

**DISPUTE RESOLUTION SERVICE**

**D00012066 and D00012142**

**Decision of Independent Expert**

GDC Group Limited

and

GasFire.co.uk Ltd

**1. The Parties:**

Lead Complainant: GDC Group Limited  
Millbrook House  
Grange Drive  
Hedge End  
Southampton  
SO30 2DF  
United Kingdom

Respondent: GasFire.co.uk Ltd  
Fires and Fireplaces  
Units 21-22  
Whitehill Industrial Estate  
Whitehill Lane  
Swindon  
Wiltshire  
SN4 7DB  
United Kingdom

**2. The Domain Names:**

valordirect.co.uk  
valorfires.co.uk  
valorfire.co.uk

### 3. Procedural History:

Until recently, the domain name <valorfire.co.uk> was registered in the name Net Directory Limited and was controlled by the Respondent. It is now registered in the name of the Respondent. These two complaints were commenced separately but because the parties are the same, the complaints are considered together in this decision.

I confirm that I am independent of each of the parties. To the best of my knowledge and belief, there are no facts or circumstances, past or present, or that could arise in the foreseeable future, that need be disclosed as they might be of such a nature as to call into question my independence in the eyes of one or both of the parties.

#### **Dispute D00012066** (valordirect.co.uk and valorfires.co.uk)

30 October 2012 15:32 Dispute received  
01 November 2012 12:19 Dispute closed  
08 November 2012 10:02 Dispute opened  
08 November 2012 10:04 Complaint validated  
08 November 2012 11:33 Notification of complaint sent to parties  
27 November 2012 01:30 Response reminder sent  
30 November 2012 08:43 Response received  
30 November 2012 08:43 Notification of response sent to parties  
05 December 2012 01:30 Reply reminder sent  
10 December 2012 15:31 Reply received  
10 December 2012 15:34 Notification of reply sent to parties  
10 December 2012 15:34 Mediator appointed  
13 December 2012 11:10 Mediation started  
01 March 2013 11:00 Dispute suspended  
17 May 2013 15:02 Dispute opened  
17 May 2013 15:02 Mediation failed  
23 May 2013 16:35 Close of mediation documents sent  
05 June 2013 02:30 Complainant full fee reminder sent  
11 June 2013 02:30 Complainant full fee reminder sent  
14 June 2013 10:20 Expert decision payment received  
19 June 2013 13:08 Sent expert decision pack, expert appointment and conflict check documents

#### **Dispute D00012142** (valorfire.co.uk)

12 November 2012 11:44 Dispute received  
13 November 2012 10:25 Complaint validated  
13 November 2012 10:30 Notification of complaint sent to parties  
30 November 2012 01:30 Response reminder sent  
05 December 2012 08:04 No Response Received  
05 December 2012 08:05 Notification of no response sent to parties  
06 December 2012 14:18 Response received  
06 December 2012 14:25 Notification of response sent to parties  
10 December 2012 15:30 Reply received.  
10 December 2012 15:34 Notification of reply sent to parties

13 December 2012 11:10 Mediator appointed  
13 December 2012 11:11 Mediation started  
01 March 2013 11:00 Dispute suspended  
17 May 2013 15:02 Dispute opened  
17 May 2013 15:02 Mediation failed  
23 May 2013 16:42 Close of mediation documents sent  
05 June 2013 02:30 Complainant full fee reminder sent  
11 June 2013 02:30 Complainant full fee reminder sent  
14 June 2013 10:20 Expert decision payment received  
19 June 2013 13:09 Sent expert decision pack, expert appointment and conflict check documents.

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

The trade mark VALOR has been used in the UK in relation to domestic heating (and particularly gas fires) since 1890. It has been registered in the UK in various classes, Nos. 484544 (in 1928), 819103 (in 1961), 181101 (in 1962) and 1003362 (in 1973). In 2006 it was registered as a Community trade mark, No. 4568663.

On September 30, 2011 the Complainant purchased all rights in relation to the VALOR trade mark from Valor Limited. Prior to the sale, Mr. Richard Beaman was the Head of Sales of Valor Fires, which I take to be a trading name of Valor Limited. After the sale, Mr. Beaman became Commercial Director of the Complainant.

The Complainant sells VALOR branded products to merchants, who in turn supply installers, contractors and social housing organisations; and to distributors and retailers, who in turn supply consumers. The Complainant's website is at [www.valor.co.uk](http://www.valor.co.uk).

