

## DISPUTE RESOLUTION SERVICE

D00011555

### Decision of Independent Expert

Imperative Training Ltd trading as Defibshop

and

Alastair Maxwell

#### **1. The Parties:**

Complainant: Imperative Training Ltd trading as Defibshop  
Excalibur House  
630 Liverpool Road  
Irlam  
Manchester  
M44 5AD  
United Kingdom

Respondent: Alastair Maxwell  
The Grange  
Shute Lane Denbury  
Newton Abbot  
Devon  
TQ12 6EB  
United Kingdom

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

thedefibshop.co.uk

### **3. Procedural History:**

The Complaint was submitted to Nominet on 29 June 2012. On 2 July 2012, Nominet validated the Complaint and notified it to the Respondent. The Respondent was informed in the notification that it had 15 working days, that is, until 23 July 2012 to file a response to the Complaint.

On 4 July 2012 the Respondent filed a Response. On 11 July 2012, the Complainant filed a Reply to the Response. The case proceeded to the mediation stage. On 20 August 2012, Nominet notified the Parties that mediation had been unsuccessful and invited the Complainant to pay the fee for referral of the matter for an expert decision pursuant to paragraph 8 of Nominet's Dispute Resolution Service Procedure Version 3 ("the Procedure") and paragraph 7 of the corresponding Dispute Resolution Service Policy Version 3 ("the Policy"). On 22 August 2012, the Complainant paid the fee for an expert decision. On 28 August, 2012, Andrew D S Lothian, the undersigned, ("the Expert") confirmed to Nominet that he was not aware of any reason why he could not act as an independent expert in this case. Nominet duly appointed the Expert with effect from 30 August 2012.

### **4. Factual Background**

The Complainant is Imperative Training Limited, a company incorporated in England under company number 4987229. The Complainant's director, David Howarth, is the registrant of the domain name <defibshop.co.uk>, registered on 11 March 2006. The Complainant is the registered proprietor of Community Trade Mark no. 8306656, filed on 18 May 2009 and registered on 29 March 2010 for the figurative mark "defibshop.co.uk" in connection with classes 10, defibrillators and 35, retail services connected to the sale of defibrillators. The graphic representation of the said mark consists of the word "defibshop" in a stylized form consisting of a red typeface, together with a heart symbol in matching red placed after and slightly above the letter "p". The Complainant's said mark claimed seniority from UK registered trade mark no. 2430129 filed on 9 August 2006 and registered on 2 February 2007.

The Complainant has been trading under the name 'Defib Shop' since March 2006. The website associated with the Complainant's <defibshop.co.uk> domain name offers automated external defibrillators ("AEDs") for sale, together with support and training services. The Complainant's website lists a wide range of household name customers from The British Red Cross and GlaxosmithKline to IKEA and Rolls-Royce. The said website contains testimonials from, among others, the University of St Andrews, Kwik Fit (GB) Ltd, Lords Cricket Ground and the England and Wales Cricket Board.

According to its website, the Complainant has received a range of accreditations including (1) approval from the First Aid Approval and Monitoring Section (FAAMS) of the Health & Safety Executive's Corporate Medical Unit to teach first aid in the workplace (May 2005); (2) ISO 14001 Environmental Quality Management Assurance (September 2009); and ISO 9001 Quality Management Assurance (May 2007).

The Respondent is the managing director of Crest Medical Limited ("Crest"), a competitor of the Complainant. The Domain Name was registered on 2 February 2011. Crest uses the Domain Name in connection with a website entitled "Crest Medical / The Defib Shop" which offers AEDs for sale.

On 24 March 2011 the Complainant's solicitors wrote to Crest stating that the website associated with the Domain Name constituted trade mark infringement and passing off. The Complainant's solicitors also claimed that the copyright in one of the Complainant's photographs used on the Complainant's website had been infringed by the reproduction thereof on the website associated with the Domain Name.

On 7 April 2011 Crest's solicitors replied to the Complainant's solicitors denying trade mark infringement and passing off and stating that the Respondent used the term "The Defib Shop" descriptively to refer to the Respondent's Internet shop for the supply of defibrillator machines, commonly known as a "Defib". With regard to the alleged copyright infringement, the solicitors stated that the image complained of had been thought to be a manufacturer's product image, which Crest had permission to use, and that steps had been taken to change this image. The solicitors stated that in the event that the Complainant had copyright in the image concerned, which was not admitted, their client apologised.

The Complainant and Crest are both members of the British Healthcare Trades Association. Minutes of the meeting of the said Association held on 6 October 2011 disclose that the Chair of the meeting was the Respondent and the Complainant's David Howarth was also present, listed as representing "Imperative Training/Defibshop".

## **5. Parties' Contentions**

### **Complainant**

The Complainant states that Defibshop.co.uk Limited is a trading name of the Complainant and notes that David Howarth is the owner and director of the Complainant and owns the domain name <defibshop.co.uk>. The Complainant asserts that the brand 'Defib Shop' is recognised by the trade and public as the website is over 5 years old. The Complainant contends that

it has built up a strong reputation within the industry with both manufacturers and customers, including schools, hospitals and sporting organisations.

