

DISPUTE RESOLUTION SERVICE

D00011518

Decision of Independent Expert

Wirral Wetrooms Ltd.

and

Mathew Whiteley t/a CW Web Design

1. The Parties

Complainant: Wirral Wetrooms Ltd.
5 Thingwall Road
Irby Village
Irby
Wirral
CH61 3UA
United Kingdom

Respondent: Mathew Whiteley t/a CW Web Design
88 Ridgemere Road
Pensby
Wirral
Merseyside
CH61 8RP
United Kingdom

2. The Domain Name

wirralwetrooms.co.uk

3. Procedural History

22 June 2012 13:38, the Dispute was received.
22 June 2012 14:00, the Complaint was validated.
22 June 2012 14:14, the notification of the Complaint was sent to the Parties.
11 July 2012 02:30, the response reminder was sent to the Respondent.
11 July 2012 11:27, the Response was received.
11 July 2012 11:27, the notification of the Response was sent to the Parties.
16 July 2012 07:23, the Reply was received.
16 July 2012 07:25, the notification of the Reply was sent to the Parties.
16 July 2012 07:25, a mediator was appointed.
19 July 2012 14:10, mediation started.
26 July 2012 14:26, mediation failed.
26 July 2012 14:27, the close of mediation documents were sent to the Parties.
27 July 2012 09:31, the Expert decision payment was received.

4. Factual Background

- 4.1 The Complainant was incorporated as a limited company on 7 October 2008 (registration no. 6716969).
- 4.2 The Respondent registered the Domain Name on behalf of *Bathrooms & Wetrooms Ltd.* (the “Respondent’s Company”) on 5 January 2009.
- 4.3 The Respondent’s Company was incorporated on 14 June 2007.

5. Parties’ Contentions

The Complaint:

- 5.1 In summary, the Complainant submitted that the Domain Name should be transferred to it for the reasons below.

The Complainant has Rights in the Domain Name

- The Complainant stated that it installed bathrooms sold by the Respondent’s Company between 2007 and 2008, but that there was a “gradual erosion” of that working relationship and a downturn in work provided to the Complainant by the Respondent’s Company.
- The Complainant stated that it incorporated in 2008, and explained that its name *Wirral Wetrooms* (the ‘Name’) was chosen because the Complainant specialises in providing and installing Wetrooms and is based on the Wirral. Further, that it had registered the domain name *wirralwetroom.co.uk* as the nearest name available to its Name.

- The Complainant stated that it opened a showroom in December 2009 as a means of providing work for its employees, with the added benefit of giving its clients a better service as the fitting of the Wetrooms would be its responsibility from the design of them through to their installation.
- The Complainant submitted that it has Rights in the Domain Name as:
 - the Domain Name is its company name;
 - the Complainant was registered as a limited company before the Domain Name was registered; and,
 - it has built its business up to have a very good reputation and has spent many thousands of pounds advertising in local magazines [a 2010 magazine advert for the Complainant was exhibited by the Respondent] and on its fleet of 8 vehicles [a photograph of one of the fleet vehicles referred to was exhibited by the Respondent].

The Domain Name, in the hands of the Respondent, is an Abusive Registration

- The Complainant stated that it had decided to create a website for its business but was informed by its web designer that the Domain Name had already been registered by the Respondent.
- The Complainant submitted that:
 - the Domain Name was set up specifically by the Respondent to capture any random searches for the Complainant and to benefit from such searches at the Complainant's expense;
 - the Domain Name is being used to host a website (the 'Website') which is used by the Respondent to market the same products and services as the Complainant provides, which disrupts the Complainant's business as customers mistake the Website with its company; and,
 - the Domain Name is being used as a portal into the Respondent's Company website (www.bathroomsandwetrooms.co.uk) in full knowledge that any person or companies searching for the Complainant's business will come across the Website and accidentally log on to it in the belief that it is the Complainant's website.
- The Complainant submitted that it has "knowledge" that customers and suppliers have contacted the Respondent's Company through the email information address at the Domain Name, and in one such case the information contained in that email was utilised by

the Respondent's Company for its benefit [no evidence to support the latter claim was provided].

