

DISPUTE RESOLUTION SERVICE

DRS11021

Decision of Independent Expert

Parent Teacher Associations UK

and

Community Inspired Ltd

1. The Parties:

Complainant: Parent Teacher Associations UK
39 Shipbourne Road
Tonbridge
Kent
TN10 3DS
United Kingdom

Respondent: Community Inspired Ltd
Stag House
23-27 London Road
East Grinstead
West Sussex
RH19 1AL
United Kingdom

2. The Domain Name: pta.co.uk

3. Procedural History:

08 March 2012 15:50 Dispute received
09 March 2012 11:22 Complaint validated
09 March 2012 11:24 Notification of complaint sent to parties
02 April 2012 15:38 Response received
02 April 2012 15:38 Notification of response sent to parties

05 April 2012 08:19 Reply received
05 April 2012 08:33 Notification of reply sent to parties
05 April 2012 08:34 Mediator appointed
12 April 2012 10:03 Mediation started
30 April 2012 14:16 Mediation failed
30 April 2012 14:17 Close of mediation documents sent
02 May 2012 15:56 Expert decision payment received

After certifying that he was independent of the Parties and knew of no reason why he could not accept the appointment, the undersigned, Peter Davies was appointed to provide a full decision in this Complaint on 10 May, 2012.

4. Factual Background

The Complainant is a charity supporting parent teacher organisations. The Respondent is a company formerly working in association with the Complainant to provide online services to the Complainant's members. The Parties are currently in dispute concerning other aspects of their collaboration and have established separate web presences. The Domain Name was registered on 12 January 1998 and acquired by the Respondent on 24 February, 2012. It currently resolves to the Respondent's website, offering services formerly available on the site operated jointly by the Parties.

5. Parties' Contentions

The Parties' submissions are summarised by the Expert as follows:

Complainant

The Complainant is a national charity and membership organisation for parent teacher associations. Founded as the National Federation of Parent Teacher Associations, it subsequently became the National Confederation of Parent Teacher Associations of England and Wales (NCPTA). It was renamed Parent Teacher Associations UK on 10 August 2011. The Complainant is a company limited by guarantee (3680271) and a registered charity (1072833). It currently has 13,750 members (75 % of the known market) and a 95 % membership retention rate. Member surveys demonstrate it is well regarded and valued. It is also known and respected by a range of educational stakeholders including the Department of Education, without whose support Companies House regulations would have prevented the Complainant from registering the National Confederation of Parent Teacher Associations as a company limited by guarantee in 1998 and more recently Parent Teacher Associations UK in 2011. Both of these names include protected words which cannot be used without proof of national pre-eminence. This proof was provided by the Department of Education.

Complainant's Rights

The Complainant is the owner of a number of UK trademarks including

PTA-UK 2591781 registered as of 25 November, 2011 and
PTA 2591782 registered as of .23 December, 2011

The Complainant under its current name and older NCPTA name has distributed a members' magazine called PTA since the spring of 2002.

Until its change of name, The Complainant used the domain name <ncpta.org.uk>. Following the change of name it switched to the domain name <pta.org.uk>. The Complainant is well recognised both by its name and mark. A Google search for “pta” provides the Complainant’s old and new domain names as first and second in the search results.

The PTA logo has been in use since 2002. More recent use is included in supporting evidence, together with use of the Complainant’s logo and website.

Abusive Registration

The Parties began working together in late 2008 and signed heads of agreement on 1 September 2010. In October 2011 they set up a joint website at <pta.org.uk>. The Respondent accepted that this domain name was owned by the Complainant but a dispute arose between the Parties concerning authorship of the website’s content and the intellectual property rights associated with this content. After unsuccessful discussions between the Parties, the Complainant sought advice from solicitors, who wrote to the Respondent on 23 February 2012.

