

DISPUTE RESOLUTION SERVICE

D00012715

Decision of Independent Expert

Goal Group Limited

and

Mr Garth Piesse

1. The Parties:

Complainant: Goal Group Limited
7th Floor
69 Park Lane
Croydon
Surrey
CR9 1BG
United Kingdom

Respondent: Mr Garth Piesse
PO Box 181
Palmerston North
Manawatu
4440
New Zealand

2. The Domain Name(s):

goalgroup.co.uk

3. Procedural History:

15 April 2013 - Dispute received.
18 April 2013 - Complaint validated and notification of the Complaint sent to the Parties.

08 May 2013 - Response reminder sent.
09 May 2013 - Response received and notification of the Response sent to the Parties.
14 May 2013 - Reply reminder sent.
17 May 2013 - No Reply received.
17 May 2013 - Mediator appointed.
23 May 2013 - Mediation started.
24 May 2013 - Mediation failed and close of mediation.
11 June 2013 - Expert decision payment received.

The Expert confirms that he is independent of each of the Parties and that, to the best of his 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 a such a nature as to call in to question his independence in the eyes of one or both of the Parties.

4. Factual Background

- 4.1 The Complainant is a registered UK company named *Goal Group Limited* (Company No: 02438530) (the 'Company Name'). The Complainant was originally registered as "Global Operations & Administration Limited" and then changed its name to the Company Name on 2 June 2008.
- 4.2 The Respondent registered the Domain Name on 30 September 2011.

5. Parties' Contentions

The Complaint

For the purposes of this section of the Decision, the Expert has summarised the submissions of the Parties but only insofar as they are relevant to the matters that the Expert is required to determine under Nominet's Dispute Resolution Service ('DRS') Policy (the 'Policy').

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

The Complainant's Rights

- The Complainant submitted that, based on its Company Name, it has Rights in respect of a name, Goal Group (the 'Name'), which is identical or similar to the Domain Name.
- The Complainant submitted that the Respondent had registered the Domain Name with the primary purpose of either selling it to the

Complainant or to a competitor for more than the Respondent paid for it, or to stop the Complainant from using it.

- The Complainant submitted that the registration of the Domain Name has resulted in a disruption to its business and is confusing for Internet users.

The Expert notes that the Complaint itself was brief in detail, without supporting documents. Nominet wrote to the Complainant inviting it to review the Complaint and resubmit it, providing the Complainant with general guidance as to how to submit a complaint. However, this invitation was declined by the Complainant.

Respondent's Response

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

- The Respondent submitted that the Complainant's Company Name is insufficient in of itself to show that the Complainant has Rights in the Name.
- The Respondent submitted that he chose the Domain Name as it reflected the "very common usage of a laudatory/descriptive term" (i.e. goal) plus the word "group". In addition, that the term "goal group", and the very similar term "goals group", are used by other persons in the UK, particularly in a descriptive sense in the context of "non-profit organisations and people coming together to achieve goals or objectives". The Respondent submitted some materials to back up these submissions.
- Thus, the Respondent submitted that the Complainant had not established goodwill in the Name and does not have Rights in the Name.
- The Respondent submitted that the Domain Name is not an Abusive Registration.
- The Respondent submitted that, for the Complaint to succeed as recognised in previous DRS appeal decisions (e.g. *verbatim.co.uk* (DRS 4331)), the Complainant has to show that the Respondent was aware of the existence of the Complainant at the time of registration.
- The Respondent explained that he is located in New Zealand, and submitted that he was not aware of the Complainant on registration of the Domain Name and that the Complainant only came to the Respondent's attention when the Complainant filed the Complaint. Further, that there was no reason why the Respondent should have heard of the Complainant, and that the Complainant had not suggested any such reason.