The Complainant states that while it does not have manufacturers' sales figures, the Complainant is the only retailer that sells every manufacturer's defibrillator in the UK. The Complainant asserts that its website ranks at number three on Google.co.uk for a search against the word "Defibrillator", behind <wikipedia.org> and the British Heart Foundation <bhf.org.uk>. The Complainant contends that this demonstrates that its website is a recognised brand in the industry and to the public.

The Complainant states that search queries in respect of "Defib Shop", "The Defib Shop" and "The Defibshop" show the Complainant's website in the number one position and the website associated with the Domain Name in the number two position. The Complainant provides hyperlinks to two Google searches involving the terms "defib+shop" and "the+defib+shop".

The Complainant states that Google and other important social network websites associate the search query "Defibshop" as being related to the brand Defibshop.co.uk Limited because the Complainant's website is the top result in a Google search for this query and that the other results are: (2) a twitter account for the Complainant having 558 followers as at 18 June 2012; (3) a competitor with a unique URL; (4) a <youtube.com> account for the Complainant having 9,748 video views as at 18 June 2012; (5) the Complainant's <imperativeonline.com> site advertising staff vacancies for <www.defibshop.co.uk>; (6) an article relating to the Complainant exhibiting at a football event; (7) the Complainant's web developer's portfolio page relative to the <www.defibshop.co.uk> website; (8) the Complainant's <imperativetraining.com> site advertising staff vacancies for <www.defibshop.co.uk>; and (9) the website associated with the Domain Name.

The Complainant notes that it has paid to exhibit at national conferences under the name DefibShop.co.uk and provides a link to a list of exhibitors from the British Dental Association Conference and Exhibition which took place between 26 and 28 April 2012.

The Complainant notes that it registered the company Defibshop.co.uk Limited, company number 582825 on 23 May 2006 and refers to the Complainant's registered Community Trade Mark as noted in the Factual Background section above.

The Complainant states that the Domain Name is an Abusive Registration because it was registered to unfairly disrupt, and threatens to unfairly disrupt, the Complainant's business by using a similar domain name to the Complainant's <defibshop.co.uk> domain name. The Complainant asserts that this can be seen from search engine rankings as the website associated

with the Domain Name is beginning to rank highly for brand name terms, being number two for "Defib Shop".

The Complainant produces a purchase order from Holy Cross Hospital dated 12 January 2012 and addressed to "The Defib Shop, 17 Chesford Grange, Warrington, Woolston, Cheshire, WA1 4RQ". The said purchase order is in respect of a "1.0 Cardiac science powerheart G3 and training equipment" at a unit price of £305 and states "Please fax order to 0845 071 0819". The said purchase order bears to be signed by the Chief Executive of the hospital concerned.

The Complainant states that the said purchase order is from one of its customers and that there are several factors that led the Complainant to believe that the customer was confused between the Complainant's website and the website associated with the Domain Name, namely:-

1. the Complainant says that Crest do not sell the device, which is the subject of the order, on their website;
2. the Complainant says that it does sell the device on its website and that it advertises the device at the price quoted in the order, which is not the manufacturer's recommended retail price. The Complainant provides the relative hyperlink to the Complainant's website.
3. The Complainant says that the postal address on the said purchase order is Crest's address.
4. The Complainant says that the fax number on the said purchase order is the Complainant's fax number.

The Complainant contends that the Domain Name was registered to confuse the trade and the public, as an Internet user seeing the Domain Name is likely to believe that the Domain Name is registered to, operated or authorised by, or otherwise connected with the Complainant, due to the close similarity between the Parties' domain names.

The Complainant notes the terms of Crest's solicitors' letter referred to in the Factual Background section above and states that the Respondent was using images taken from the Complainant's website <[www.defibshop.co.uk](http://www.defibshop.co.uk)> on Crest's website at the Domain Name. The Complainant asserts that the Respondent admitted to the unintentional use of the image concerned. The Complainant asserts that the image had been taken by a photographer commissioned by the Complainant.

The Complainant notes that in the correspondence between its solicitors and those of Crest the Respondent had asserted that "Defib" is a commonly used term in the industry and was selected for its generic nature. The Complainant supplies figures from Google Adwords Keyword Tool as at 28 May 2012 showing the estimated monthly search volume for UK based searches for the

following terms:- (a) Defibrillator - 40,500; (b) Defibrillators - 22,200; (c) AED - 90,500; (d) AEDs - 49,500; (e) Defib - 3,600; and (f) Defibs - 1,600. The Complainant contends that had the Respondent been seeking a generic term it would have opted for a domain name with the full name "Defibrillator" or "AED," the popular acronym for Automated External Defibrillator. The Complainant notes that the domain name <defibrillatorshop.co.uk> was available as of 28 May 2012.

The Complainant notes Crest's denial in the solicitors' correspondence that the Complainant has established any reputation in the term "Defib Shop" and states that the Complainant is a member of the British Healthcare Trades Association (BHTA) of which the Respondent is the Chair of the First Aid and Medical Equipment section. The Complainant produces a copy of the minutes from a meeting of the said section held on 6 October 2011 and notes that within these the Complainant's David Howarth is acknowledged as being from Imperative Training and Defibshop.

