

DISPUTE RESOLUTION SERVICE

D00012336

Decision of Independent Expert

Geolabs Ltd

and

Geo Laboratory Testing Services Limited – In Liquidation

1. The Parties:

Complainant: Geolabs Ltd
Geolabs Ltd
Bucknalls Lane
Garston
Watford
Hertfordshire
WD25 9XX
United Kingdom

Respondent: Geo Laboratory Testing Services Limited – In Liquidation
Crosshands Business Park, Crosshand
Heol Stanllyd
Llanelli
SA14 6RB
United Kingdom

2. The Domain Name:

geolab.org.uk

3. Procedural History:

- 3.1 10 January 2013 17:58 Dispute received
11 January 2013 12:06 Complaint validated
11 January 2013 12:52 Notification of complaint sent to parties
30 January 2013 01:30 Response reminder sent
04 February 2013 10:37 No Response Received
04 February 2013 10:37 Notification of no response sent to parties
05 February 2013 10:47 Expert decision payment received
- 3.2 Ravi Mohindra was appointed as Independent Expert as of 11 February 2013 and confirmed to Nominet that he was independent of the parties and knew of no facts or circumstances that might call into question his independence in the eyes of the parties.
- 3.3 On 8 February 2013, Nominet contacted the Expert to inform him of a letter received from Christine Edwards, a director of Geo Site & Testing Services Limited – a company which appears to share directors with the Respondent company – stating that they have no objection to the transfer of the Domain Name. A copy of this letter was also sent to the Expert.
- 3.4 On 11 February 2013, Nominet contacted the appointed insolvency practitioners for the Respondent, informing them of the letter received from Geo Site & Testing Services Limited, and asking them (in their capacity as the Respondent’s liquidators) whether they had any objection to Nominet processing the transfer of the Domain Name to the Complainant.
- 3.5 On 20 February 2013 Nominet contacted all parties to the Dispute to inform them that it had not received the authorisation required from the liquidators of the Respondent to transfer the Domain Name to the Complainant, and as a result the Expert would proceed to make his decision. Nominet also informed all parties that paragraph 12a. of the DRS Procedure allows Nominet to extend timescales, and because it had advised the Expert to wait whilst it attempted to get clearance from the Respondent’s liquidators, the Expert decision deadline was being extended until 19 March 2013.

4. Factual Background

- 4.1 The Complainant is a company registered under the laws of England and Wales and is a provider of soil laboratory testing and associated services (the “Services”).
- 4.2 The business providing the Services was established in 1995 under and by reference to the name GEOLABS (the “Business”).
- 4.3 On 15 March 2000, the Complainant acquired the domain name <geolabs.co.uk> and since March 2000 or thereabouts the Complainant has

promoted the Business under and by reference to the mark GEOLABS from a website to which this domain name resolves.

- 4.4 The Domain Name was registered by the Respondent in July 2004 and the website to which the Domain Name resolves has appeared in several forms since that date.

5. Parties' Contentions

- 5.1 A summary of the Complainant's contentions is set out below. The Respondent has not provided a Response:

The Complainant

Rights

- 5.2 The Complainant is well known as a provider of soil laboratory testing and associated services (the "Services"), and since 1995 has continuously provided on a substantial scale the Services under and by reference to the mark GEOLABS (the "Mark").
- 5.3 The Complainant has supplied the Services on a substantial scale to customers throughout the United Kingdom and abroad.
- 5.4 The Complainant currently operates the largest independent soil testing laboratory in the United Kingdom and has been involved in a number of high profile projects such as the Crossrail project, the London Olympics and the building in London known as the "Shard of Glass".
- 5.5 The Complainant has made wide use of the Mark in connection with its Business, including on headed stationery, public price lists, advertisements in trade journals and directories and in its domain name <geolabs.co.uk> and on the associated website.
- 5.6 The Complainant's sales of services provided under the Mark have been substantial (for example £1,077,000 in 2008).
- 5.7 By reason of the use of the Mark outlined above, the Mark when used in relation to the Services has come to indicate in the United Kingdom to members of the relevant trade and public the business and services of the Complainant and none other.
- 5.8 The Complainant is the registered proprietor and owner of UK Trade Mark 2504907 for a series of two device marks incorporating the word GEOLABS, registered with effect from 16 December 2008 for soils laboratory testing in class 42 (the "Registered Mark"). The Registered Mark proceeded to registration having established acquired distinctiveness through use.