As a result of this dispute, the Parties set up separate web presences in late February 2012. The Complainant’s site remained at <pta.org.uk>. The Respondent is believed to have acquired the Domain Name at this time. Because of the recent purchase of the Domain Name, it has not been possible to contact the Respondent to resolve the Domain Name issue because of the ongoing commercial dispute.

The Domain Name is an Abusive Registration under Section 3 of the Policy, as it is being used for the purpose of unfairly disrupting the Complainant’s business by offering competing services to those of the Complainant.

The Domain Name is being used in a way that is likely to confuse people into believing that it is operated or authorised by or otherwise connected to the Complainant. The Complainant has records of members and suppliers calling its advice line seeking clarification as to which website pertains to the Complainant.

With reference to Section 4 a i B of the Policy, the Respondent formerly operated under the name of “PTALocal” with the domain name <ptalocal.co.uk>. Since the breakdown of the relationship, the Respondent has used the Domain Name instead of <ptalocal.co.uk>, traffic from which is now directed to the Domain Name. The Respondent’s use of the logo PTA+ connected with the Domain Name also coincides with the breakdown in the relationship between the Parties.

Respondent

The Domain Name is not an Abusive Registration. The Complainant is using the DRS in bad faith, has no valid grounds for Complaint and wants to harass the Respondent and disrupt its business. The Complainant has provided an incomplete and misleading picture of the situation.

The Complainant alleges that the Domain Name was purchased and used by the Respondent for the purpose of unfairly disrupting the business of the Complainant and that it is being used in a way which is likely to confuse people into believing that it is operated or authorised by or otherwise connected to the Complainant. However solicitors for the Complainant wrote that it is the suffix <.co.uk> in conjunction with PTA that may cause confusion.

The Respondent believes that the Complainant is using the Complaint to reach a better settlement in the legal dispute between the Parties. This can be demonstrated by the letter from the Complainant's solicitor answering the Respondent's request to withdraw the Complaint, which suggests that they "may be willing to consider withdrawing the objection as a part of any wider settlement". These are not the actions of an organisation that genuinely believes that the Domain Name is associated with it. There is no accusation in this letter that the Respondent is trying to confuse anyone or pass itself off as the Complainant. The sole objection relates to the suffix <.co.uk> which the Complainant believes may confuse users. This is risible as virtually everyone with Internet access understands that .co.uk is a suffix. The Complainant also acknowledges in this letter that the Domain Name is generic.

The Complainant says that it has records of calls to its advice line, to find out which website pertains to the Complainant, but they have not supplied the evidence. The Complainant submits an account of a call from a PTA which provides no evidence that the Respondent is claiming to be associated with the Complainant or trying to gain an unfair advantage. The caller simply couldn't find some information on the site. The Complainant explained the situation and the caller found it confusing. The Complainant did not say that this information used to be available through the PTA+ login on <pta.org.uk> but was removed by the Complainant. Thus the Complainant caused the confusion, not the Respondent. The Complainant promoted the Respondent's services as member benefits for 2012. These were previously available via the PTA+ link on <pta.org.uk>. The Complainant removed these services from <pta.org.uk> without notice and without directing PTAs to the new website provided by the Respondent. Both Parties have now advised PTAs of the situation and the confusion created by the Complainant should be cleared up.

The second piece of evidence the Complainant has put forward is an email from the Respondent giving the new location of the services it provides. The Respondent has not tried to confuse people or purport to be the Complainant. PTAs were looking for access to the PTA+ services and the documents they had uploaded to the file storage system which was part of the service. The Complainant had promoted these services as part of 2012 membership and then removed them without notice. It must be acceptable for the Respondent to advise PTAs where these services could be found.

The business relationship between the Parties began in 2005 (not 2008 as stated by the Complainant) and the Respondent's "PTA local" service was introduced in 2008. The development of "PTA local" was made with the knowledge and support of the Complainant. The Respondent worked closely with, but independently of the Complainant launching "PTAlocal" in its magazine and online via <ptalocal.co.uk> in 2009. This highlights the Respondent's prior use of the term PTA for its services.

