

**DISPUTE RESOLUTION SERVICE**

**D00014293**

**Decision of Independent Expert**

C Williams t/a Sussex Motorcycles

and

Mr Peter Karmios

**1. The Parties**

Complainant: C Williams t/a Sussex Motorcycles

Respondent: Mr Peter Karmios

**2. The Domain Name**

sussexmotorbikes.co.uk

**3. Procedural History**

3.1 On 2 June 2014 the complaint was received and validated. On 4 June 2014 notification of the complaint was sent to the Respondent. On 17 June 2014 the response was received and notification of it sent to the Complainant. On 20 June 2014 a reply reminder was sent to the Complainant. On 23 June 2014 the reply was received, notification of it sent to the Respondent and a mediator was appointed. On 27 June 2014 the mediation started and on 26 August 2014 the mediation failed. On 26 August 2014 the close of mediation documents were sent, on 5 September 2014 the Complainant was sent a full fee reminder and on 10 September 2014 the Expert decision payment was received.

3.2 The Complainant has submitted a non-standard submission under paragraph 13(b) of the Nominet DRS Procedure ("the Procedure"). Having considered the Complainant's explanation, I do not consider there is an exceptional need for this non-standard submission and accordingly I have not requested to see it.

3.3 I, Patricia Jones ("the Expert"), can 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 in to question my independence in the eyes of one or both of the parties.

**4. Factual Background**

4.1 The Complainant is a sole trader based in Henfield, Sussex. The Complainant has been trading under the name Sussex Motorcycles for over 10 years. The Complainant sells used motorcycles, with about half of his business being small 50cc and 125cc bikes which are often sold to younger and first time riders. The Complainant also services and repairs motorcycles, supplies motorcycle spare parts and accessories and undertakes motorcycle engine rebuilds and motorcycle modifications. The

Complainant does not deal in, service or repair Chinese made motorcycles or sell spare parts for them.

- 4.2 The Complainant registered sussex-motorcycles.co.uk, sussexmotorcycles.com and sussex-motorcycles.com in 2008 and sussexmotorcycles.co.uk in 2010. The Complainant uses sussex-motorcycles.co.uk and sussexmotorcycles.co.uk for a website for his business which has operated since 2008 (these domains route through to the website at sussexmotorcycles.com).
- 4.3 The Complainant has advertised his business in the Brighton Yellow Pages, Motorcycle and Scooter Dealers section, since 2004. The Complainant has given his web address as sussexmotorcycles.co.uk in his advert.
- 4.4 The Domain Name was registered on 24 August 2012. The Respondent is said to be a non-trading individual on the Nominet WHOIS record for the Domain Name. However, the Respondent is the manager of Sussex Motorbikes Limited which was incorporated on 30 August 2012.
- 4.5 The Domain Name resolves to a website headed "Sussex Motorbikes" which advertises motorbike training, servicing and repairs and bikes for sale.
- 4.6 On 14 October 2013 the Complainant e-mailed an enquiries e-mail address at sussexmotorbikes.com. The Complainant said he had recently become aware of trading in second hand motorcycles and servicing under the name 'sussexmotorbikes'; he believed that the previous/normal company name was Bike Smart Motorcycle Training; stated that he had been trading under 'sussexmotorcycles' for several years; and demanded that use of 'sussexmotorbikes' cease.
- 4.7 On the same day the Complainant e-mailed the hosting company, Pipe Ten, requesting that the sites at sussexmotorbikes.com and the Domain Name be stopped. Pipe Ten responded that the request would be passed on to the account holder.
- 4.8 On 7 March 2014 the Complainant sent a chasing e-mail to the same enquiries address which included a copy of his first e-mail. The Complainant gave further details of his business and of his trading history under 'sussexmotorcycles'; said that there had been customer confusion; and threatened legal action against the Respondent and Pipe Ten. On the same day the Complainant sent a copy of this e-mail to Pipe Ten who responded that the request would be passed on to the account holder and that no further action could be taken by Pipe Ten without a formal and valid takedown notice.
- 4.9 On 10 March 2014 the Respondent e-mailed the Complainant. The Respondent said he had not replied to the Complainant's first e-mail because Pipe Ten had responded with their opinion that the Complainant was making a spurious claim and he agreed with this view. The Respondent referred to the Complainant's threat of legal action over infringement of the Complainant's rights to use 'Sussex Motorcycles'. The Respondent stated he did not have an issue with the Complainant using this name as he had not had any adverse experience of the Complainant trading in this name. The Respondent said he did not see any confusion as the Complainant's website did not show any trading address or premises, the Respondent had made enquiries and no-one knew where the Complainant traded from whereas Sussex Motorbikes Limited had advertised premises in Haywards Heath with ten staff, a MOT bay and training school. The Respondent stated Sussex Motorbikes Limited had been trading longer than Sussex Motorcycles Limited and that in the event of legal action he would