The Complainant states that while manufacturers and suppliers will not release their sales figures, the Complainant has been told by the manufacturers that the Complainant is the top selling distributor for Defibtech and Zoll in the UK for the past few years. The Complainant asserts that it is also one of the top three distributors for Cardiac Science, Philips, Schiller and Heartsine products.

### **Respondent**

The Respondent states that the Domain Name is used by its business, Crest. The Respondent asserts that the complaint has already been handled by Crest's solicitor and provides a copy of the Complainant's solicitors letter to Crest together with a draft copy of Crest's solicitor's reply. The Respondent notes that as no response was received to the reply from Crest's solicitors it had presumed that the matter was closed.

The Respondent states that the term "defib" is a commonly accepted abbreviation of the word defibrillator and submits that a Google search demonstrates this by reference to page one results including the following URLs: [www.stjohnsupplies.co.uk/defibs](http://www.stjohnsupplies.co.uk/defibs); [www.thedefibcentre.co.uk](http://www.thedefibcentre.co.uk); and [www.defibfinder.co.uk](http://www.defibfinder.co.uk).

The Respondent notes that it does not consider it appropriate for the Complainant to have a monopoly on the word "defib" as a commonly accepted abbreviation; or the word "shop" as an obviously accepted term for a retailer whether online or off. The Respondent quotes an example from its own business where it employs the domain name <firstaidwarehouse.co.uk> but states that it could not expect to claim other domain names in use, such as <medicalwarehouse.co.uk> which it does not own.

The Respondent states that the Complainant's assertion that defibshop.co.uk Limited is a trading name of the Complainant is untrue. The Respondent states that it accepts that the domain name <defibshop.co.uk> is a trading style of the Complainant but a Companies House search on defibshop.co.uk Limited, company number 05825825, shows the company to be registered as dormant and non-trading. The Respondent requests that the Complainant's said assertion is held to be inadmissible as evidence. The Respondent also notes that it disputes the Complainant's claim that the Complainant is the only retailer that sells every manufacturer's defibrillators in the UK.

With regard to the purchase order from Holy Cross Hospital, the Respondent states that this is an isolated incident that may have been designed by the Complainant to support its claim. The Respondent submits that the order should have been passed back to Crest, given that the address and price was theirs. The Respondent states that it did not learn of the purchase order before the present Complaint. The Respondent adds that it believes that it is impossible that someone could mistake the Respondent's site as being owned by the Complainant given the strong Crest Medical branding on the Respondent's website. In this connection, the Respondent refers again to the reply from Crest's solicitors to the Complainant's solicitors which states that the website at the Domain Name focuses heavily on the Crest Medical brand image and that in no way is the Respondent attempting to benefit from the Complainant's trade mark, branding or any general recognition of the Complainant or its trading styles.

### **Complainant's reply to response**

The Complainant notes that the issue of the Domain Name was mentioned in the correspondence between solicitors but was not concluded.

The Complainant states that it is not asking for a monopoly on the word "defib" but was highlighting the fact that it is not the most commonly used search term. The Complainant adds that it has no issue with a site using "defib" in the URL, or to the branding on the website associated with the Domain Name, but does object to the adding of a "the" as a prefix to the Complainant's registered trade mark, which the Complainant submits has the potential to confuse businesses and the public in search results.

The Complainant seeks to clarify the information provided from Companies House by noting that (1) the Complainant, Imperative Training Limited, is trading as "defibshop.co.uk"; (2) defibshop.co.uk is a registered trade mark with OHIM; and (3) defibshop.co.uk Limited is a company owned by the Complainant for the purpose of protecting the company name and is registered at Companies House. The Complainant concedes that this latter company is currently dormant.

## **6. Discussions and Findings**

### **General**

Paragraph 16(a) of the Procedure states, *inter alia*:-

"The Expert will decide a complaint on the basis of the Parties' submissions, the Policy and this Procedure. The Expert may (but will have no obligation to) look at any web sites referred to in the Parties' submissions."

In the present case the Expert has considered the Complainant's website at <www.defibshop.co.uk> and the website associated with the Domain Name, both of which were referred to in the Parties' submissions. In particular, the Expert reviewed the content of the Complainant's website which provided evidence of the extent of its customer base, significant numbers of whom are well known and are listed on a scrolling banner therein, alongside multiple testimonials from selected clients.

In terms of paragraph 2(b) of the Policy the onus is on the Complainant to prove to the Expert on the balance of probabilities each of the two elements set out in paragraph 2(a) of the Policy, namely 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.

### **Complainant's Rights**

Paragraph 1 of the Policy provides that Rights means "rights enforceable by the Complainant, whether under English law or otherwise, and may include rights in descriptive terms which have acquired a secondary meaning".

The requirement to demonstrate Rights under the Policy is not a particularly high threshold test. Rights may be established in a name or mark by way of a trade mark registered in an appropriate territory, or by a demonstration of unregistered so-called 'common law rights'.