- 5.9 The Complainant is also the owner of substantial reputation and goodwill in the name GEOLABS in the UK and internationally (particularly when used in relation to soil laboratory testing and associated services), as a result of its trading history under such name.
- 5.10 The Domain Name is identical or similar to the Mark in which the Complainant has extensive rights. The Domain Name consists of the Complainant's Mark with only the omission of the final "s" at the end of GEOLABS. The omission of the final "s" is likely to go unnoticed by the average consumer or in the alternative the average consumer will view the Domain Name as the singular form of the Mark and will therefore believe that the Respondent is in fact the Complainant or is associated with or endorsed by the Complainant.
- 5.11 It was held in *Mattel, Inc. v Domain Administration DRS04298* that a final missing letter "s" in the infringing domain name did not change the core of the complainant's trade mark and did not preclude a finding of similarity between the complainant's rights and the infringing domain name. It is also long established that when determining whether domain names are identical to a mark the suffix "org.uk" can be disregarded.

Abusive Registration

- 5.12 The Respondent is using the Domain Name in a way which has confused or is likely to confuse people or businesses into believing that the Domain Name is registered to, operated by, or otherwise connected with the Complainant.
- 5.13 The website to which the Domain Name resolves has at various points in time since 2007 offered identical services to those offered by the Complainant. Coupled with the inclusion of the Mark in the Domain Name and the Complainant's significant reputation and goodwill in the Mark, the average internet user is likely to be confused into thinking the Domain Name and associated website is operated or authorised by, or otherwise connected with, the Complainant.
- 5.14 The Complainant also submits that there have been many instances of actual confusion between the services of the Complainant and the Respondent and has provided copies of, inter alia, emails, invoices and payments that it has received from people and entities but which were in fact intended for the Respondent.
- 5.15 Contrary to paragraph 3(a)(i)(C) of the Policy, the Respondent has registered the Domain Name for the purpose of unfairly disrupting the business of the Complainant. The Respondent has registered and uses the Domain Name to offer services which compete directly with those of the Complainant. The Respondent's registration and use of the Domain Name in this way constitutes an Abusive Registration. It also takes unfair advantage of the Complainant's rights in the Mark since it provides the Respondent with sales and/or publicity as a direct result of the use of the

Complainant's Mark. It further is detrimental to the Complainant's rights in the Mark since it deprives the Complainant of the exclusive benefit of the goodwill in the Mark thereby diluting the Mark and the value of the Complainant's goodwill in the Mark.

- 5.16 Due to the significant reputation and goodwill of the Mark the Respondent cannot but have been aware of the reputation of the Mark when it registered the Domain Name. This is especially so given that the Respondent hosts a geotechnical laboratory testing services website at the Domain Name, being identical to the manner in which the Complainant trades under the Mark. The Respondent's use of the Mark in the Domain Name is intended to lead consumers to believe that they have reached the Complainant's website and so divert internet traffic from the Complainant thereby interfering with the Complainant's business. The Respondent could not have chosen or subsequently used the word "geolab" in its Domain Name for any reason other than to trade on the Complainant's rights in that name and to confuse internet users and by that means seek to attract them to a website with a name which is the same as that of the Mark with the intention to profit from the reputation and goodwill of the Mark.
- 5.17 The Complainant also relies on the concept of initial interest confusion which as stated in *joiedevivreholidays.co.uk* (DRS 05122) is the "*phenomenon whereby visitors to the Domain Name, in the moment before they actually reach the website, believe that the Domain Name is in some way connected to the Complainant.*" This is expanded upon in *dynapro.co.uk* (DRS 07800), "*In other words, this initial confusion causes some advantage to the Respondent, and it is the gaining of that advantage, that is unfair. The advantage referred to does not need to be monetary and could simply be a disadvantage to a third party, one person's gain is another person's loss, for example by causing disruption to the Complainant's business*". The Complainant further submits that initial interest confusion also applies in this dispute and as per the established decisions referred to above constitutes unfair advantage thereby equating to an Abusive Registration.
- 5.18 In *BT v One In A Million* [1999] 1 WLR 903, the Court of Appeal cited, as an example of confusion, a Whois search of the registry/registrar database. The appearance of the infringing domain name in the Whois search results would likely lead the person performing the search to assume that the domain name was associated with the trade mark owner. The court held that mere registration of a domain name could constitute unfair use of a domain name for the purposes of passing off and trade mark infringement, even if nothing more is done with the domain name. The Nominet Expert Overview at paragraph 3.3 refers to the Court of Appeal's decision in its guidance about paragraph 3(a)(ii) of the Policy, and states that "[t]he prevailing approach under the DRS is consistent with this".
- 5.19 The Domain Name has also been used in a way that is likely to dilute the reputation of the Mark and as such is evidence of being unfairly detrimental to the Complainant's rights. The mere registration alone of the