Over the past 4 years the Respondent has expanded its range of services for PTAs. The Complainant acknowledges that Respondent is the 'dominant PTA network provider'. The Complainant also acknowledges that the Respondent is the owner and provider of 13 different PTA services. These services included PTA Hot, PTA Perks, PTA Planner, PTA Web Provision, PTA Email and PTA Network. Again this provides evidence of prior use of the PTA name.

In 2010 the Parties signed heads of agreement to work together. In March 2011 the Respondent reported that <ptalocal.org.uk> was the most frequented PTA website in the UK. The Parties agreed to formalise their agreement and set up a joint website. This was to be a copy of <ptalocal.co.uk> under a new domain name <pta.org.uk>. Extra information was to be added from the Complainant's <ncpta.org.uk>. It was acknowledged that the Respondent would own the IPR to the site and would be

responsible for the development of products and services. The plan was to form a jointly owned company, with <pta.org.uk> as its website.

At this time the Complainant, then operating as NCPTA, used different corporate branding. It did not use the PTA element that the Respondent was using for PTALocal, PTA Hot, PTA Planner etc. Indeed the Complainant has used many branding variations in the past. The Complainant says that “We are very definitely recognised both by our name and our mark” but provides no proof of this. The Complainant’s new brand has only recently been launched but would be more widely associated with the Respondent, which used the ‘PTA’ element on the old PTALocal site and for its other services.

The only evidence provided by the Complainant of the popularity of their mark and name relates to a Google search. This shows an old cached version of <pta.org.uk> which used the site that the Respondent developed. This can be proved by the references to PTA Hot, My Donate and Days Out in the meta description. An up-to-date Google search shows the Domain Name above <pta.org.uk>. In fact on Google.com the Domain Name appears on page 1 and <pta.org.uk> appears on page 3. It must also be noted that a position in a search engine does not prove that the mark and name are well recognised.

The Respondent was instrumental in the development of the new mark incorporating the branding that the Respondent had been using for its services but with the added “-UK”. There is no mention by the Complainant of applying for a trademark for ‘PTA’ on its own. The Respondent intends to object to both trademark registrations on the grounds of prior use and creative input.

When the Respondent moved PTALocal to <pta.org.uk> there were over 6,000 PTAs using the Respondent’s services and accessing their files. The Complainant asked the Respondent to drop the PTALocal brand and offer all its services under a “PTA” brand such as PTA+, PTA Perks and PTA Planner.

The transfer of services from <PTALocal.co.uk> and <ncpta.org.uk> to <pta.org.uk> was well publicised. The Complainant sold membership to over 13,000 PTAs from Oct 2011 onwards with the Respondent’s services as an entitlement of membership. 13,500+ PTAs have renewed their membership and expect to get the services that were previously available on <ptalocal.co.uk> and latterly on <pta.org.uk>. The Complainant has now removed these services.

In February 2012 following meetings between the Parties the Complainant consulted solicitors but did not tell the Respondent that they were withdrawing from the heads of agreement. On 23 February the Respondent received a letter from the Complainant’s solicitors requiring removal of references to the Complainant and its marks from the Domain Name website. The Respondent complied but the Complainant removed the Respondent’s access to <pta.org.uk> and took control of the nameservers. The Complainant placed a holding page on <pta.org.uk> and withdrew access to all member services. The Respondent temporarily placed the services on <ptaplus.co.uk> before reverting to the Domain Name.

The Respondent asked the Complainant on several occasions to agree a joint statement to ensure PTAs knew how to access services previously available on <pta.org.uk>. The Complainant ignored all requests and sent several emails without providing information on the whereabouts of the services that members had paid for. This caused confusion which the Complainant could have avoided.

The Respondent made every effort to ensure PTAs could gain access to all services. The Domain Name home page makes clear that the Complainant can be located elsewhere and a contact number is provided. This proves that the Respondent has tried to avoid

confusion and is not trying to pass the Domain Name off as being relating to the Complainant.

