

DISPUTE RESOLUTION SERVICE

DRS12038

Decision of Independent Expert

International Travel Connections Ltd

and

Mr Paul Abbott

1. The Parties:

Lead Complainant: International Travel Connections Ltd
Concorde House
Canal St
Chester
Cheshire
CH1 4EJ
United Kingdom

Respondent: Mr Paul Abbott
Nimax House
20 Ullswater Crescent
Coulston
Surrey
CR5 2HR
United Kingdom

2. The Domain Name(s):

horseracingabroad.co.uk

3. Procedural History:

19 October 2012 17:46 Dispute received
22 October 2012 11:27 Complaint validated
22 October 2012 12:03 Notification of complaint sent to parties
08 November 2012 01:30 Response reminder sent
09 November 2012 10:36 Response received
09 November 2012 10:36 Notification of response sent to parties
12 November 2012 12:19 Reply received
19 November 2012 09:24 Notification of reply sent to parties
19 November 2012 09:24 Mediator appointed
23 November 2012 11:41 Mediation started
20 December 2012 16:54 Mediation failed
20 December 2012 17:30 Close of mediation documents sent
27 December 2012 11:56 Expert decision payment received

4. Factual Background

The Lead Complainant is a luxury tour operator. It has won a number of awards including “Favourite Tour Operator of the Year Award 2011”. One of the names under which it trades is Horse Racing Abroad which is used in connection with a specialist travel agency offering horse racing holidays. It operates a website at www.horseracingabroad.com. The Complainant acquired the Horse Racing Abroad business in 2008 from Hayward Travel Limited. The Complainant states that the history of the Horse Racing Abroad name by the Complainant’s predecessors in title can be traced back to 1975 (although there is no supporting evidence for this statement). The horseracingabroad.com domain name was registered in 2002. Horse Racing Abroad Limited is also an incorporated company registered in 1995 and apparently owned by the Complainant.

The Respondent was incorporated in 2007 and provides luxury horse racing trips to various overseas destinations. It operates a website at www.luxuryleisureventures.co.uk and has done so since 2007. The Respondent acquired the Domain Name from a domain name company in January 2012 and has subsequently used the Domain Name to link to the Respondent’s main website. This use is the subject of the Complaint in this matter.

The Complainant’s solicitors wrote to the Respondent on 7 September 2012 complaining about its use of the Domain Name and requiring it to stop using the Domain Name in connection with the redirection of traffic to the Respondent’s main website. It appears that no reply to the Complainant’s satisfaction was received. A copy of this letter has been attached to the Response.

5. Parties’ Contentions

Rights

The Complainant

The Complainant asserts Rights in the Horse Racing Abroad name. It claims that substantial goodwill and reputation has been built up over the period of time in which the name has been used by the Respondent and its predecessors in title such that the name has come to be associated with the services offered by the Complainant.

In support of this assertion, the Complainant has produced screenshots of Google search results. The first screenshot shows the results of an (undated) Google search for "horse racing abroad". On the screenshot provided (which is for page 1 only) no results for the Respondent are shown. The three search results that are shown relate to the Complainant. The second screenshot (also undated) is for a search of "www.horseracing.co.uk" which features the Respondent's web address as the first site shown but thereafter it lists results that are linked to the Complainant. The Complainant asserts that the results of these searches demonstrate that the brand value of the "Horse Racing Abroad" mark lies with the Complainant.

The Respondent

The Respondent disputes that "Horse Racing Abroad" has brand significance. It asserts that the phrase is generic. It points out that there are various websites operating under a domain name containing "horseracing" which are not connected to either party in this matter (for example horseracingaustralia.com).

Abusive Registration

The Complainant

The Complainant submits that the redirection of traffic for the Domain Name to the Respondent's website is causing confusion and a loss of business. The Parties are in competition with each other and offer very similar services. The Respondent is therefore benefitting from "click throughs" that were meant for the Complainant's website.

It attaches a screenshot of the Respondent's website at www.luxuryleisureventures.co.uk reached by clicking on the Domain Name and asserts that the Respondent is selling Horse Racing Abroad product from clicks generated by the goodwill in the brand.

The Respondent

The Respondent submits that it acquired the Domain Name as part of a strategy of using generic domain names (e.g. horseracingfrance.co.uk) to redirect traffic to its website from general search enquiries made by people who are interested in horse racing overseas. For the Respondent, these are normal search terms based on people's general expectations. There was no deliberate strategy to redirect traffic from the Complainant's website. The Domain Name is not actively promoted or marketed by the Respondent.

The Respondent disputes that its use of such a generic term has resulted in loss of business to the Complainant. The holidays offered by the Parties are not similar. The Respondent operates at the top of the market while the Complainant's product is aimed at the mass market. The Respondent uses its website as a shop window to the trips it offers but takes few bookings over the Internet. The majority of its bookings are obtained through word of mouth and referrals. The volume of hits on the Respondent's website does not suggest that it is actively trying to divert business from the Complainant (no further detail is provided to support this assertion).

In the Reply, the Complainant disputes that there is no similarity in holidays offered by the respective parties. It claims that the Respondent's tours are either comparable or of lower quality than those it offers. The screenshot of the Respondent's website attached to the Complaint lists the Respondent's tours for 2013 and these show that the Respondent gets about half of its business from tours that it has in common with the Complainant.

Other

There is reference to an approach being made to the Complainant to sell the Domain Name in the "late 1990's". At that time the Complainant did not choose to purchase it. The date of this supposed offer is confusing but no connection to the Respondent has been shown and the alleged offer of sale will therefore be disregarded in this Decision.