countersue on the grounds that Sussex Motorcycles Limited as the younger company should be dissolved.

### **Parties' Contentions**

5.1 I set out below a summary of what I regard to be the main contentions of the parties.

#### **The Complainant's complaint**

- 5.2 The Complainant contends that he has established use of the business name Sussex Motorcycles. The Complainant submits that he has an active motorcycle business and has been trading under, and invested in promoting, the name Sussex Motorcycles for over ten years. The Complainant relies on his on-line trading since 2008 under the name 'sussexmotorcycles' and his advertising in the Brighton Yellow Pages. The Complainant says he has many customers in Sussex, having sold hundreds of bikes, and an existing reputation and goodwill for quality service.
- 5.3 The Complainant says he does not include his trading address in his adverts as he keeps motorcycles in stock for sale and has had break-ins in the past. The Complainant states that he does not deal in Chinese made motorcycles as he considers them to be of lesser quality.
- 5.4 The Complainant contends that the Domain Name is an Abusive Registration for the following reasons:
- (a) The Complainant asserts that the Domain Name is similar to his trading name. The Complainant argues that the Domain Name invites confusion with the Complainant's domain name and that Sussex Motorbikes is selling lower quality Chinese motorcycles, which damages his reputation and goodwill.
  - (b) The Complainant says he first heard of Sussex Motorbikes in December 2012/January 2013 when he was called by a lady who had bought a Chinese motorcycle which had gone wrong. The caller was under the impression she had bought the motorcycle from the Complainant and said the bike had come from 'sussexmotorbikes'. The Complainant states he has received further phone calls confusing him with Sussex Motorbikes, the latest being in April 2014.
  - (c) The Complainant contends that at the end of 2012/beginning of 2013 an existing company, Bike Smart, which had been trading for a few years began to use the name Sussex Motorbikes and the Domain Name. The Complainant says that Bike Smart is a motorcycle training school in Haywards Heath, Sussex which is about 9 miles from the Complainant's premises and is in the area covered by the Yellow Pages in which the Complainant advertises.
  - (d) The Complainant says that Bike Smart and Sussex Motorbikes have the same address and phone number, have corresponding websites and offer the same services. The Complainant points out (as is supported by the Complainant's evidence of the Respondent's website) that people in the photographs on the Sussex Motorbikes website are wearing Bike Smart jackets.
  - (e) The Complainant states the website at the Domain Name offers competing goods and services of 50cc and 125cc motorcycles for sale, servicing and repairs and spare parts and accessories. The Complainant says that the motorcycles offered for sale are Chinese. The Complainant argues that the name "Sussex Motorbikes" is almost identical to "Sussex Motorcycles" and that Sussex Motorbikes is passing itself off as Sussex Motorcycles.

- (f) The Complainant argues that the change in name from Bike Smart to Sussex Motorbikes, and the use of the Domain Name is an abuse of the name Sussex Motorcycles which the Complainant has a right to use. The Complainant contends that the abuse is by imitation and by selling inferior products.