The Complainant has admitted that “PTA” is a generic term and it is not complaining about the Respondent’s use of the name, which it has done for many years. The Respondent withdrew the brand ‘PTAlocal’ at the Complainant’s request and is now working under the generic term “PTA” to provide PTAs with a range of services. The Domain Name is the most appropriate one for hosting its PTA services, including PTA+, PTA Hot, PTA Planner, PTA Email, PTA Network and PTA Perks.

The Respondent registered <pta-uk.org.uk>, <ptauk.org.uk> and the Domain Name with the Complainant’s knowledge and consent. An administrative error meant they were registered under the Respondent’s name, trading as PTA-UK, but the Respondent has offered to transfer them to the Complainant. A request has been sent to the Complainant, using the Nominet domain transfer service, to accept the transfer of all three domains but this request has not been accepted.

Referring to paragraph 4a I B of the Policy in relation to <ptalocal.co.uk>, the Complainant omits to say that the Respondent had to remove all “PTAlocal” branding when moving to <pta.org.uk>. The Complainant is aware that “PTAlocal” could no longer be used, but cites its non-use by the Respondent as evidence of the Respondent’s bad faith. Similarly the Complainant knows that the Respondent adopted PTA+ as one of its services, as the Complainant publicised it as a member benefit. A new logo was needed because of the Complainant’s solicitor’s letter and the Complainant’s refusal to allow the Respondent to use the mark.

Complainant’s Reply

The Domain Name is an abusive registration and continues to cause confusion. Further examples of such confusion have been received since the submission of the Complaint. This contradicts the Respondent’s claim that emails have been sent removing the confusion. Emails sent by the Respondent referred to in the Complaint are examples of deliberate action to cause confusion.

The claim that the DRS is being used to reach a better settlement of the commercial dispute is untrue; the two issues are separate. Much of the Response attempts to divert attention from the Abusive Registration by airing points which are part of the wider dispute.

The core of the abuse is the purchase of the Domain Name to cause confusion at the time the Parties ceased their partnership. We note mention of the suffix <.co.uk>; however the fact is being overlooked that the Domain Name is likely to confuse people in view of its overall similarity to pta.org.uk - it is a flagrant attempt to draw traffic to the Respondent’s site.

The references to the relative Google rankings in the Response provide evidence that the registration of the Domain Name is beginning to generate the abuse that the Complainant alleges.

The Respondent claims to have been using the term PTA for 3-4 years. This pales into insignificance against the Complainant’s use of the term PTA for over 55 years. The assertion of the Respondent’s 6,000 registrations also pales into insignificance against the some 30,000 held by PTA-UK.

Why, when the Parties separated, did the Respondent not use <ptalocal.co.uk> or <ptaplus.co.uk> which were already, and still are, in its possession? The Respondent's purchase and use of the Domain Name were part of a deliberate tactic to confuse.

The Respondent annexes to its Response homepages of <pta.org.uk> and the Domain Name and claims that there is no attempt by to confuse users. The screen grab of the Domain Name website only shows part of the PTA Magazine which, had the full image been represented, would show that this is the official magazine of PTA-UK. This is confusion and not an example that no such confusion exists.

6. Discussions and Findings

Introduction

The DRS Policy defines the limits within which the Expert may adjudicate, in terms of the subject matter of the dispute and the acts and omissions of the Parties. In this case, the Parties' collaboration has come to an acrimonious end and they have gone their separate ways. In the course of this breakdown, the Respondent acquired the Domain Name. A great deal of information was submitted about the business relationship and its collapse, almost all of which is outside the scope of this Complaint. The Expert makes no findings concerning the legal dispute. More relevant to this Dispute, but equally beyond the Expert's remit, is the validity or otherwise of the Complainant's trademarks, one of which repeats exactly the substantive portion of the Domain Name. The Expert similarly makes no finding in this matter. Finally, the Response included reference to a document which the Complainant asserts to be confidential and improperly put into evidence by the Respondent. The Expert takes no view as to the confidentiality of this document, but believes that the Complaint can be decided fairly without reference to this material and makes no allusion to it.