6. Discussions and Findings

Under Paragraph 2 of the Nominet Dispute Resolution Service Policy (the Policy) In order for the Complainant to succeed it must establish on the balance of probabilities, both:

that it has Rights in respect of a name or mark which is identical or similar to the Domain Name, and

that the Domain Name, in the hands of the Respondent, is an Abusive Registration as defined in Paragraph 1 of the Policy.

Rights are defined in Paragraph 1 of the Policy as follows;

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

If the Complainant satisfies the Expert on the balance of probabilities that it has relevant rights, the Expert must consider whether the registration and/or use of the Domain Name by the Respondent are abusive.

An Abusive Registration is defined in Paragraph 1 of the Policy as follows:

"Abusive Registration means a Domain Name which either:

- i. was registered or otherwise acquired in a manner which, at the time, when the registration or acquisition took place, took unfair advantage of or was unfairly detrimental to the Complainant's Rights; or*
- ii. has been used in a manner which took unfair advantage of or was unfairly detrimental to the Complainant's Rights".*

Rights

There are no trade mark registrations for the Horse Racing Abroad mark which means that the existence of the Complainant's Rights turns on whether the Complainant has unregistered Rights in any goodwill that may have been generated through the use of the name in the course of trade.

Clearly on its face, "horse racing abroad" is a descriptive term. It refers to a type of activity (horse racing holidays that take place abroad). The name is not therefore inherently distinctive of a particular business or point of origin. A descriptive name can however acquire brand significance which links it to a particular business or its products if it has been used in a way that has become distinctive. The acquisition of brand significance through use is known as a secondary meaning. To demonstrate a secondary meaning, the Complainant must show that the name Horse Racing Abroad has come to be associated with its products and that this has displaced the descriptive nature of the phrase. Under Paragraph 2 of the Policy the Complainant must show this on the balance of probabilities.

Nominet has published a document called "Experts' Overview" which provides guidance to Complainants. In relation to unregistered Rights, the overview states as follows:

"If the right is an unregistered trade mark right, evidence needs to be put before the Expert to demonstrate the existence of the right. This will ordinarily include evidence to show that (a) the Complainant has used the name or mark in question for a not insignificant period and to a not insignificant degree (e.g. by way of sales figures, company accounts etc.) and (b) the name or mark in question is recognised by the purchasing trade/public as indicating the goods or services of the Complainant (e.g. by way of advertisements and advertising and promotional expenditure, correspondence/orders/invoices from third parties and third party editorial matter such as press cuttings and search engine results).

In the Complainant's favour is the length of time that the name has been used by the Complainant (since 2008) and seemingly before then by its predecessors in title (since 1975). (It must however be noted that it is not clear that there is an unbroken chain of title to the name dating back to 1975.) However leaving aside uncertainty about exactly how long the name has been used, length of use on its own is not sufficient to show a secondary meaning. A descriptive term may be used in a descriptive way for many years without acquiring distinctiveness. What is also needed is evidence that the name is recognised by customers or potential customers as indicating the Complainant specifically and the holidays it offers.

The Expert is referred to the Complainant's website at www.horseracingabroad.com. The text of the website refers to "Horse Racing Abroad" as a distinct business and features a logo consisting of imagery in conjunction with the Horse Racing Abroad name. The website is evidence of how the Complainant is using the name but it is not evidence of how the name is perceived by customers or third parties. There are references in the Reply to "business growing very nicely" and to "good money" being spent year on marketing the name but no details are provided. There is no evidence about how long the Complainant has used this trading style, no sales figures and no information about advertising and promotional expenditure. Such evidence is particularly needed here. The horse racing abroad name has such a strong descriptive quality that compelling information is required to prove that it has acquired distinctiveness.

The Complainant mainly supports its case on distinctiveness with the results of searches carried out through the Google search engine which, it states, shows that the Horse Racing Abroad name functions as a brand associated with the Complainant's business. The Expert finds that the search results, in isolation, do not demonstrate this. The results are supportive of the fact that the Complainant and its associated websites are linked to the key words "horse racing abroad" but this does not in itself demonstrate that the key words are recognised by the public as a brand linked specifically to the Complainant's products. The Expert agrees with the Respondent that a customer searching for an overseas racing holiday could easily type in the general search term "horse racing abroad" without intending to reach the Complainant. There could therefore be other reasons why the Google searches rank the Complainant first which do not equate to brand significance in a secondary meaning sense.

For completeness, the registration of the horseracingabroad.com domain name and company name do not confer Rights under the Policy. Such registrations are obtained on a "first come, first served" basis without an assessment of entitlement to rights in the name.

No other information is before the Expert on this matter.

Having reviewed the Complainant's materials the Expert is of the view that the Complainant has not established its case on Rights on the balance of probabilities. The evidence before the Expert does not demonstrate that the descriptive nature of the Horse Racing Abroad has been displaced so that the name has come to be a

mark associated in the minds of customers/potential customers with the Complainant or its products.

The first criterion under the Policy has not been demonstrated.

Abusive Registration

Abusive Registration under the Policy is linked to taking unfair advantage of or causing unfair detriment to the Complainant's Rights. Because the Expert has found that the Complainant does not have Rights under the Policy it follows that the use of the Domain Name does not amount to an Abusive Registration in the hands of the Respondent.

For completeness, the Expert agrees with the Complainant that the Parties are in direct competition with each other in terms of product. Had the Complainant been able to demonstrate that "horseracing abroad" had acquired a secondary meaning which differentiated the Complainant's holidays from those offered by its competitors, it is possible that the Respondent's use would have contravened the Policy.

7. Decision

No action to be taken.

Signed Sallie Spilsbury

Dated 22 January 2013