**The Respondent's response**

- 5.5 While the Domain Name is in the name of the Respondent, he refers in his response to "we", "our" and "us" which I have taken to mean Sussex Motorbikes Limited.
- 5.6 The Respondent says he has communicated with the Complainant by email to refute his claims, which the Respondent says the Complainant is willing to drop if a "friendly arrangement" is reached.
- 5.7 The Respondent states that Sussex Motorbikes Limited has been trading since August 2012 and the Domain Name and sussexmotorbikes.com were registered to support the business at the time of incorporation. The Respondent refers to his e-mail reply to the Complainant of 10 March 2014 (see paragraph 4.9).
- 5.8 The Respondent contends that the Complainant has attempted to legitimise his claim by registering Sussex Motorcycles Limited after Sussex Motorbikes Limited began trading.
- 5.9 The Respondent argues that there is no scope for confusion as Sussex Motorbikes Limited is a prominent garage with public access and a large customer base. The Respondent says the Sussex Motorcycles website did not support a legally incorporated business before the complaint began and has no trading premises. The Respondent states that the Complainant does not offer the same range of services, no-one has contacted Sussex Motorbikes Limited by mistake and it has not benefitted from any case of mistaken identity.
- 5.10 The Respondent says the Complainant has not provided any evidence to show that the Domain Name has negatively impacted on the Complainant's business; that the Domain Name accurately represents the legal trading entity; and that the website at the Domain Name shows the business, location and services of Sussex Motorbikes Limited so there can be no confusion with any other business.

**The Complainant's reply**

- 5.11 The Complainant says he would be happy to come to a friendly agreement with the Respondent if the latter stopped using the Domain Name.
- 5.12 The Complainant says he was trading before Sussex Motorbikes Limited.
- 5.13 The Complainant states that Pipe Ten only forwarded his e-mails to the Respondent and did not give an opinion that he was making a spurious claim.
- 5.14 The Complainant argues that there is confusion between 'sussexmotorcycles' and 'sussexmotorbikes' since they are almost identical as is evidenced by the phone calls the Complainant has received from the Respondent's customers. The Complainant says he cannot tell how many phone calls the Respondent has received from potential customers looking for the Complainant. The Complainant states his contact address is on the links page rather than the home page of his website. The Complainant argues that if the Respondent cannot find his address this adds to the confusion.
- 5.15 The Complainant says he receives about twenty or thirty phone calls a day and has hundreds of customers inside and outside Sussex. The Complainant says a Google search finds his website, his details are in Yellow Pages and that he is contactable on the phone number on his website.