In the present case, the Complainant relies on its registered trade mark as described in the Factual Background section above. The word element of that mark is contained in the Domain Name in its entirety, together with the prefix "the". In such circumstances the Expert would typically be prepared to find that the Domain Name is similar to the trade mark without further discussion.



However, an additional matter arises in the present case which does require more detailed consideration, namely the issue of the Complainant's mark being figurative in nature, that is, the word "defibshop" is incorporated in a device or logo within the trade mark rather than having been registered as a word only mark. While neither of the Parties discusses this in their submissions, the correspondence between the Complainant's solicitors and those acting for Crest does address the point. The essence of the Respondent's position as derived from that correspondence is that only the graphic representation of the word with the adjoining heart-shaped image "appears to be (arguably) distinctive and capable of registration".

The issue of a figurative mark in which the textual elements comprise an arguably unregistrable description made up of dictionary words was considered by the Appeal Panel in *Elite Licensing Company S.A. v. Mr Leigh Davy* (DRS 08975). The Appeal Panel quoted from paragraphs 78-80 of the judgment of Jacob LJ in the case of *Phones4u Ltd v. phones4u.co.uk* [2006] EWCA Civ.244. The essence of these passages appears to the Expert to be that if one "goes by the existing legislation" one cannot say in the case of a figurative mark that only a confusingly similar device would infringe; one must make an overall ("global") comparison of the registered mark with the alleged infringement and in such a comparison the words may be a sufficiently clear, prominent and memorable part of the mark that the words as such or a trivial variant thereof will cause confusion. The Appeal Panel in *Elite* decided to adopt Jacob LJ's reasoning and to apply this to the question of Rights under the Policy without further discussion.

In addition to the *Phones4u* case, the Expert notes that this issue is also examined in paragraph 1.11 of the *WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Second Edition* ("WIPO Overview 2.0"). The UDRP, or Uniform Domain Name Dispute Resolution Policy, does however contain different wording from the Nominet DRS Policy; for example, it requires that a complainant show that a disputed domain name is "identical or confusingly similar" to a complainant's trade mark rather than merely "identical or similar" as in the DRS Policy. In light of the differences between the Policy and the UDRP, many of which are significant, the Foreword to the corresponding DRS Experts' Overview notes that most comparisons or indeed citations of UDRP decisions in cases under the DRS Policy should generally be avoided as they are "rarely likely to be helpful".

However, in the present case, the Expert considers that the WIPO Overview 2.0 is of assistance, principally because the issue arising from a figurative mark, namely the question of whether one can extract elements from a device in order to compare them with a domain name, is identical for both the DRS and the UDRP. Where a figurative trade mark is cited by a complainant, each policy requires a consistent mechanism or approach for identifying which, if any, elements of such a mark may be extracted and compared with a disputed domain name, bearing in mind that while the former by definition contains a device or pictorial component, the latter cannot. The fact that the

policies differ in their approach to the subsequent comparison of any such extracted mark elements and a disputed domain (relative to identity or similarity in the case of the DRS, while the test in the UDRP is identity or confusing similarity) is of no particular significance to the method by which the elements were extracted from the figurative mark in the first place.

Paragraph 1.11 of the WIPO Overview 2.0 states:-

"1.11 Are disclaimed or design elements of a trademark considered in assessing identity or confusing similarity?"

Textual content which has been expressly disclaimed in a complainant's relevant trademark registration is generally disregarded by panels when assessing a domain name's identity or confusing similarity under the first element of the UDRP. Also, as figurative, stylized or design elements in a trademark are generally incapable of representation in a domain name, such elements are typically disregarded for the purpose of assessing identity or confusing similarity, with such assessment generally being between the alpha-numeric components of the domain name, and the dominant textual components of the relevant mark. However, design elements in a trademark may be relevant to the decision in certain circumstances - such as where, for example, they form an especially prominent or distinctive part of the trademark overall. Some panels have found it to be a matter of impression in the circumstances of each case. Where the *entire* textual component of a complainant's relevant trademark has been disclaimed, or the *only* protectable component of such mark is comprised of design elements which generally cannot be represented in the alpha-numeric string of a domain name, then (absent a showing of acquired distinctiveness through use of the relevant mark) the complainant may lack any relevant rights under the UDRP on the basis of such mark, rendering moot any assessment of the disputed domain name's identity or confusing similarity with it." [cited cases omitted]

In addition to the WIPO Overview 2.0, the question of a figurative mark also features in paragraph 11.4 of the recently published *Overview of CAC panel views on several questions of the alternative dispute resolution for .eu domain name disputes* ("ADReu Overview"). Again, the test in the ADReu policy is different from the DRS policy, being in this case the same as the UDRP, in that it relates to identity or confusing similarity between the disputed domain name and the qualifying right. However, the test is likewise applied after extraction of elements from the mark. On this subject, the ADReu Overview states:-

"Can a complainant have a relevant right from a figurative trademark/service mark?"