Domain Name by the Respondent and not the Complainant has meant that the Mark is not as unique as it was prior to the registration of the Domain Name. This lack of uniqueness and dilution means that the Mark is not acting as a guarantee of origin that the services provided in relation to the Mark are provided uniquely by or with the endorsement of the Complainant and is thereby adding to the dilution of the reputation in the Mark.

- 5.20 The Respondent has no legitimate interest in the Domain Name and has appropriated the Mark in which the Complainant has significant goodwill and reputation and unfairly used it to promote the Respondent's website at the expense of the Services and Mark of the Complainant.
- 5.21 Accordingly, the Complainant submits that the Domain Name amounts to an Abusive Registration in satisfaction of paragraphs 2(a)(i) and 2(a)(ii) of the Policy.
- 5.22 Further, the Respondent has no rights or legitimate interests in respect of the Domain Name and it is not able to rely on any of the factors set out in paragraph 4 of the Policy for the following reasons:
- 5.22.1 The Respondent's use of the Domain Name to offer a competing service does not constitute a genuine offering of goods or services as per the case of *Silicalia SA v Simmy Ceramics* DRS 5427 where it was held that the Respondent in the case was using the domain name to redirect to a page of its own website promoting competing products and that *"such use cannot be conceived of as a genuine offering of goods and services. On the contrary, it misleads consumers, takes unfair advantage and is unfairly detrimental to the Complainant"*.
- 5.22.2 There is no legitimate non-commercial or fair use of the Domain Name.
- 5.22.3 The Domain Name was registered almost a decade after the Complainant started trading under the Mark. Accordingly, in the absence of any legitimate interests in the Domain Name, the registration of the Domain Name by the Respondent cannot have been in good faith and therefore takes unfair advantage of the Complainant's rights since it is a bad faith attempt to benefit from the goodwill and reputation that the Complainant has built up in the Mark.
- 5.22.4 Due to the extremely significant reputation of the Complainant, it is reasonable to assume that the Respondent must have known of the Complainant at the time the Domain Name was registered. In fact, given the distinctiveness and reputation of the Complainant's Mark, it defies belief that the Respondent could innocently and in good faith register the Domain Name without knowledge of the Complainant and then use the Domain Name in the exact same

industry and manner as the Complainant, competing directly against the Complainant. The Respondent would have been well aware of the existence of the Complainant and the Complainant's Mark when it registered the Domain Name. It is beyond credulity that anyone involved in the business of geotechnical laboratory testing services could establish a business in the industry without being aware of the Complainant, its website and its rights. The Respondent's use of a domain name which is identical or confusingly similar to the Complainant's Mark on a website offering for sale identical products and services to those of the Complainant cannot be considered as a bona fide offering of goods or services. This is particularly so given that various versions of the websites at the Domain Name had a similar look, feel, style and layout to the Complainant's Website.

- 5.23 For the avoidance of doubt, the Complainant has not licensed or otherwise permitted or authorised the Respondent to use its Mark or to apply for a domain name incorporating any such Mark.
- 5.24 For the reasons set out above, it is submitted that the Respondent has no rights or legitimate interests in respect of the Domain Name. Accordingly, the Complainant submits that the Respondent will not be able to rely on any of the factors in paragraph 4 of the Policy to demonstrate that the Domain Name is not an Abusive Registration.

The Respondent

- 5.25 As indicated above the Respondent did not file a Response.

6. Discussions and Findings

General

- 6.1 The Complainant is required under paragraph 2b. of the Policy to prove to the Expert, on the balance of probabilities, that:
- (i) the Complainant has Rights in respect of a name or mark which is identical or similar to the Domain Name; and
 - (ii) the Domain Name, in the hands of the Respondent, is an Abusive Registration.
- 6.2 Where no Response has been received, as is the case with this Complaint, it is still necessary for the Expert to be satisfied that the elements necessary to establish the Complainant's Rights and to make a finding of Abusive Registration are present in order for the Complainant's case to succeed.