Respondent's response:

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

- The Respondent explained that the Respondent's Company is a supplier and installer of bathrooms and Wetrooms. It has used its distinctive trading style of blues and particular fonts on its showrooms, websites and advertising literature since it began to trade. The Respondent's Company has three internet commerce sites and two showroom sites. As well as maintaining two showrooms, it also undertakes a considerable amount of trade on-line.
- The Respondent stated that the Complainant's Managing Director was previously "directly employed" by the Respondent's Company to install bathrooms and Wetrooms but that he subsequently decided to go into business himself as *Bathroom and Kitchen Design Services Ltd.* and that that company was employed as an installation sub-contractor by the Respondent.
- The Respondent submitted that, in early 2009, the Complainant was set up by the Complainant's Managing Director, and it traded in competition with the Respondent.
- The Respondent stated that the relationship between the Respondent's Company and the Complainant "is not good" and that the Complainant is using the Nominet dispute service as part of its "ongoing commercial feud" with the Respondent's Company.
- The Respondent submitted that the Domain Name contains generic, non-copyrighted words that equally apply to the Respondent's Company. The Respondent stated that the Domain Name was selected as the generic keywords contained within the Domain Name reflected both a major aspect of the Respondent's Company business (Wetrooms) and the geographical area in which the Respondent's Company is located and predominantly serves (Wirral).
- The Respondent stated that it is unaware of any right in law that the Complainant may have to claim the Domain Name, and he noted that none had been asserted.
- The Respondent explained that, at the time he registered the Domain Name, he was unaware of the registration of the Complainant. The Respondent stated that the Complainant did not commence trading under the Name until February or March 2009.

- The Respondent stated that the Domain Name was registered by him as part of an on-going exercise to secure keyword heavy domain names for current or future use, and not on a malicious basis as claimed. The domains registered, on different dates but preceding this dispute, include: *liverpoolwetrooms.co.uk*, *londonwetrooms.co.uk*, *merseybathrooms.co.uk* and *mobilitywetrooms.co.uk*.
- The Respondent explained that he holds over 150 domain names relating to bathrooms and Wetrooms, and that the domain names have been acquired as part of a commercial strategy and not for any malicious intent.
- The Respondent submitted that the Domain Name has been in use since February 2009, and that the Complainant has known of the Respondent's use of the Domain Name for over three years and only now has sought to raise the issue with Nominet.
- The Respondent submitted that, if the Complaint was successful, the Respondent's Company would lose business both actual and potential as established and new customers seeking its services would be directed to the Complainant's website.
- The Respondent submitted that the Complaint has been made in the hope that it will disrupt its business and to further the dispute between the Parties, rather than as a consequence of a genuine belief that the Respondent's possession of the Domain Name is an abuse.
- The Respondent denied that, by the Website, the Respondent's Company seeks to pass itself off as the Complainant or to capture potential searches for the Complainant's business. On the Website, the Respondent submitted that the Respondent's Company seeks to establish its corporate identity by:
 - use of the Respondent's Company logo;
 - the clear presence in large font of the Respondent's Company address at the foot of every page;
 - the photograph of the Respondent's Company showroom on the *about page*; and,
 - the highlighted link to the Respondent's Company 'main' website (www.bathroomsandwetrooms.co.uk).
- Further, the Respondent explained that the Respondent's Company has put on the Website and its main website that: "Please take notice you are visiting Bathrooms & Wetrooms Limited, please do not confuse us with other businesses having similar names" (the 'non-confuse phrase').

- The Respondent submitted that the Complainant's trading style closely resembles that of the Respondent's Company, which has caused and continues to cause difficulties for both Parties, and that the Complainant in styling its showroom premises, websites, adverts etc. as closely as possible to the Respondent's Company hopes to secure a commercial advantage arising from its association in the eyes of the public with the Respondent's Company business. [The Expert has not considered whether such a claim by the Respondent would amount to an actionable claim that the Complainant has 'passed himself off' as the Respondent.]
- Further, as the Respondent's Company established its trading style prior to the incorporation of the Complainant, the Respondent cannot be "passing itself off" as the Complainant.