The Respondent sells gas and electrical fire place units to the general public. For the last 10 years, i.e. starting prior to the Complainant's acquisition of Valor Limited, the Respondent has bought VALOR products, initially from Valor Limited and subsequently from the Complainant, and sold them from its premises in Wiltshire and, since April 2007, online.

The Respondent's online sales have been made via the website [www.gasfire.co.uk](http://www.gasfire.co.uk) and at websites reached via the Domain Names <valorfires.co.uk>, registered on March 25, 2000; <valorfire.co.uk>, registered on January 16, 2007; and <valordirect.co.uk>, registered on September 6, 2011.

On August 4, 2011, Mr. Beaman, then Head of Sales and Marketing of Valor Fires, responded to a complaint about the Respondent's [www.valorfire.co.uk](http://www.valorfire.co.uk) website which read: "They [the Respondent] even look as if they are your website, which I assume they are not. They want the public to believe that they are dealing directly with Valor". Mr. Beaman replied: "I am aware of them and i do track their activity. I have also taken legal advice about their website and how it could potentially confuse customers. Unless they are blatantly trying to pass themselves off as Valor, there isn't a lot i can do – They have even created their own images of our

fires. I do recognise the issues it causes and other retailers are equally as vocal as you.”

On August 9, 2012, Mr. Beaman, then Commercial Director of the Complainant, emailed the Respondent as follows:

“The perennial issue of websites has cropped up, as yet again I’m receiving complaints from retailers who think your <http://valordirect.co.uk/> and <http://www.valorfire.co.uk/> websites belong to Valor.

Many retailers think we are selling directly to end users and likewise our Distributors think we are trading directly with retailers, which is blatantly not the case.

I am very concerned that your websites look very similar to ours and mirrors the look of our brochures and Valor Centre logo.

I don’t have an issue with you trading on the internet, but I must request that you make changes to your websites to distance the look from Valor and make it more visible that you are an independent retailer.”

In an exchange of emails next day Mr. Kevin Law, on behalf of the Respondent, offered to change the colours, asked what colours the Complainant would prefer and suggested the Complainant bear the cost. Mr. Beaman replied that any changes would be at the Respondent’s cost. Mr. Law offered to sell the two domain names at a price to be agreed. On August 17, 2012, the Respondent, through its lawyers, offered to transfer the <valordirect.co.uk> domain name to the Complainant at the Complainant’s cost, and on August 24, 2012, the Complainant, through its lawyers, agreed to pay the £10 transfer fee.

The Domain Names presently remain with the Respondent.

## **5. Parties’ Contentions**

### **Complainant**

The Domain Names contain the word VALOR which is identical to the marks in which the Complainant has established registered rights. The Domain Names host websites which seek to sell VALOR products. They are not used to sell anything other than VALOR branded products.

The Complainant understands that the Respondent runs the Domain Names purely as online businesses and that none of them relate to the Respondent’s physical showrooms. Also, that the <valordirect.co.uk> domain is used by the Respondent in an attempt to sell VALOR products as a distributor, which it is not entitled to do.

The Complainant did not become aware of the <valordirect.co.uk> domain name until August 2012. It became aware of the Respondent’s registration and use of <valorfires.co.uk> and <valorfire.co.uk> in around August 2011. On 9 August 2012, when the Complainant asked that the style and colours of the websites be changed, the Complainant was receiving weekly complaints from both retailers

and distributors that the domain names <valorfires.co.uk> and <valordirect.co.uk> were causing great confusion for them and the general public.

The Respondent's registration and continued use of the Domain Names is abusive because online users have been and will continue to be confused into believing that the Domain Names are registered to, owned, operated or authorised by, or otherwise connected to the Complainant, when this is not the case. This is unavoidable due to the fact that the Domain Names contain the name 'VALOR' which is identical to the Mark.

Further, the design and 'get-up' of the websites operated from the Domain Names are confusingly similar to the Complainant's own website:

- a) although recently a short and very well hidden disclaimer has been included on the <valorfire.co.uk> website's homepage stating that it is not affiliated with the Complainant, the websites at the other two domains do not contain such disclaimers;
- b) all three websites have a history of the Complainant at the bottom of the main homepage. This history is worded in such a way that it does not make clear that those sites are not affiliated with the Complainant;
- c) throughout the websites there is almost no reference to the Respondent or indeed the true ownership and management of the Domain Names;

The Respondent's registration of the <valorfire.co.uk> and <valorfires.co.uk> domain names was or could reasonably have been interpreted to have been a strategy to instigate the transfer of the domains to the Complainant for valuable consideration in so far as the domain names themselves as well as the websites associated with them do, will or have the potential to cause confusion as to their relationship with the Complainant.