- Accordingly, the Respondent submitted that the Complainant had failed to "get to first base" in its Complaint as it had not demonstrated that the Respondent was aware of the existence of the Complainant at the date of registration of the Domain Name.
- Also, the Respondent submitted that, since 2007, he had been in the business of buying, selling and monetising domain names which, as recognised by the Policy, are of themselves lawful activities. The Respondent submitted that he had registered other domain names which comprise a common term plus "group", such as *faithgroup.co.uk*, *catalystgroup.co.uk*, *leadgroup.co.uk* and *brilliantgroup.co.uk*.
- The Respondent explained that he chose the Domain Name as he considered that businesses like to incorporate the word "group" in their name because it conveys an "impression of scale and charitable-type organisations are keen too as it also denotes the ideal of people working together."
- The Respondent noted, as provided for by paragraph 4d of the Policy, that trading in domain names for profit is of itself a lawful activity, and that based on DRS appeal decisions (e.g. *parmaham.co.uk* (DRS 359)), there is nothing objectionable about offering a domain name for sale where the domain name was not acquired for the purpose of sale to the complainant.
- The Respondent submitted that he intended to sell the Domain Name to someone with an interest in the Name but, in the meantime, to profit from advertising links relating to the generic meaning of the words comprised in the Domain Name.
- The Respondent noted that the Complainant did not explain why it had submitted that the Domain Name "is ultimately confusing for Internet users." The Respondent submitted that, referencing *wiseinsurance.co.uk* (DRS 4889), the Complainant had no goodwill in the Name and "so does not even get to first base on a likelihood of confusion argument."
- Finally, the Respondent submitted that the Complainant had not objected to the use of the Domain Name for a parking page (noting that the Policy (paragraph 4e) makes it clear that using a Domain Name in this way is not of itself objectionable) or suggested that the advertising links on the parked page have any relevance to the Complainant's business.

Complainant's Reply

No Reply by the Complainant to the Response was received.

6. Discussions and Findings

General

6.1 To succeed in the Complaint, the Complainant has to prove pursuant to paragraph 2 of the Policy that, on the balance of probabilities¹:

“a. (i) [it] 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 Addressing each of these limbs in turn:

i) Rights in respect of a name or mark which is identical or similar to the Domain Name

6.3 The Expert does not consider that, for the reasons set out below, the Complainant has Rights in the Name as understood by the Policy.

6.4 Paragraph 1 of the Policy defines 'Rights' as:

“[...] rights enforceable by the Complainant, whether under English law or otherwise, and may include rights in descriptive terms which have acquired a secondary meaning;”

also, the Complainant must have the Rights at the time of the complaint.²

6.5 The Complainant has not brought forward evidence that it has obtained registered trade (or service) mark protection for the Name; such registration being an enforceable right as understood by the above definition.

6.6 As the above definition of Rights embraces enforceable rights other than a registered trade (or service) mark, the Expert has considered whether such other rights arise in the Name (the Name, in the view of the Expert, being identical to the Domain Name, not counting the generic *Limitedl.co.uk* suffix at the end of each).

6.7 The Complainant submitted that it has Rights in the Name as the Name is identical to that of its Company Name. However, in the view of the Expert, the mere registration of a company name does not of itself give rise to any

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

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

Rights.³ Therefore, the Expert has considered whether there is evidence that the Complainant has generated unregistered rights in the Name.

- 6.8 In this regard, the definition of Rights includes a reference to “*rights in descriptive terms which have acquired a secondary meaning*”; such a secondary meaning indicating to the purchasing public the goods/services of the Complainant (i.e. that the person has generated goodwill in the descriptive term).⁴
- 6.9 The Respondent submitted, in effect, that the Name is not distinctive and thus not capable of acquiring such a secondary meaning as it consists of “a laudatory/descriptive term” plus the word “group”.
- 6.10 Contrary to the Respondent's submission, the Expert considers that, on the facts before him, the Name itself is capable of being distinctive: the combination of the words “goal” and “group” is not generic and is not a usual combination in the English language.
- 6.11 As such, the Expert has considered whether the Name, which the Expert considers is descriptive, has acquired a secondary meaning as understood by the Policy. However, on the facts before him, the Expert does not consider that the Name has acquired such a meaning; indeed, no evidence has been brought forward by the Complainant that it has used the Name and that consumers have come to recognise the Name as indicating the goods/services of the Complainant.
- 6.12 Thus, while noting the fact that the requirement to demonstrate ‘Rights’ is not a particularly high threshold (Nominet appeal panel decision, *Seiko-shop* DRS 00248), the Expert considers that the evidence before him is insufficient to establish that, at the time of the Complaint, the Complainant had Rights in the Name.

ii) Abusive Registration

- 6.13 In any event, even if the Complainant were to have Rights in the Name, for the reasons set out below, the Expert does not consider that the Domain Name is an Abusive Registration as understood by the Policy.
- 6.14 Paragraph 1 of the Policy defines “Abusive Registration” as a domain name which either:

³ For further discussion, please see The Nominet Experts’ Overview at: http://www.nominet.org.uk/sites/default/files/drs_expert_overview.pdf.