Complainant's Rights

For the Complainant to succeed, it must satisfy the two stage test in paragraph 2 of the Policy: the Complainant must prove on the balance of probabilities that

- 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.*

The test for deciding whether a complainant has rights in a name or mark under the DRS is not intended to be strenuous. The Complainant has provided evidence of a UK trademark registration in the acronym PTA, and of a history of activity concerned with parent-teacher associations, involving the use of PTA as part of the various "trading" names it has adopted in the course of its existence. There is thus a registered right in a name which is identical to the Domain Name, along with the possibility of unregistered rights. Although some of what follows may suggest that these Rights are open to question, the Expert believes that the Complainant's trademark registration for "PTA" is sufficient to meet the Rights test, to the extent necessary for this Complaint.

Abusive Registration

Paragraph 1 of the DRS 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 has taken unfair advantage or has been unfairly detrimental to the Complainant's Rights;*

Paragraph 3 of the Policy sets out a non-exhaustive list of factors which may be evidence that a domain name is an Abusive Registration, including

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;

B. as a blocking registration against a name or mark in which the Complainant has Rights; or

C. for the purpose of unfairly disrupting the business of the Complainant;

ii. Circumstances indicating that the Respondent is using the Domain Name in a way which has confused people or businesses into believing that the Domain Name is registered to, operated or authorised by, or otherwise connected with the Complainant;

The Complainant alleges that the Respondent bought the Domain Name at a point close in time to the breakdown in the Parties' relationship, with an intention of unfairly disrupting the Complainant's business. Following a request from the Expert pursuant to Paragraph 13 of the DRS Procedure, the date of acquisition of the Domain Name by the Respondent was found to be 24 February 2012. This date accords with the Complainant's supposition as to timing, but of course says nothing about the Respondent's motives for buying the Domain Name. In many DRS cases, such timing might support an inference that a respondent intended to act unfairly and to a complainant's detriment. In the present case, the issue is less clear. The Respondent has been associated, via its collaboration with the Complainant, with a brand "PTAPlus". Under this brand, it was recognised as a provider of services to the Complainant's membership "in association with" (as the jointly-owned website described it) the Complainant. In its submission, the Complainant cites Paragraph 4 a i B of the Policy in describing the Respondent's incorporation of the term "PTA" in its operations and earlier domain name. This paragraph says that a Registration may not be Abusive where a respondent can show that it

"has been commonly known by the name or legitimately connected with a mark which is identical or similar to the Domain Name"

In reality, this may help the Respondent, who appears to have other business interests contiguous with the services it provided to the Complainant's members and therefore a possible valid interest in acquiring the Domain Name if it is available and if the acquisition does not otherwise fall foul of the DRS Policy. In this light, the Expert does not feel able to accept the view that the Respondent bought the Domain Name to disrupt the Complainant's business or infringe its Rights. The registration of the Domain Name does

not therefore fall under the first part of the definition of Abusive Registration in Paragraph 1 of the Policy.

The second part of the definition concerns the subsequent use of the Domain Name, and whether or not this is unfair to the Complainant or detrimental to its Rights. The Complainant relies upon Paragraph 3 a C ii of the Policy, covering actual or potential confusion between the Complainant's name and the Domain Name in the Respondent's hands. The Complainant's concerns are however expressed in a way that does not sit easily within a conventional analysis under the DRS Policy. The March 26 letter from the Complainant's solicitors to the Respondent states that the Complainant is not troubled by the substantive portion of the Domain Name, but rather by the suffix <.co.uk>. This is liable, says the Complainant, to make the Domain Name as a whole [emphasis added] confusing, when seen alongside its trading name of "PTA-UK". Before considering the issue of confusion further, it should be stated that it is usual in DRS cases to disregard suffixes and focus exclusively on the substantive portion of the Domain Name. The 26 March letter shows that the use of the term "PTA" by the Respondent is not what the Complainant objects to, and solicitors for both Parties agree that the term is "generic". These points make it hard for the Complainant to object when "PTA" is repeated in the Domain Name. The Complainant's stance invites the conclusion that a domain name containing a name or mark identical to one over the use of which a complainant expressly acquiesces, cannot (almost by definition) be an Abusive Registration. The Complainant nevertheless argues that the Respondent's use of the Domain Name has caused confusion and that this was the intention in acquiring it. But again, on the Complainant's own assessment, confusion lies not in the repetition of the <pta> substantive element, but in the whole Domain Name including its suffix.