The <valorfire.co.uk> and <valorfires.co.uk> domain names and their associated websites give the Respondent an unfair advantage over other retailers of the Complainant's products in so far as they purport to be affiliated with the Complainant. The Complainant does not sell to consumers (unlike the Respondent), therefore, by creating the impression of an affiliation with the Complainant and the marks, the Respondent gains an unfair advantage in the marketplace over other retailers of the Complainant's products who rely on their own goodwill and reputation.

The Respondent's use of the Domain Names has caused damage to the Complainant in the following ways:

- a) The Respondent's use of the marks and goodwill means that the Complainant is no longer in control of its own intellectual property and the goodwill associated with the marks. The Complainant has a right to manage its intellectual property and the goodwill that it has invested in developing. The Respondent's use of the marks or goodwill has the potential to devalue and/or tarnish the Complainant's brand and reputation.

- b) The Respondent's use of the Domain Names has caused confusion in the minds of consumers and retailers to whom the Complainant supplies its products. Specifically this has resulted in disputes arising between the Complainant and retailers who have been confused into believing that the Domain Names are affiliated with the Complainant. This has and continues to tarnish the Complainant's previously exceptional reputation.

The Respondent has never been known as Valorfire, Valorfires or Valordirect prior to the registration of the Domain Names.

The Domain Names are not descriptive or generic such that the Respondent is making fair use of them. The marks themselves evidence the fact that the Domain Names are not generic.

No agreement has ever been reached between the Complainant and the Respondent to allow the Respondent use of the Domain Names.

For all the reasons set out above the Respondent has registered and used the Domain Names in a manner which takes unfair advantage of and is unfairly detrimental to the Complainant's rights. In view of this and the fact that the Respondent has already agreed to transfer <valordirect.co.uk> but failed to do so the Complainant submits that the Domain Names ought to be transferred to the Complainant.

### **Respondent**

The Complainant has failed to raise any substantial points or issues which should require transfer to it of the Domain Names. By contrast, the Respondent has fairly operated its business from the Domain Names for a considerable period of time. Its usage of them was at all times known by Valor Limited and with its express agreement. The websites at each of the Domain Names contain clear disclaimers indicating to all users that they are not associated with the Complainant and do not present any form of confusion to such users which would suggest otherwise.

The Respondent is selling only officially licensed Valor products purchased directly from the Complainant. The Complainant presents no evidence that its goodwill and reputation are being affected by the use of the Domain Names, only the 'potential' for such. Any case that the Respondent is negatively impacting upon the Complainant's goodwill and reputation is for the civil courts. The Nominet Dispute Resolution Service is not the correct forum for such allegation and therefore this strand of the Complainant's argument is irrelevant.

At all times during the Respondent's dealings with Valor Limited and later the Complainant, it has been common knowledge that the Respondent was using the Domain Names to trade online. The establishment of a more active online presence by the Respondent in respect of its sale of VALOR products was known and actively encouraged by Valor Limited, which provided £10,000 to assist the Respondent in doing so, as evidenced by Invoice number 13431 dated 20 April 2010. Mr Richard Beaman was present at the meeting at which this proposal was presented to the Complainant's [*scil.* Valor Limited's] board of directors. He, and

therefore by association the Complainant, were fully aware of the Respondent's intended increased internet presence as a route to market.

The Complainant was aware of the Respondent's use of [www.valorfires.co.uk](http://www.valorfires.co.uk) and [www.valorfire.co.uk](http://www.valorfire.co.uk) in August 2011 prior to its purchase of Valor Limited. In an email dated 20 May 2011, Mr Beaman made reference to <valorfire.co.uk> and acknowledged this is used by the Respondent in its trading activities. In an email dated 29 June 2012, Mr Beaman demonstrated both clear knowledge of the domains <valorfire.co.uk> and <valorfires.co.uk> and that both represent direct accounts with the Complainant. On each occasion, Mr Beaman took no issue as to the use of these names, nor in respect of any of the other complaints now asserted.