Several panels have ruled that a figurative trademark/service mark can be a relevant right, if a word can be clearly separated and distinguished from the

other elements. If a figurative mark holds relevant rights to a specific domain name has to be determined in the decision on "Identity or confusing similarity". [cited cases omitted]

Accordingly, panels under the UDRP and the ADReu policies have adopted largely the same approach as that identified by Jacob LJ in the *Phones4u* case which was in turn adopted by the DRS Appeal Panel in *Elite Licensing Company*. Having expressed the caveat above regarding wholesale adoption of principles arising from different domain name dispute policies, or the citation of cases from such other policies in connection with the DRS Policy, but likewise having noted no substantive differences in approach between either the respective policies or UK trade mark law as expressed by Jacob LJ, the Expert is content to approach the figurative mark in the present case on the same basis. Accordingly, the question for the Expert is whether there are dominant textual components of the Complainant's trade mark which have not been disclaimed and which are severable and capable of being clearly distinguished from the design elements. If so, such elements are to be extracted and compared to the alpha-numeric string of the Domain Name.

The Expert is satisfied that the word element of the Complainant's trade mark, namely "defibshop" is clear and prominent in this case. There is minimal stylization of the textual component, which is restricted to the typeface and colour in which it is presented, while the graphical "heart" symbol is entirely non-dominant, being very small and positioned after the word element in a superscript position, approximately in the location where one might find an asterisk and indeed of a similar size and prominence.

This leaves the Expert with a comparison between the alpha-numeric string of the Domain Name and the extracted textual element of the Complainant's trade mark, disregarding the top (".uk") and second (".co") levels of the Domain Name as is customary in cases under the Policy. On such a comparison the Expert notes that the Domain Name is identical to the mark with the exception of the addition of the definite article as a prefix to the string in the Domain Name. In the Expert's opinion, the latter addition does nothing to distinguish the textual element of the mark from the Domain Name.

The Expert considered but was unable to attach significant weight to the Respondent's argument that the mark "Defib Shop" is merely descriptive of the Complainant's business. The Complainant relies on its registered trade mark, which is undoubtedly a "right enforceable by the Complainant" as the definition of Rights provides. The Expert takes the view that it is not strictly necessary for the Complainant also to show that the word elements of its figurative mark have acquired any secondary meaning for the purposes of demonstrating Rights in terms of paragraph 2(a)(i) of the Policy. That said, the definition of Rights under the Policy does in any event encompass descriptive terms which have acquired a secondary meaning and, had it been necessary to do so, the Expert believes that the Complainant would have

been able to demonstrate such a secondary meaning in "Defib Shop" for the following reasons. The Expert notes that the Complainant has been trading as "Defib Shop" since March 2006, some six and a half years. Over this time it has evidently built a business which has attracted a substantial base of household name customers, many of which have provided testimonials for the Complainant's website. In addition to this, the Complainant asserts that it has exhibited at national conferences and that it is one of the top three distributors in the UK for various brands of defibrillator. The Respondent notably does not take issue with these averments, seeking only to dispute the Complainant's contention that the Complainant is the only retailer selling every manufacturer's defibrillators in the UK.

The Expert also considered and did not attach weight to the Complainant's various averments regarding search engine placement. The Expert does not believe that search engine results are particularly valuable evidence of the extent to which a given website is a recognised brand in industry or to the public. To attach weight to such results would suggest that they are an accurate measure of an online trader's goodwill when in fact they are merely a demonstration either of that trader's relative skills in the art of search engine optimisation or a product of the search engine's algorithm which may be using any number of diverse factors to rank a given website.

Finally, the Expert did not consider the Complainant's registration of the limited company defibshop.co.uk Limited, company number 05825825, to be of any particular significance and accepted the Respondent's averments on this subject. The company is dormant and although the Complainant did describe it as its trading name the Expert believes that this was an unintentional slip on the Complainant's part; the facts demonstrate to the Expert's satisfaction that the Complainant's trading names are both "defibshop" being its registered trade mark as used on its website and its domain name <defibshop.co.uk>. Furthermore, in light of the Respondent's averments the Complainant took the opportunity to clarify this matter in the Reply and the Expert is satisfied with its explanation.

In all of these circumstances the Expert finds that the Complainant has proved to the satisfaction of the Expert, on the balance of probabilities, that it has Rights in a name which is similar to the Domain Name.

## **Abusive Registration**

### **General**

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*

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

This general definition is supplemented by paragraph 3 of the Policy which provides a non-exhaustive list of factors which may be evidence that the Domain Name is an Abusive Registration. Paragraph 4 of the Policy provides a similar non-exhaustive list of factors which may be evidence that the Domain Name is not an Abusive Registration.

In the present case, the Complainant asserts that the Domain Name was registered primarily for the purpose of unfairly disrupting the business of the Complainant in terms of paragraph 3(a)(i)(C) of the Policy. The Complainant also contends that the Respondent has used 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 in terms of paragraph 3(a)(ii) of the Policy. For its part, the Respondent contends that the Domain Name is generic or descriptive and the Respondent is making fair use of it, a submission in terms of paragraph 4(a)(ii) of the Policy.