- 5.16 The Complainant contends that the premises in Haywards Heath with ten staff, a training school and MOT bay are those of Bike Smart which has traded under this name for several years. The Complainant says that Bike Smart continues to trade and has a website at bike-smart.net. The Complainant states this domain name was registered in 2004. The Complainant asserts that in August 2012 Bike Smart also started trading under the name Sussex Motorbikes.
- 5.17 The Complainant says that Sussex Motorcycles Limited is a dormant company and he has been a sole trader under the name Sussex Motorcycles for over 10 years.
- 5.18 The Complainant contends that the Respondent is offering competing products and services on the website at the Domain Name including 50cc and 125cc bikes and the service and repair of bikes. The Complainant says that 50cc and 125cc bikes is a niche market and that there are very few, if any, other companies in Sussex specialising in these bikes. The Complainant contends that the Respondent is offering a similar range of motorcycles for sale, as well as lower quality and cheaper Chinese manufactured motorcycles into the same market.
- 5.19 The Complainant doubts that no-one has contacted the Respondent by mistake looking for the Complainant, given that the Complainant has been contacted by people looking for the Respondent. The Complainant argues that there is little difference between 'sussexmotorbikes' and 'sussexmotorcycles'. The Complainant says his customers call him Sussex Motorbikes by mistake, as well as Sussex Cycles, Sussex Bikes and Sussex. The Complainant states the website at the Domain Name is four results away from the Complainant's website when Google searches are run on "motorcycles sussex" or "sussex motorcycles".
- 5.20 The Complainant says it is difficult for him to know if prospective customers are contacting the Respondent instead of him but that his bike sales fell in 2013. The Complainant argues that the website at the Domain Name offering similar services to the Complainant in the same niche market was set up to profit from traffic looking for sussexmotorcycles.co.uk.
- 5.21 The Complainant relies on recordings (which I have heard) of two telephone calls made on 21 June 2014 to Sussex Motorbikes. In the first call the caller enquires about buying a 125cc motorcycle. The Complainant states that when the caller asks if this is Sussex Motorcycles, the reply is "yes, this is Sussex Motorbikes". In the second call the Complainant states that when the same caller asks if this is Sussex Motorcycles, the reply is "yes, this is Sussex Motorbikes" and the caller is told that Sussex Motorcycles is a website. When the caller asks about Aprilia the Complainant states she is referred to the website at getbike.net, a motorcycle training school that also sells Japanese and European second hand motorcycles. The Complainant says that the directors of the company which runs this site are relations of the Respondent. The Complainant asserts that this is an indisputable example of passing off.
- 5.22 The Complainant argues that the Domain Name is too similar to Sussex Motorcycles, invites confusion and is an abuse of his use of sussexmotorcycles.co.uk. The Complainant says he has built up the name of sussexmotorcycles.co.uk in Sussex over several years in the niche 125cc and 50cc geared motorcycle market and that the website at the Domain Name is offering cheaper, lower quality Chinese bikes into the same market as sussexmotorcycles.co.uk that detract from the Complainant's brand and trade. The Complainant contends that the Respondent's offering of the same and similar products and services into the same market, just 9 miles away, with the Domain Name that is indistinguishable from the Complainant's is abusive. The Complainant argues that this is intentional as the Respondent has an alternative

website which has been used for years offering the same products and services. The Complainant states that the Respondent admits sussexmotorcycles.co.uk has been trading for years before use of the Domain Name. The Complainant asserts that there is confusion and that it is irrelevant that Sussex Motorbikes Limited is larger than the Complainant.

## **6. Discussions and Findings**

6.1 Paragraph 2 of the Nominet DRS Policy ("the Policy) sets out that for the Complainant's complaint to succeed he must prove to the Expert 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 In this respect, while the Complainant has made allegations of passing off in his complaint, the issue for me to determine is whether the Complainant has proved to me, on the balance of probabilities, that both the above elements are present.

### **The Complainant's Rights**

6.3 Under Paragraph 1 of the Policy, Rights is defined 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*". It is well accepted that the question of Rights falls to be considered at the time the Complainant makes his complaint and is a test with a low threshold to overcome.

6.4 The Complainant contends that he owns Rights in the name Sussex Motorcycles. On the face of it this name is descriptive of the Complainant's motorcycle business based in Sussex. However, the Complainant has been trading under the name Sussex Motorcycles in the Sussex area for more than 10 years. Whilst the Complainant has not adduced any trading figures, I am satisfied that the Complainant has made sufficient use of the name Sussex Motorcycles over this time period such that it is recognised by the public in Sussex as indicating the goods and services of the Complainant, particularly in the niche 125cc and 50cc motorcycle market. Such use includes the Complainant's website and his advertising in Yellow Pages. I have also taken into account the daily phone calls he receives, his customer numbers and that there are only a few businesses in Sussex specialising in these learner bikes.

6.5 I therefore consider that the Complainant has established that Sussex Motorcycles has acquired a secondary meaning in Sussex as being distinctive of the Complainant's products and services, particularly in the niche 125cc and 50cc motorcycle market. Accordingly I consider that the Complainant has unregistered Rights through use in the name Sussex Motorcycles.

6.6 I regard the name Sussex Motorcycles to be similar to the Domain Name (disregarding the .co.uk suffix). I consider the terms 'motorcycle' and 'motorbike' to be interchangeable and, in my view, there is a high degree of similarity between 'sussexmotorcycles' and 'sussexmotorbikes'.

6.7 Accordingly, I find that the Complainant has Rights in the name or mark, Sussex Motorcycles, which is similar to the Domain Name.