The Respondent sold Valor products via the Domain Names for a considerable period of time without any complaint from Valor Limited and without any comment or complaint as to the Respondent's operation of the Domain Names causing any form of confusion to the public. This only appears to have become an issue since the [purchase] of Valor Limited by the Complainant. It is clear in the circumstances that Valor Limited wholly consented to the use of the Domain Names by the Respondent and therefore such consent cannot now be questioned in the absence of proper grounds to do so.

In any event, it is clear that the Complainant has been wholly aware of the registration of the Domain Names by the Respondent and their usage of the same in the course of their business and as a route to market. No umbrage has been taken by the Complainant up until this point in respect of the ownership and usage of the Domain Names by the Respondent.

The Respondent's offer in August, 2012 to the Complainant of the option to purchase the Domain Names for fair consideration cannot be construed as an admission that the Respondent was operating, using or otherwise dealing with the Domain Names in other than a fair and lawful manner.

The evidence presented by the Complainant in support of its assertion that confusion is being caused to other retailers is minimal when compared to the Complainant's 1500 retailers and customers. To present such a small sample of instances whereby some confusion is alleged, when compared with the vast size of the Complainant's overall client base, in no way establishes that confusion is being caused to the public. This has only been found by a small number of individuals who have not properly considered the content of each of the Domain Names which make clear there is no affiliation between the Complainant and Respondent.

The Respondent does not seek to create an impression that it is in any sense affiliated to the Complainant. The Respondent has taken active steps to distance itself from any such implied affiliation through the use of clear disclaimers that the websites are not owned or operated by the Complainant. They are immediately clear to any user of the website on the first page and are highlighted in an alternative colour scheme to ensure maximum possible attention. References are made throughout the website to the Respondent's status as an 'independent retailer'. The assertion that the Complainant 'understands' that

www.valordirect.co.uk is used to represent the Respondent as a distributor is unproven, unevidenced and confusing.

It is denied that the 'get up' of the websites operated from the Domain Names are confusingly similar to that of the Complainant or give rise to a passing off claim.

The Domain Names were fairly registered by the Respondent and have been used throughout their registration for the Respondent's business purposes. The suggestion that the Respondent's pure intention when registering the Domain Names was to obtain financial gain from the Complainant has not been made out.

The Respondent denies that the use of the Domain Names gives it any form of advantage over other retailers which could be considered unfair.

The Respondent denies that its use of the Domain Names has any impact upon the goodwill and reputation of the Complainant's rights in the name 'Valor'. The use of the Domain Names has the opposite impact by increasing access to the market place of the Complainant's products since the Complainant sells to independent suppliers, not to the general public.

### **Complainant's Reply**

Valor Limited never consented to the use by the Respondent of the Domain Names, nor did it actively encourage it. Valor Limited's board of directors met with the Respondent in 2010, not to discuss the Respondent's "online presence in relation to Valor products" but to discuss a business proposal from Independent Gas (UK) Limited for Valor Limited to invest £10,000 to produce a booklet of non-branded fires to be sent to gas installers.

The Complainant stands by its position that Richard Beaman, acting on behalf of Valor Limited, became aware of the <valorfires.co.uk> and <valorfire.co.uk> domains in 2011, although this might have been in May rather than August, as stated in the Complaint. It is irrelevant as to when the Respondent's use of the Domain Names came to the Complainant's attention, since neither it nor Valor Limited ever consented to or approved the Respondent's use.

The Complainant and Mr. Beaman had been receiving regular complaints about the Domain Names for a considerable time, including complaints made to Mr Beaman prior to Valor Limited being purchased by the Complainant. The number of complaints received significantly increased in July/August 2012 when the Respondent changed the getup of the websites at the Domain Names to incorporate a style that is confusingly similar in both style and colour to the Complainant's own website.

It is irrelevant and disingenuous for the Respondent to contend that the evidence of "confusion" is "minimal" and that confusion "has only been found by a small number of individuals who have not properly considered the content of each of the [Valor] Domains". The Complainant does not need to provide evidence of confusion, merely a likelihood that confusion will be caused. Confusion has in fact been caused and as such, the test in relation to likelihood has been satisfied.



By changing the getup used on the websites in or around July/August 2012, the Respondent made a conscious decision to use the Domain Names in such a way as to deliberately confuse people into believing that it is in some way connected and/or associated with the Complainant, when it is not. This confusion is having a detrimental effect on the Complainant, its goodwill and its reputation.

