me by the Respondent in respect of the use that it, or its affiliated businesses have made of the name 'DAPA', I conclude that its registration and use of the Domain Name falls squarely within all of the criteria identified in paragraphs A-C above and find that the Respondent's conduct has not taken unfair advantage of or been unfairly detrimental to the Complainant's Rights.. In that respect, I am mindful that the registered trade mark relied upon by the Complainant and which predates the registration of the Domain Name specifically carves out the geographical area in which the Respondent operates, and further there is certainly not enough information presented to me by the Complainant for me to be able to determine whether it could lawfully prevent the Respondent from conducting its business based on any other cause of action, for example passing off.

I make no further comment in respect of the Complainant's causes of action, save to say that I agree with the Complainant that “this is a complicated situation” and the proper forum for determining the causes of action to which the Complainant has alluded is not the DRS.

## **7. Decision**

For the reasons set out above, I find that the Complainant does have Rights in respect of a name or mark which is identical to the Domain Name <dapa.co.uk>, however I find that the Domain Name in the hands of the Respondent is not an Abusive Registration. The Complaint therefore fails.

There should be no action taken in respect of the disputed Domain Name.

**Signed: Simon Chapman**

**Dated: 18<sup>th</sup> May 2012**