### **Abusive Registration**

6.8 It now has to be considered whether the Domain Name, in the hands of the Respondent, is an Abusive Registration. 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.
- 6.9 It is sufficient to satisfy either of the limbs for there to be a finding of an Abusive Registration.
- 6.10 Paragraph 3(a) of the Policy sets out a non-exhaustive list of factors which may be evidence that the Domain Name is an Abusive Registration under Paragraph 1(i) of the Policy as follows:
  - i. Circumstances indicating that the Respondent has registered or otherwise acquired the Domain Name primarily:
    - C. for the purpose of unfairly disrupting the business of the Complainant.
- 6.11 Paragraph 3(a)(i) of the Policy relates to the Respondent's motives at the time of registration of the Domain Name. It must therefore be established that at the time of registration of the Domain Name the Respondent had knowledge of the Complainant and/or its Rights. If the Respondent, with knowledge of the Complainant, registered the Domain Name for the purpose of unfairly disrupting the business of the Complainant, by attracting users to the Respondent's site who were looking for the Complainant and once there potentially diverting users into placing business with the Respondent, this may be an Abusive Registration under paragraph 1(i) of the Policy.
- 6.12 The Respondent states the Domain Name was registered to support the business of Sussex Motorbikes Limited. The Complainant asserts that Sussex Motorbikes Limited has a connection to Bike Smart which had been trading for several years when the Domain Name was registered. The Respondent does not deny that Sussex Motorbikes Limited has some connection with Bike Smart or that Bike Smart was trading when the Domain Name was registered.
- 6.13 In my view Sussex Motorbikes Limited has some connection with Bike Smart. The website of "Sussex Motorbikes" at the Domain Name gives the same address and phone number as Bike Smart; has similar website content to that of Bike Smart; and shows photographs of people in high visibility Bike Smart jackets. The contact page of the Bike Smart website at bike-smart.net has a map with the location shown as Sussex Motorbikes rather than Bike Smart.
- 6.14 I also consider that Bike Smart was trading as a motor cycle training school when the Domain Name was registered. This is supported by the Complainant's evidence of the creation in 2004 of bike-smart.net.
- 6.15 The Complainant specialises in 50 and 125cc motorcycles which are typically sold to learner riders and which is a niche market in the Sussex area. Bike Smart is located in Haywards Heath, Sussex only about 9 miles from the Complainant's premises. The Complainant has advertised in the Brighton Yellow Pages, Motorcycle & Scooter Dealers section for 10 years which covers Bike Smart's location. Taking into account that the Complainant and Bike Smart are both based in Sussex, their geographic proximity and the nature of their businesses of dealing with learner bike riders, it is my view that personnel at Bike Smart were aware of the Complainant's Sussex Motorcycles business when the Domain Name was registered.
- 6.16 The Respondent is the manager of Sussex Motorbikes Limited who registered the Domain Name for use by this company. This is supported by the registration of the

Domain Name shortly before Sussex Motorbikes Limited was incorporated. Further the Respondent states in his response:

*“We have traded as Sussex Motorbikes Ltd since August 2012. We are a limited Company...We registered the domains www.sussexmotorbikes.com and .co.uk to support our business at the time of incorporation.”*