The Respondent is obtaining an unfair advantage over the Complainant's other customers in that, by using the Domain Names, it is trying to "ride on the coattails" of the Complainant's reputation and marks.

The <valorfire.co.uk> website disclaimer was highlighted by the Complainant and was not highlighted on the website. It is not immediately clear to any user. It remains at the very bottom of the first page, a user having to scroll down several times to locate it.

The <valorfires.co.uk> website did not contain a disclaimer at the time of the Complaint. The Respondent has since added, at the bottom of the first page of the website (again a user would have to scroll down to locate it), a disclaimer that states: "As stated valorfires.co.uk is an online retailer of Valor's products, we are independent, we are NOT part of the GDC Group we are Gasfire.co.uk Limited". The disclaimer however is not "immediately clear". Its inclusion on this website is an acknowledgement by the Respondent that the Domain Names are confusing.

The <valordirect.co.uk> website contents remain unchanged from the time of the Complaint. There is no disclaimer.

## **6. Discussions and Findings**

Under paragraph 2 of the Dispute Resolution Service Policy ("the Policy") the Complainant must show, on the balance of probabilities, that;

- (1) it has rights in respect of a name or mark which is identical or similar to each of the Domain Names; and
- (2) each of the Domain Names in the hands of the Respondent is an Abusive Registration.

"Rights" are defined in the Policy 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".

### Rights

The Complainant has exhibited registration certificates demonstrating that it has rights in the VALOR trade mark. Given that each of the Domain Names comprises the word "valor" followed by a purely descriptive term ("fire", "fires" and "direct"), I find that the VALOR mark is similar to each of the Domain Names. The Complainant has established this element.

### Abusive Registration

Abusive Registration is defined in the Policy as:

“...a domain name which either;

(i) was registered or otherwise acquired in the 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.”

Paragraph 3(a) of the Policy provides a non-exhaustive list of factors that may be evidence that a domain name is an Abusive Registration. The Complainant relies on the following provision:

3a ii Circumstances indicating that the Respondent is using or threatening to use the Domain Name in a way that 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.

Paragraph 4(a) of the Policy sets out a similar list of factors that may be evidence that a domain name is not an Abusive Registration. The Response calls for consideration of factor 4(a)(i)(A):

“Before being aware of the Complainant’s cause for complaint (not necessarily the ‘complaint’ under the DRS), the Respondent has used or made demonstrable preparations to use the Domain Name or a Domain Name which is similar to the Domain Name in connection with a genuine offering of goods or services.”

The Appeal Panel in DRS 04331 held that ‘intention’ is not a necessary ingredient for a complaint under paragraph 3(a)(ii) of the DRS Policy. The test is more objective than that. However, some knowledge of the complainant or its name/brand is a pre-requisite.

The facts of this case bear some similarity to those of DRS 0248 (seiko-shop.co.uk), in which, at first instance, the Expert said:

“Reduced to its critical elements, the decision in this case depends on whether or not the registration and use of a domain name, incorporating a supplier’s registered trade mark together with other non-distinctive characters, by a legitimate trader in that supplier’s goods, but without the approval of the supplier, takes unfair advantage of the Complainant supplier’s rights.”

...

“In BMW v. Deenik, which was not a domain name case, but which involved consideration of the right of a trade mark owner (BMW) to prevent informative use of its mark by a dealer, the [European] Court [of Justice] held that the proprietor of a trade mark was not entitled to prohibit a third party from using the

mark for such informative purposes *"unless the mark is used in a way that may create the impression that there is a commercial connection between the other undertaking and the trade mark proprietor, and in particular that the reseller's business is affiliated to the trade mark proprietor's distribution network or that there is a special relationship between the two undertakings."*

In the Expert's opinion, use of the SEIKO mark in a trade mark sense in the Domain Name, Seiko-shop.co.uk creates precisely the sort of impression of a (non-existent) "special relationship" beyond that of one of Seiko's 800 ordinary retailers, which the ECJ would allow the trade mark owner to prevent."

In upholding that decision on its particular facts, the Appeal Panel in DRS 0248 said:

"There are many different traders who may wish to make use of the trade mark of a third party e.g. the proprietor's licensee (exclusive or non-exclusive), a distributor of the proprietor's goods (authorised, unauthorised or 'grey market'), the proprietor's franchisee, or the proprietor's competitor engaged in comparative advertising. There are an infinite array of different factual circumstances which could arise under each of these categories.