#### **Paragraph 4(a)(ii)**

The Expert agrees with the Respondent that the term "The Defib Shop" may be considered to be descriptive although the Expert would not perhaps see this as quite as descriptive as the Respondent, given the use of the abbreviation "Defib". That said, the Expert agrees that the term might describe a shop which offers defibrillators for sale and accepts the Respondent's submissions that there are at least three other users of the term "Defib" in an online context, namely (1) as "defibs" in a URL; (2) as <thedefibcentre.co.uk> and (3) as <defibfinder.co.uk>. The Expert notes that the subject of generic or descriptive terms is addressed in paragraph 4.9 of the Expert's Overview as follows:

"4.9 Can use of a purely generic or descriptive term be abusive?"

Yes but, depending on the facts, the threshold level of evidence needed to establish that this is the case is likely to be much higher. It may well often depend upon the extent to which such a term has acquired a secondary meaning, which increases the likelihood that any registration was made with knowledge of the rights that existed in the term in question. In many such cases where there is little or no evidence of acquired secondary meaning the Respondent is likely to be able to show that the domain name in question has been arrived at independently and accordingly cannot have been as a result of an Abusive Registration. A helpful discussion is found in DRS 04884 (maestro.co.uk) where the Appeal Panel observed "Where a domain name is

a single ordinary English word, the meaning of which has not been displaced by an overwhelming secondary meaning, the evidence of abuse will have to be very persuasive, if it is to be held to be an Abusive Registration under the DRS Policy".

The key elements which the Expert draws from this passage for the present case are (1) a domain name consisting of a generic or descriptive term may be an Abusive Registration if the complainant proves that the registration was made with knowledge of the complainant's rights in that term; (2) if a respondent can show that a domain name was arrived at independently it cannot have been as the result of an Abusive Registration, albeit that a domain name could still subsequently become an Abusive Registration through the manner of its use; (3) where there is evidence of acquired secondary meaning the respondent is less likely to be able to show that it arrived at the domain name independently.

*Direct to You Online Ltd v. Void Design* (DRS10134) provides an example of a case under the Policy involving similar generic or descriptive domain names where the expert was required to consider the question of the respondent's knowledge of complainant rights. In that case, the disputed domain names were <bathroomlightingcentre.co.uk> and <outdoorlightingcentre.co.uk>, in other words, names describing the business of retailing bathroom and outdoor lighting. The respondent's business comprised the operation of websites acting as a portal through to third party websites where products could be purchased. In furtherance of that operation, the respondent had registered a range of generic or descriptive domain names, including the disputed domain names. The complainant traded in lighting under the names Outdoor Lighting Centre and Bathroom Lighting Centre, using the domain names <outdoor-lighting-centre.co.uk> and <bathroom-lighting-centre.co.uk>. The respondent denied knowledge of the complainant, its business or its domain names and in particular noted that the complainant's domain names were an unusual variation from the norm, being hyphenated, such that the respondent had not noticed these during the registration process of the disputed domain names. The expert found that the disputed domain names were part of a pattern of descriptive domain names registered by the respondent at or about the same time and that, given the very limited extent of the complainant's goodwill, the complainant had not established on the balance of probabilities that the respondent had knowledge of the complainant and/or its rights at the time of registration of the disputed domain names. Accordingly, the expert did not find that the disputed domain names constituted an Abusive Registration under paragraph 1(i) of the Policy.

In the present case, the Expert is faced with an arguably descriptive domain name, albeit perhaps not of quite the same order of descriptiveness as 'bathroom lighting centre'; however in any event the facts are very different from those in *Direct to You, supra*. The parties in that case were not competitors. Here, the Parties are in competition with one another in a very

niche market, indeed, one might say a 'niche within a niche', in that they are not only both engaged in healthcare trades but specifically are both suppliers of first aid equipment within the healthcare marketplace. Indeed, the Parties are not only in competition, they are in close geographic proximity to one another in the north of England, in that the Complainant is based in Manchester while Crest has premises in Warrington. The evidence demonstrates that the Complainant has been trading as "Defib Shop" in this marketplace since March 2006. No evidence has been provided that the Domain Name is part of a pattern of descriptive domain names registered at about the same time as the Domain Name.

The Minutes of the First Aid and Medical Equipment Section of the British Healthcare Trades Association ("BHTA") produced by the Complainant further illustrate the Parties' close connections. The meeting described in the Minutes was held at Crest's premises in Warrington on 6 October 2011. David Howarth of the Complainant was in attendance, described as representing "Imperative Training/Defibshop", and the Respondent was the chair of the meeting. The Expert notes however that these Minutes post-date the registration of the Domain Name. The Complainant has not provided the Expert with the date or dates on which the Parties began their mutual involvement with the BHTA. Had such involvement pre-dated the registration of the Domain Name this would likely have demonstrated on its own that the Respondent had knowledge of the Complainant prior to the date of registration of the Domain Name. Nevertheless, and in the absence of such evidence, the Expert is prepared to regard the Parties' membership of the same trade association, and their recent shared contributions to the same section within that association, as a matter which reinforces the fact that the marketplace which the Parties occupy is relatively tight-knit.