- 6.17 In view of the connection between Bike Smart and Sussex Motorbikes Limited, and given that the Domain Name was registered to support the business of Sussex Motorbikes Limited, I consider the Respondent must have been aware of the Complainant’s business under the name Sussex Motorcycles when the Domain Name was registered. In this respect, whilst the Respondent states that the Sussex Motorcycles website did not support a legally incorporated business before the complaint began, he has wholly failed to deal with his knowledge of the Complainant’s unincorporated business as a sole trader under the name Sussex Motorcycles at the time the Domain Name was registered. Further, he has also failed to give any background to the setting up of Sussex Motorbikes Limited, the choice of trading name or the relationship with Bike Smart.
- 6.18 It therefore has to be considered whether the Respondent registered the Domain Name for the purpose of unfairly disrupting the Complainant’s business, in order for there to be an Abusive Registration under paragraph 1(i) of the Policy.
- 6.19 In my view Sussex Motorcycles and Sussex Motorbikes are confusingly similar. I consider the terms ‘motorcycles’ and ‘motorbikes’ to be interchangeable and highly similar. I am supported in my view by the evidence of the Complainant being contacted by the Respondent’s customers and of the Complainant’s customers calling him Sussex Motorbikes in error.
- 6.20 Accordingly I consider there is a real risk that internet users will find the Respondent’s site when they are looking for the Complainant because they replace ‘motorcycles’ with ‘motorbikes’ when inputting the Complainant’s domain name into their browser. I also consider that because of the confusing similarity of ‘motorcycles’ and ‘motorbikes’ there is a real risk that internet users guessing the URL of the Complainant will use the Domain Name. Further I consider there is a real risk that internet users looking for the Complainant may mistakenly use the search term ‘sussex motorbikes’ and thereby visit the Respondent’s site.
- 6.21 Once at the Respondent’s site users will be exposed to competing goods and services of “Sussex Motorbikes” including motorcycles for sale and motorcycle servicing and repairs and there is a risk that such users may be diverted into placing business with them.
- 6.22 In my view the Respondent registered the Domain Name with knowledge of the Complainant’s business, for the purposes of unfairly disrupting the Complainant’s business by taking unfair advantage of the likely confusion of internet users to divert traffic to the Respondent’s website where users may potentially be diverted into buying goods and services.
- 6.23 However before I make a finding that there is an Abusive Registration under paragraph 1(i) of the Policy I must also take into account paragraph 4(a) of the Policy being non-exhaustive factors which may be evidence that the Domain Name is not an Abusive Registration as follows:
- i. Before being aware of the Complainant's cause for complaint (not necessarily the 'complaint' under the DRS), the Respondent has:



- A. 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; or
  - ii. The Domain Name is generic or descriptive and the Respondent is making fair use of it.
- 6.24 In relation to paragraph 4(a)(i)(A) I have found that the Respondent commenced use of the Domain Name after he was aware of the Complainant's Sussex Motorcycles business so I do not consider this factor applies.
- 6.25 In relation to paragraph 4(a)(ii), the Domain Name is descriptive of a motorbike business in Sussex. However I have found that Sussex Motorcycles has a secondary meaning in Sussex as denoting the Complainant's goods and services (particularly in the niche 125cc and 50cc motorcycle market); that the Respondent was aware of the Complainant's Rights at the time the Domain Name was registered; and that he registered the Domain Name for the purposes of unfairly disrupting the Complainant's business. In such circumstances the Respondent is not making fair use of the Domain Name and I do not consider that the factor in paragraph 4(a)(ii) applies.
- 6.26 I therefore find that the Domain Name, in the hands of the Respondent, is an Abusive Registration under paragraph 1(i) of the Policy.

**Abusive Registration under Paragraph 1(ii) of the Policy**

- 6.27 I also find that the Domain Name is an Abusive Registration under paragraph 1(ii) of the Policy. Under paragraph 3(a)(ii) of the Policy a non-exhaustive 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.
- 6.28 It is generally accepted that paragraph 3(a)(ii) of the Policy covers initial interest confusion, where internet users are likely to visit the Respondent's site in the expectation of finding the Complainant. I have found at paragraph 6.20 that there is a real risk of internet users being initially confused into visiting the Respondent's site in the expectation of finding the Complainant. Even if internet users become aware that they have not found the Complainant when they reach the Respondent's site, the Respondent has still used the Domain Name in a way to cause initial interest confusion that the Domain Name is registered to, operated or authorised by, or otherwise connected with the Complainant.
- 6.29 I therefore find that the Domain Name, in the hands of the Respondent, is an Abusive Registration under paragraph 1(ii) of the Policy

**7. Decision**

- 7.1 I find that the Complainant 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.
- 7.2 I therefore direct that the Domain Name be transferred to the Complainant.