Accordingly, we are not able to – and we are not going to attempt to – lay down any general rules governing when a third party can make 'legitimate' use of the trade mark of a third party as a domain name. All we can do is decide whether the Expert came to the right conclusion on the evidence and submissions before him.

Essentially Seiko's complaint is that Wanderweb's registration of the Domain Names has gone beyond making the representation "we are a shop selling Seiko / Spoon watches" and is instead making the representation(s) "we are The Seiko/Spoon watch Shop" or "we are the official UK Seiko/Spoon watch shop". The latter form of representation is what we understand the ECJ to be referring to when, in the ECJ case C-63/97 BMW v. Deenik, it speaks of creating "the impression that there is a commercial connection between the other undertaking and the trade mark proprietor". An example of a domain name which, in the opinion of some members of the Panel, would make the former but not the latter representation was given by the Expert in paragraph 7.28 of the Decision: "we-sell-seiko-watches.co.uk".

The Panel agrees that if there is support in the evidence for the suggestion that the Domain Names make, or are liable to be perceived as making, the latter representation (i.e. that there is something approved or official about their website), this would constitute unfair advantage being taken by Wanderweb or unfair detriment caused to Seiko."

The Appeal Panel in DRS 07991 (toshiba-laptop-battery.co.uk) summarised the principles of the two key appeal panel decisions under the DRS Policy in relation to the issue of the incorporation by resellers of trade marks into Internet domain names, *Seiko UK Ltd -v- Wanderweb* DRS 00248 and *Epson Europe BV -v- Cybercorp Enterprises* DRS 03027 as follows:

1. It is not automatically unfair for a reseller to incorporate a trade mark into a domain name and the question of abusive registration will depend on the facts of each particular case.
2. A registration will be abusive if the effect of the respondent's use of the domain name is falsely to imply a commercial connection with the complainant.
3. Such an implication may be the result of "initial interest confusion" and is not dictated only by the content of the website.
4. Whether or not a commercial connection is implied, there may be other reasons why the reseller's incorporation of the domain name is unfair. One such reason is the offering of competitive goods on the respondent's website.

In the present case the Respondent was clearly aware of the VALOR trade mark when registering the Domain Names, because the Respondent did so in order to engage in online retail sales of VALOR branded products which it purchased initially from Valor Limited and subsequently from the Complainant.

I do not accept the Respondent's contention that Valor Limited paid £10,000 to encourage the Respondent's online activities, since the invoice which the Respondent puts forward as evidencing this (annexed to Complaint 12142) is for "Printing matter contribution for the Indgaz promotion...".

Nevertheless, it is clear that by May 20, 2011 Valor Limited was aware of the Respondent's registration of the <valorfire.co.uk> domain name. In an email to the Respondent dated that day concerned with pricing, Mr. Beaman referred without objection to the domain name <valorfire.co.uk> as belonging to the Respondent.

The emails to and from Mr. Beaman in August 2011 and August 2012 set out above establish that both Valor Limited and subsequently the Complainant were aware of the Respondent's registration and use of the <valorfire.co.uk> and <valordirect.co.uk> domain names to sell VALOR branded products and were concerned that the appearance and content of the Respondent's websites gave the impression that they were operated by Valor Limited and subsequently by the Complainant. It was not until August, 2012, when the Complainant's lawyers first wrote to the Respondent, that objection was made also to the registration of the Domain Names by the Respondent.

Given Mr. Beaman's knowledge, without objection, both at Valor Limited and at the Complainant, of the Respondent's registration of the Domain Names and that they were being used to sell only the Complainant's products, I am not persuaded that the Domain Names were registered or otherwise acquired in the 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.

As to whether the Domain Names have been used in a manner which took unfair advantage of or was unfairly detrimental to the Complainant's Rights, I do not regard Mr. Beaman's lack of objection to the registration of the Domain Names by

the Respondent for the purpose of selling the Complainant's products as constituting approval by Valor Limited or by the Complainant of the way in which the Domain Names have been used by the Respondent.

The Complainant's <valor.co.uk> website presentation is a black background with a red bar across the page beneath a depiction of flames, followed by four squares with links to other pages, two of which squares contain pictures of fires. In the top left corner of the home page is a red depiction of the VALOR mark with a flame emerging from the letter V.