Complainant's Reply:

5.3 The Complainant replied that, in summary:

- It has no knowledge of the Respondent's Company business or e-commerce sites, the Complainant's Managing Director has never been employed by the Respondent's Company directly, and the Complainant is not aware of the Respondent's Company business plan.
- It refutes that there is an "ongoing commercial feud". Also, its trading style is quite distinctive from the Respondent's Company and that it has gone to a lot of expense to make it so.
- The Respondent was aware of the registration of the Complainant at the time it registered the Domain Name, and the Respondent also registered the Name on *ebay* at the same time.
- In relation to the Respondent registering over 150 domain names relating to bathrooms and Wetrooms, the Complainant submitted that it appears to be a general assault on the Internet in general and the bathroom industry in particular.
- It has only recently become aware of the dispute service offered by Nominet. As it has not been aware of any action it could have taken until now, it does not believe its naivety for not having used the dispute service sooner should be used against it in this matter.
- It failed to see how the Respondent's Company would lose business from the Complainant being successful, unless by doing so the Respondent is admitting that the Respondent's Company generates business from searches for the Name and thereby admitting to an abusive registration.
- The use of the Name by the Respondent's Company in highlighted bold words at the centre of the Website homepage text is a

deliberate attempt to confuse the viewer of the Website to believe that they are dealing with the Complainant or at least someone associated with it.

- The Complainant welcomed the addition of the non-confuse phrase and will respond in kind on its future advertisements.
 - One adverse side effect of the Domain Name is that emails intended for *info@wirralwetroom.co.uk* are sent by mistake to *info@wirralwetrooms.co.uk* even when the email address is written down “as it appears to be human nature to automatically assume that the company name is the email address”.
 - [While the Complainant stated that:
 - the Respondent’s view that the Domain Name contains generic, non-copyrighted words that equally apply to the Respondent’s Company “appears to be correct”; and,
 - the Respondent’s statement that he is unaware of any right in law that the Complainant may have to claim the Domain Name and notes that none has been asserted “is correct”,
- the Expert has not taken either comments by the Complainant to be an admission that it does not have Rights in the Domain Name. The Expert considers that the Complainant in replying as it did was summarising the Respondent’s thoughts (i.e. the Complainant basically replied that, “I agree, that is what the Respondent thought”) rather than stating what the Complainant thought.]

6. Discussions and Findings

General

- 6.1 To succeed in the Complaint, the Complainant has to prove pursuant to paragraph 2 of Nominet’s Dispute Resolution Service Policy (the ‘Policy’) that, on the balance of probabilities¹:

“(i) [it] has Rights in respect of a name or mark which is identical or similar to the Domain Name [paragraph 2.a.i. of the Policy]; and,

¹ I.e. on the basis that the Complainant’s case is more likely than not to be the true version, see <http://www.nominet.org.uk/disputes/drs/legalissues/>.

(ii) The Domain Name, in the hands of the Respondent, is an Abusive Registration [paragraph 2.a.ii. 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:

“[...] 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.²

6.4 The Complainant has not brought forward evidence that it has obtained registered trademark protection for the Name; a registered trademark being an enforceable right as understood by the above definition.

6.5 Also, while the Expert considers that the Domain Name is substantially identical (and certainly similar) to that of the Complainant’s registered company name, the Name (not counting the generic .co.uk suffix or the addition of ‘Ltd’) – in the view of the Expert, the mere registration of a company name does not of itself give rise to any Rights.

6.6 As the above definition of Rights embraces other enforceable rights other than a registered trade (or service) mark, the Expert has considered whether such a non-registered enforceable right arises in the Name.

6.7 The Expert considers that relevant to this consideration is whether:

(a) the Complainant has used the Name for a not insignificant period and to a not insignificant degree; and,

(b) the Name is distinctive of (i.e. indicates to the purchasing public (including trade purchasers)) 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 as a limited company in October 2008, and has carried on its business activities under the Name since. Therefore, the Expert considers that the Complainant in this way has used the Name for a ‘not insignificant’ period.

6.9 In addition, the Expert considers that the use of the Name by the Complainant has been to ‘a not insignificant degree’. As mentioned above, the Complainant has run its business under the Name for nearly 4

² See for example, Nominet Appeal decision, *ghd*, DRS No. 03078, at page 9, para 9.2.2.

years, it has a shop front in the general locality, it has generated sufficient business and consequent turnover to keep a business employing three people running for that length of time.