The Complainant also alleges, both in the solicitors' correspondence and in the background document which it supplied with the Complaint, that Crest took an image from the Complainant's website and used this on the website associated with the Domain Name. The Complainant says that the image was taken by a photographer which the Complainant had engaged. The Respondent does not address this issue in detail in the Response, noting simply that the matter had been dealt with by Crest's solicitor. The relative passage in Crest's solicitor's letter of 7 April 2011 is as follows:-

"So far as the photograph to which you refer is concerned our client's understanding was that the image was a manufacturer's product image, which our client had permission to use. We note that you have not identified how it is alleged that copyright in the photograph is alleged to vest in your client. In any event, in order to avoid any possible argument in this respect, our client has already taken steps to change the image which it uses. If (which is not admitted) your client did have copyright, then our client apologises."

The Expert sees this passage as worded particularly carefully. Contrary to what the Complainant says in its background document, neither the Respondent nor Crest's solicitors state that the Respondent obtained the image from the manufacturer. Crest's solicitors merely state that Crest understood it to be a manufacturer's product image, which they had permission to use. The solicitors do not actually specify from what source the Respondent obtained the image. It is not entirely unreasonable to infer that it may indeed have come from the Complainant's website. Certainly, the Respondent does not deny this either via Crest's solicitor's correspondence or in the Response, despite the Complainant's clear averment to this effect.

It is not the function of the Expert under the Policy to make any finding regarding copyright infringement or indeed for that matter trade mark infringement, both of which are discussed in the solicitors' correspondence and, to a lesser extent, in the Parties' submissions in the present case. What is relevant to the Decision is whether the incident regarding the image may be a factor which indicates that the Respondent had knowledge of the Complainant's Rights and was targeting these when it registered the Domain Name. On that question, the Expert regards the proximity of the solicitors' correspondence to the date of registration of the Domain Name as significant. The Domain Name had been registered on 2 February 2011 and the Complainant's solicitors' letter to the Respondent is dated 24 March 2011. In other words, it is recorded in the correspondence that within 60 days of having registered the Domain Name the Respondent is using an image on the website associated therewith which the Complainant says was taken from the Complainant's website. When Crest's solicitors reply to this allegation on 7 April 2011 they provide what appears to the Expert to be a carefully worded and guarded explanation.

The Expert considers that it is reasonable to infer from the facts and circumstances outlined above, taken as a whole, that the Respondent did have actual knowledge of the Complainant. While a respondent does not require to prove anything in proceedings under the Policy, it being the Complainant's job to satisfy the Expert as to Rights and Abusive Registration on the balance of probabilities, the Expert is nevertheless fortified in the above conclusion by the fact that at no point, whether in the solicitor correspondence or the Response, does the Respondent deny an awareness of the Complainant and/or its Rights when it registered the Domain Name.

While not in itself conclusive of the position, it is unusual in a case such as this for there to be no denial from the Respondent, particularly where the Respondent seeks to rely on paragraph 4(a)(ii) of the Policy. By contrast, such denials may be found in the case of *Direct to You, supra*, and in the decision of the Appeal Panels in *Wise Insurance Services Limited v Tagnames Limited* (DRS04889) and *Maestro International, Inc v Mark Adams* (DRS04884) in each of which the respective respondent was arguing that it registered the disputed domain name independently of the complainant and its rights.



*Maestro, supra*, indicates that proving a respondent's knowledge of a complainant's Rights may only get a complainant part of the way. The Appeal Panel in that case added: "When the trade mark in question is a dictionary word, there has to be something more than knowledge of the trade mark to justify a finding of Abusive Registration. Were it otherwise, owners of trade marks which are dictionary words would effectively be able to monopolise the use of such words for domain names." In this case, while the Expert is not dealing with a dictionary word, the case nevertheless involves an alleged descriptive use and indeed the suggestion from the Respondent is that the Complainant is seeking to monopolise the term, such that the position is similar. The Expert considers that there are several facts and circumstances outlined in this case which could each be described as "something more". There is the fact that the Parties are competitors and are geographically proximate. There is the relatively niche marketplace in which the Parties operate. There is the use of an image on the Respondent's website shortly after the registration of the Domain Name which appears to have been sourced from the Complainant's website. There is the lack of any denial of knowledge of the Complainant and/or of the Complainant's Rights on the part of the Respondent, and in any event, had there been any such denial of knowledge this would most probably not have been particularly credible. There is the fact that as noted above the Expert considers on the balance of probabilities that the Complainant's mark "defibshop" has acquired a secondary meaning such that it is associated with the Complainant's goods and services in the minds of the relevant consumers. In all of these circumstances, while the Domain Name may appear at first sight to be generic or descriptive, the Expert considers that the Respondent is not making fair use of it within the meaning of paragraph 4(a)(ii) of the Policy.

### **Paragraph 3(a)(i)(C)**

Turning therefore to the question of 3(a)(i)(C) of the Policy, the Expert does not accept the Complainant's contention that the Domain Name was registered primarily for the purpose of disrupting the business of the Complainant. The Expert accepts that the *de facto* effect of the registration and use of the Domain Name may have been to disrupt the Complainant's business but does not find there to be any evidence that this was necessarily the Respondent's primary purpose.