Even if the above analysis is not correct, it is necessary to distinguish between confusion which might arise from the breakdown of the business relationship in general, and confusion that might be attributable to the Respondent's acquisition of the Domain Name. Confusion of the former kind falls outside of the Complaint. The Complainant argues that the purchase of the Domain Name by the Respondent is the sole source of user confusion but the Expert cannot give much weight to the more or less unsupported assertions in this regard. One brief internal email summarising a telephone call from an unknown third party was submitted, but this is not enough to establish the Complainant's position on a balance of probabilities. Moreover, Paragraph 3aCii of the Policy points to a quite specific form of confusion, requiring the Complainant to show that there are

"Circumstances indicating that the Respondent is using the Domain Name in a way which has confused people or businesses into believing that the Domain Name is registered to, operated or authorised by, or otherwise connected with the Complainant;

The Expert sees no indication that the Respondent has tried to pass itself off as the Complainant or suggest a link to the Complainant of the kind described in this paragraph. The DRS Expert Overview explains confusion as follows:

"The 'confusion' referred to in this paragraph of the Policy is confusion as to the identity of the person/entity behind the domain name. Will an Internet user seeing the domain name or the site to which it is connected believe or be likely to believe that "the domain name is registered to, operated or authorised by, or otherwise connected with the Complainant?"

"...Commonly, Internet users will visit web sites either by way of search engines or by guessing the relevant URL. If the domain name in dispute is identical to the name of the Complainant and that name cannot sensibly refer to anyone else,

there is bound to be a severe risk that a search engine, which is being asked for the Complainant, will produce high up on its list the URL for the web site connected to the domain name in issue.”

In this case, the Complainant’s name is not identical to the Domain Name and the Expert does not believe that the Domain Name “cannot sensibly refer to anyone else”. The Complainant’s trading names over the years have incorporated the letters “PTA” in various ways, with various addition letters, but “PTA” on its own is not the Complainant’s name nor is it exclusively or unambiguously associated with its identity. For the sake of completeness, the Expert notes that both Parties have made claims concerning their respective rankings when “PTA” is entered as a Google search term, but does not feel that these arguments point to a conclusion either way. The Overview’s question “will an Internet user...believe or be likely to believe that the Domain Name is registered to or otherwise connected to the Complainant?” is one which the Expert must address on a balance of probabilities. In this case, while there is a possibility of such an outcome, the Expert does not believe that it is sufficient to tilt the balance in the Complainant’s favour.

The Complainant, in its Reply to the Response, repeats its assertion that “the purchase and use of [the Domain Name] by [the Respondent] is likely to confuse people in view of its overall similarity to pta.org.uk”. Considered alongside the Complainant’s acceptance of the Respondent’s use of the substantive portion of the Domain Name (“PTA”), “overall similarity” as this is understood by the Complainant, is not a conclusive argument in a DRS Complaint. The Expert therefore concludes that the Respondent’s registration of the Domain Name is not an Abusive Registration as defined by the DRS Policy.

7. Decision

The Expert finds that the Complainant has Rights in a name or mark identical to the Domain Name, but that the registration of the Domain Name is not an Abusive Registration as defined by the DRS Policy. No action to be taken.

Signed Peter Davies

Dated 29 May 2012