- 6.10 In relation to consideration (b), the Expert considers that, on the balance of probabilities, the Name serves to indicate to the purchasing public the goods or services of the Complainant, at least in the Wirral area (the 'relevant geographic area') in which each of the Parties trade.
- 6.11 Based on the evidence before him, the Expert considers that the Name itself is capable of being distinctive; the combination of the words 'Wirral' and 'Wetrooms' were unique to the Complainant in the relevant geographic area until the registration of the Domain Name by the Respondent, and the Respondent's use of the Name on *ebay*. In the view of the Expert, the combination of the words is not generic and is not a usual combination in the English language.
- 6.12 The Expert also considers that, on the balance of probabilities, the Complainant has generated goodwill and reputation in the Name sufficient to give rise to unregistered trade mark rights in respect of the Name.³ Relevant to this is the Complainant's assertion that it has built its business up to have a very good reputation in the relevant geographic area and has spent many thousands of pounds advertising in local magazines and on its fleet of 8 vehicles (and the evidence supplied by the Respondent referred to at para. 5.1 above).⁴
- 6.13 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, at the time of the Complaint, the Complainant had Rights in a Name which is substantially identical (and certainly similar) to the Domain Name.

ii) Abusive Registration

- 6.14 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

³ 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.

⁴ The case of *Redwood Tree Services Ltd v Warren Apsey t/a Redwood Tree Surgeons* [2011] EWPC 14) supports the fact that small businesses with only local custom can generate Goodwill in a localised geographic area sufficient to successfully prevent third parties from passing off in that area.

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

- 6.15 *In relation to i. above* – the Respondent submitted that, at the time he registered the Domain Name, he was unaware of the registration of the Complainant; and that the Complainant did not commence trading under the Name until February or March 2009. Therefore, the Domain Name could not have been registered by him to take unfair advantage of be unfairly detrimental to the Complainant's Rights. The Complainant in reply stated that the Respondent was aware of the registration of the Complainant at the time it registered the Domain Name
- 6.16 While there is nothing before the Expert to show that the Complainant was trading prior to the registration of the Domain Name, it seems highly unlikely to the Expert, on the balance of probabilities, that the Respondent was not aware of the Complainant's incorporation and its Name at the time of the Respondent's registration of the Domain Name in early 2009. Relevant to this is the previous close working relationship between the Managing Director of the Complainant and the Respondent's Company (where the Managing Director of the Complainant installed bathrooms for the Respondent's Company as a sub-contractor between 2007 and 2008, until there was a "gradual erosion" of that relationship) and that the Name was registered as the Domain Name so soon after the incorporation of the Complainant.
- 6.17 Further, and given the obvious risk of resultant confusion (see below, e.g. at para. 6.21), the Expert considers that, on the balance of probabilities, the Respondent's intention at the time of registering the Domain Name was to unfairly disrupt the business of the Complainant (as provided for at paragraph 3.a.i.C. of the Policy).
- 6.18 Thus, the Expert considers that the registration of the Domain Name took unfair advantage of, and was unfairly detrimental to, the Complainant's Rights.
- 6.19 *In relation to ii. above* – in any event, the Expert considers that the Domain Name has been used in a manner which took unfair advantage of and was unfairly detrimental to the Complainant's Rights.
- 6.20 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."

- 6.21 Given the evidence before him, including email correspondence between the Parties indicating general confusion, and the reference on the Website to the Name,⁵ the Expert considers that the Respondent's use of the Website has confused and is likely to confuse those accessing the Website into believing that the Domain Name (and the goods/services offered for sale on the Website) is the Complainant's or is at least authorised by the Complainant: which is not the case.
- 6.22 The Expert considers that the Respondent has taken unfair advantage of the Complainant's Rights in the Name as the Respondent has likely generated potential custom from those accessing the Website under the false impression that the Website and the goods/services sold there are the Complainant's.
- 6.23 Also, such use of the Domain Name has been unfairly detrimental to the Complainant as the use of the Website in the way described above has likely diverted potential Internet traffic away from the Complainant's website, and thus the Complainant has lost possible sales income as a consequence.
- 6.24 The Expert has considered whether there is evidence before him to suggest that any of the factors listed at Paragraph 4 of the Policy demonstrate that the Domain Name is not an Abusive Registration but does not consider any are relevant.

7. Decision

- 7.1 The Expert finds that, on the balance of probabilities, the Complainant has Rights in the Name which is substantially identical (and certainly similar) to the Domain Name and that the Domain Name in the hands of the Respondent is an Abusive Registration. Therefore, the Expert directs that the Domain Name be transferred to the Complainant.

Signed Dr Russell Richardson

Dated 29 August 2012

⁵ The Complainant provided a print-out of the homepage of the Website.