Complainant's Rights

- 6.3 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*". 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'.
- 6.4 The Complainant has been granted a UK trade mark registration for "Geolabs" (in a series of 2), which provides it with exclusive rights to use the mark in relation to the services for which the mark is registered, being soils laboratory testing. The Complainant has also provided some evidence of its use of the mark GEOLABS and it is also the owner of the <geolabs.co.uk> domain name. The Expert finds that the Complainant has Rights in the mark GEOLABS.

Similarity

- 6.5 For the purpose of assessing similarity under this head of the Policy the generic domain suffix "org.uk" may be ignored. The only other difference between the mark in which the Complainant has Rights and the Domain Name is the omission of the letter "s" at the end of the Domain Name. This change does nothing to change the distinctive character of the mark in which the Complainant has Rights and there is a very high degree of similarity.
- 6.6 The Expert therefore finds that, on the balance of probabilities, the Domain Name is similar to a name or mark in which the Complainant has Rights.

Abusive Registration

- 6.7 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 took unfair advantage of or has been unfairly detrimental to the Complainant's Rights.
- 6.8 Paragraph 3a. of the Policy sets out a non-exhaustive list of five factors that may be evidence that a domain name is an abusive registration. The Complainant bases its case on Abusive Registration mainly on paragraph 3a.ii, which reads as follows:
- "ii. Circumstances indicating that the Respondent is using or threatening to use the Domain Name in a way which has confused or is likely to confuse people or businesses into believing that the*

Domain Name is registered to, operated or authorised by, or otherwise connected with the Complainant”

6.9 The Complainant has put forward evidence of some actual confusion, including evidence of invoices wrongly sent to it by suppliers of the Respondent, and of customers making payment to the Complainant when that payment should have been made to the Respondent. The Respondent has not challenged these statements made by the Complainant.

6.10 In addition, taking the following factors into account, the Expert finds that use of the Domain Name by the Respondent will be likely to lead to confusion as anticipated under paragraph 3a.ii of the Policy:

- The Complainant has been providing its Services under the Mark since 1995. Unchallenged evidence provided by the Complainant shows that the Mark is recognised as indicating the Services of the Complainant, and accordingly it has generated goodwill and reputation in its Mark.
- The extract from the UK IPO submitted by the Complainant to prove its Rights in the mark GEOLABS shows that the application for its trade mark proceeded to registration “*because of distinctiveness acquired through use*”. In short, this means that upon initial examination of the trade mark application, the UK IPO objected to the registration of the mark due to the mark lacking inherent distinctiveness (and therefore not fulfilling the function of a trade mark), but the Complainant was able to overcome such objection by providing evidence of use of the mark such that the relevant public would associate the mark with the Complainant and no other party.
- The high degree of similarity between the Complainant’s mark GEOLABS and the Domain Name means that consumers searching online for the Complainant and its Business are likely to expect there to be some connection between the website operated under the Domain Name and the Complainant, even before they arrive at that website. As stated in Paragraph 3.3 of the Expert’s Overview¹:

“This is what is known as ‘initial interest confusion’ and the overwhelming majority of Experts view it as a possible basis for a finding of Abusive Registration, the vice being that even if it is immediately apparent to the visitor to the web site that the site is not in any way connected with the Complainant, the visitor has been deceived.”

6.11 Further, the Domain Name has previously been used by the Respondent to resolve to websites which have offered services identical or at least very similar to the Services of the Complainant, under and by reference to the

¹ The Experts’ overview is a document promulgated by Nominet’s panel of Experts which deals with a range of issues that come up in DRS disputes. It is published on Nominet’s website at: http://www.nominet.org.uk/sites/default/files/drs_expert_overview.pdf.

name GEOLAB. In light of the reputation and goodwill generated by the Complainant in respect of its Mark GEOLABS, the Expert is satisfied that use of the Domain Name to promote a business offering such services has been unfairly detrimental to the Complainant's Rights.

- 6.12 The Expert therefore finds, on the balance of probabilities, that the Domain Name, in the hands of the Respondent, is an Abusive Registration within the meaning of the Policy.

7. Decision

- 7.1 The Expert finds that the Complainant has Rights in the mark GEOLABS which is similar to the Domain Name, and further that the Domain Name, in the hands of the Respondent, is an Abusive Registration. The Expert therefore directs that the Domain Name should be transferred to the Complainant.

Signed Ravi Mohindra

Dated 19 March 2013