⁴ Goodwill has been defined as: “the benefit and advantage of the good name, reputation and connection of a business. It is the attractive force which brings in custom.” - *Inland Revenue Commissioners v Muller & Co Margarine Ltd* [1901] A.C. 217 at 223,224.

“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;”

- 6.15 *In relation to i. above* – the Expert does not consider that it was an Abusive Registration at the time the Domain Name was registered.
- 6.16 The Policy, at paragraph 3, sets out a non-exhaustive list of factors which may be evidence that the Domain Name is an Abusive Registration. Specifically, paragraph 3 a. i. B. refers to where the Respondent has registered the domain name primarily *“as a blocking registration against a name [...] in which the Complainant has Rights;”* and paragraph 3 a. i. C. refers to where the Respondent has registered the domain name primarily *“for the purpose of unfairly disrupting the business of the Complainant.”* Both these factors have been claimed by the Complainant.
- 6.17 The Expert notes the Respondent’s submission that he did not know of the Complainant at the time of the Domain Name registration, such knowledge he submitted is needed to show in this regard an Abusive Registration.⁵ The Respondent explained that he registered the Domain Name as it “reflected the very common usage of a laudatory/descriptive term plus the word “group””; not because of the Complainant’s business. He also stated that he chose the Domain Name as he considered that businesses like to incorporate the word “group” in their name because it conveys an “impression of scale and charitable-type organisations are keen too as it also denotes the ideal of people working together.”
- 6.18 The Expert agrees with the Respondent that knowledge of the Complainant is needed to show, in this regard, an Abusive Registration. To this end, the Expert would have expected the Complainant to provide evidence that the purchasing public identified the Complainant with the Name and, as a consequence, the Respondent did know or at least on the balance of probabilities would have known about the Complainant at that time. However, there is no such evidence before the Expert that would suggest that the Name was thus recognisable.
- 6.19 Therefore, on the evidence before him, the Expert does not consider that the Domain Name was registered by the Respondent with the intention to disrupt unfairly the business of the Complainant. In this way, the Expert does not consider that such action took unfair advantage of, and/or was unfairly detrimental to, the Complainant’s Rights.

⁵ Based on previous DRS appeal decisions (e.g. *verbatim.co.uk* (DRS 4331)).

6.20 In relation to (ii) above – the Expert also considers that it was not an Abusive Registration through the use by the Respondent of the Domain Name.

6.21 The Policy sets out at paragraph 3 a. ii. of the Policy that a factor which may be evidence that the Domain Name is an Abusive Registration is:

“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;”

6.22 The Complainant, in effect, submitted that this factor was met. However, again, no evidence was provided by the Complainant to support such a bald assertion. For example, there was no explanation in the Complaint as to what goods/services the Complainant sells and how those accessing the website connected to the Domain Name (the ‘Website’) would be so confused. On the evidence before him, the Expert does not consider that anyone accessing the Website would be confused into thinking, even initially,⁶ that the Website is the Complainant’s or is connected with the Complainant.

6.23 Further, the Respondent, as he explained in his submission, is using the Domain Name as a ‘parked page’ i.e. which is where an automated service generates sporting-related links on the Website based on use of the term “goal”. Again, no evidence has been provided by the Complainant that this parked page in any way has disrupted or disrupts its business.

6.24 Thus, the Expert does not consider that the Respondent, by using the Domain Name in this way, has taken unfair advantage of, and/or was unfairly detrimental to, the Complainant’s Rights.

7. Decision

7.1 The Expert finds that, on the balance of probabilities, the Complainant does not have Rights in the Name and that the Domain Name in the hands of the Respondent is not an Abusive Registration. Therefore, the Expert directs that no action is taken.

Signed Dr Russell Richardson

Dated 5 July 2013

⁶ For a discussion of the concept of ‘initial interest confusion’ and recent case-law, please see the English High Court judgment in *OCH-ZIFF Management Europe Limited and others v OCH Capital LLP and others* [2010] EWHC 2599 (Ch).