### **Paragraph 3(a)(ii)**

Finally, the Expert must consider the Complainant's contention that the Respondent has used 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 in terms of paragraph 3(a)(ii) of the Policy. The Complainant has produced evidence of a single instance of actual confusion, namely the purchase order from Holy Cross Hospital addressed to Crest in Warrington

however bearing the Complainant's fax number. The Complainant notes four separate instances within this document of possible confusion.

The Respondent seeks to cast doubt on the authenticity of the purchase order by suggesting that, given it contains Crest's address, it should have been passed back to Crest. The Respondent also suggests that the purchase order may have been designed by the Complainant to support its claim. This latter allegation is very serious, suggesting either deliberate falsification of the document produced or some manipulation thereof. The Expert has no such reason to doubt the authenticity of the document and indeed there is no evidence to indicate that the Complainant had any significant part in the document's creation. There is merely the unsupported allegation of the Respondent to this effect. The Expert considers that if the Respondent genuinely believed that the document was not authentic it would have been a relatively simple matter for the Respondent to request the issuing body whose details are on the face of the document, and whose Chief Executive's signature bears to be applied thereto, to confirm that it was genuine or equally to carry out any other investigations regarding how the purchase order came to be created. Notably, the Respondent does not take issue with the various factors listed by the Complainant as illustrative of the extent to which the customer was confused.

With regard to the Respondent's comment that the purchase order should have been passed back to Crest, rather than to the Complainant, the Expert considers that there is an entirely plausible reason why this did not happen even though the document bears to have been issued to Crest and contains its name and address. The purchase order states "please fax order to [the Complainant's fax number]". It seems likely therefore that the order initially reached the Complainant by fax and was never issued to the postal address of the Respondent. While the example before the Expert does not appear to be a fax copy, it is not unreasonable to infer that the Complainant asked its customer for the principal copy to be forwarded to it for the purposes of filing this along with the Complaint. Accordingly, the Expert does not believe that the fact that the Complainant received this purchase order rather than the Respondent is any indication either that the document is not authentic or is in some way contrived by the Complainant. In the circumstances, the Expert finds that the Respondent has used the Domain Name in a way which has confused a business into believing that the Domain Name is registered to, operated or authorised by, or otherwise connected with the Complainant.

The Respondent notes that the instance of actual confusion is an isolated incident. However, as was stated by the Appeal Panel in *Seiko UK Limited v. Designer Time/Wanderweb* (DRS 00248), even a small number of instances of confusion may merely be the "tip of the iceberg" and should not be rejected out of hand. That said, even if the present example of confusion were discounted or accorded little weight on the basis that it is a single incident, the Expert must also consider the likelihood of confusion in terms of paragraph 3(a)(ii) of the Policy. The Expert notes that the expert in *Direct to*

*You, supra*, determined that the complainant in that case had limited trading goodwill in its trading names and consequently decided that the likelihood of confusion would be low. By contrast, the Expert in the present case considers that the likelihood of confusion here is significant, given the similarity of the Domain Name to the Complainant's trade mark, the extent of the Complainant's customer base, the Complainant's length of trading under its trade mark and trading name, and the niche market in which the Parties operate.

The Respondent notes that it has very different branding from the Complainant on its website such that the risk of confusion will be minimised. However, no matter how different that content may appear, the Expert considers that there remains the potential for initial interest confusion. There is a substantial risk, given the similarity of the Domain Name to the Complainant's mark and trading style, that Internet users may visit the Respondent's site in response to a search engine request when they are seeking the site of the Complainant. As paragraph 3.3 of the Expert Overview has it, the vice in the case of initial interest confusion is that even if it is immediately apparent to the visitor to the website that the site is not in any way connected with the Complainant, the visitor has been deceived. Having drawn the visitor in, the visitor is faced with a commercial web site, which advertises goods similar to those offered by the Complainant.

## **Conclusion**

The Expert has found on the balance of probabilities that at the time of registration of the Domain Name the Respondent registered the same with knowledge of the Complainant's Rights rather than having independently selected a generic or descriptive term for the purposes of making fair use thereof, and that the Respondent is not making fair use of the Domain Name. Furthermore, the Expert finds that there are circumstances indicating that the Respondent is using the Domain Name in a way which is likely to confuse people or businesses into believing that the Domain Name is registered to, operated or authorised by, or otherwise connected to the Complainant.

The Expert finds that the Domain Name was registered in a manner which, at the time when the registration took place, took unfair advantage of the Complainant's Rights and has been used in a manner which has been unfairly detrimental to those Rights. Accordingly the Expert finds that the Domain Name, in the hands of the Respondent, is an Abusive Registration.

## **7. Decision**

The Expert finds that the Complainant has proved that it has Rights in a name or mark which is similar to the Domain Name and that the Domain Name, in

the hands of the Respondent, is an Abusive Registration. The Expert therefore directs that the Domain Name be transferred to the Complainant.

**Signed** .....  
Andrew D S Lothian

**Dated** 19 September, 2012  
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