The following describes the Respondent's websites as at the dates of the filing of the relevant Complaints.

The Respondent's <valorfire.co.uk> website presentation is a predominantly black background with white writing and, against a red background, pictures of VALOR branded fires, with that brand name appearing under each one. The <valorfire.co.uk> domain name appears in the top left corner of the home page, with the word Valor in red and the rest in white, thus giving prominence to the Complainant's VALOR trade mark. The pictures follow. The next section, entitled "A Brief History of Valor", says in effect that, after 100 years of keeping UK homes warm and safe, Valor has recently been taken over by GDC Group. This gives the impression that the website is that of the Complainant, an impression already created by what has gone before. The next sections, entitled "Homeflame gas fires" and "Valorfire.co.uk" contain nothing to detract from that impression. The disclaimer at the foot of the home page: "Please Note: ValorFire.co.uk is NOT a part of the GDC Group, but an Independent retailer. You are NOT buying Direct from Valor or the GDC Group when using this site" is not prominent and, both for that reason and because it cannot be reached without scrolling several times to reach the bottom of the screen, is unlikely to be seen or read by many Internet users and is therefore unlikely to dispel the false impression, created by all that has gone before, that the site is operated by the Complainant, being the owner of the VALOR mark.

The <valordirect.co.uk> website presentation also has a black background with some red. The writing is white. The <valordirect.co.uk> domain name appears in the top left corner of the home page, with the word Valor in red and the rest in white, thus giving prominence to the Complainant's VALOR trade mark. The presentation is similar to the Complainant's website. There follows the statement: "Welcome to ValorDirect.co.uk. This website is for showrooms and the Trade to buy Valor products wholesale. We are an independent retailer offering Competitive prices and offer a Next working day delivery before 12 Noon\* service." Apart from the similar presentation, the text, stating that the operator of the website sells both to the trade and as a retailer, conveys the impression that it is operated by the Complainant. The word "direct" forming part of the domain name also conveys this impression. There is no disclaimer.

The <valorfires.co.uk> website presentation is a white background with black writing and some red parts, predominantly the word Valor, presented several times with a flame emerging from the letter V, and pictures of VALOR branded fires, with that brand name appearing under each one. The <valorfires.co.uk> domain name appears in red in the top left corner, followed by the words "The premier Valor

online retailer”. Following the pictures is a section: “A Brief History of Valor” written, as in the case of the <valorfire.co.uk> website, in such a way as to give the impression that the website is that of the owner of the VALOR trade mark. At the time of the Complaint there was no disclaimer.

I find that the presentation and content of the Respondent’s websites at the Domain Names at the time of the filing of the Complaints, coupled with the Domain Names themselves, give the false impression that they are official websites of the Complainant, thereby representing that the Complainant sells directly to consumers when it does not.

As the Expert said in DRS 09667 (thefrontlineshop.co.uk):

“The decisions on appeal in *seiko-shop.co.uk* and *toshiba-laptop-battery.co.uk* make it clear that the false implication of a commercial connection between the registrant and the Rights owner may constitute the taking of an ‘unfair advantage’ even where the registrant is a reseller of genuine goods. The question is whether the registrant crosses the line and makes a representation beyond the fact that he is a mere re-seller of genuine goods.”

In the present case I am satisfied, on the balance of probabilities, that the Respondent is using the Domain Names in a way that has confused or is likely to confuse people or businesses into believing that the Domain Names are registered to, operated or authorised by, or otherwise connected with the Complainant. The fact that the Respondent is using the Domain Names in connection with a genuine offering of goods does not assist the Respondent in this case. In making a representation beyond the fact that it is a mere reseller of genuine goods, the Respondent has crossed the line and has used the Domain Names in a manner which took unfair advantage of or was unfairly detrimental to the Complainant’s Rights.

Accordingly, I find that, in the hands of the Respondent, each of the Domain Names is an Abusive Registration.

## **7. Decision**

I find that the Complainant has proved, on the balance of probabilities, that it has rights in the trade mark VALOR, which is identical or similar to the Domain Names and that each of the Domain Names is an Abusive Registration in the hands of the Respondent. I therefore direct that the Domain Names <valorfire.co.uk>, <valorfires.co.uk> and <valordirect.co.uk> be transferred to the Complainant.

**Signed Alan Limbury**

**Dated July 11, 2013**