

DISPUTE RESOLUTION SERVICE

D00014483

Decision of Independent Expert

B&Q PLC

and

Square Systems

1. The Parties:

Lead Complainant: B&Q PLC
B & Q House
Chestnut Avenue
Chandlers Ford
Eastleigh
Hampshire
SO53 3LE
United Kingdom

Respondent: Square Systems
28 Baldwin St
Bristol
Avon
BS1 1NG
United Kingdom

2. The Domain Name(s):

2.1 <tellbandq.co.uk> (the “Domain Name”)

3. Procedural History:

3.1 The procedural history of this matter is as follows:

04 July 2014 16:03 Dispute received
07 July 2014 11:58 Complaint validated
07 July 2014 13:13 Notification of complaint sent to parties
24 July 2014 02:30 Response reminder sent
25 July 2014 08:32 Response received
25 July 2014 08:33 Notification of response sent to parties
29 July 2014 12:27 Reply received
29 July 2014 12:27 Notification of reply sent to parties
29 July 2014 12:28 Mediator appointed
04 August 2014 11:37 Mediation started
07 August 2014 11:34 Mediation failed
07 August 2014 11:37 Close of mediation documents sent
13 August 2014 10:40 Expert decision payment received

3.2 I have provided confirmation to Nominet that I am independent of each of the parties and that 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 a 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 well known retailer of DIY and related products and operates under the brand name "B&Q". The first B&Q store opened in 1969 and it currently operates 330 stores across the UK and Ireland. It is currently the UK's largest DIY retailer with a turnover for the financial year ending February 2013 of £3.7 billion.

4.2 The Complainant is the owner of various trade marks that either comprise or incorporate the term "B&Q". These include:

- (i) UK registered trade mark no 1327953 in Classes 1, 2, 3, 4, 5, 6, 7, 8, 9, 11, 12, 16, 17, 18, 19, 20, 21, 22, 24, 26, 27, 28, 31 and 32 and filed on 25 November 1987 for the word mark B&Q; and
- (ii) Community trade mark no 11007119 in classes 16, 35 and 37 and filed on 2 July 2012 for the following logo:



- 4.3 The Complainant is also the owner of various domain names that it uses to promote its business. They include bandq.com, which was first registered in 2000 and bandq.co.uk, which was ordered to be transferred to the Complainant on 24 April 2007 in *B&Q PLC v Ms Oxana Ovchinnikova* DRS04478. Currently, each of these domain names are being used to redirect internet users to the Complainant's website at <http://www.diy.com>.
- 4.4 The Respondent would appear to be a limited company registered in England and Wales with company no 03047595, one of whose directors is Mr Paul Murphy.
- 4.5 The Domain Name and the domain name <tellbandq.com> were registered by the Respondent on 12 November 2013. The Respondent registered these domain names for a company called Impact Research. At that time Impact Research were tendering for "a customer experience project" that the Complainant wished to set up and the domain names were used for a website created by the Respondent to illustrate the services that Impact Research and/or the Respondent could provide to the Complainant. Impact Research were not awarded the work.
- 4.6 In late February 2014 a representative of the Complainant contacted Mr Murphy of the Respondent and asked that the domain names either be transferred to the Complainant or cancelled. The Complainant offered to pay the Respondent what it paid for the Domain Name in return for the transfer. Mr Murphy stated that the Respondent would want more money than this to reflect the time and effort that had gone into registering the domain names and creating the associated website.
- 4.7 In subsequent email correspondence in early March 2014 Mr Murphy offered to transfer the domain names to the Complainant for £600.
- 4.8 As at 19 June 2014 the web page operating from the Domain Name took the form of what appears to have been a pay-per-click domain name parking page provided by 123-reg.co.uk. The web links appearing on that page appear to have advertised bathroom related products of various companies in competition with the Complainant.

5. Parties' Contentions

Complaint

- 5.1 The Complainant contends that the Domain Name is identical, alternatively “highly similar” to its B&Q trade mark, because (a) “BandQ” is the distinctive and dominant component of the Domain Name, (b) the “tell” element of the Domain Name being a descriptive or generic term does nothing to distinguish the Domain Name from the mark; and (c) an ampersand cannot be represented in a domain name and the word “and” is commonly used to represent an ampersand and is phonetically identical.
- 5.2 The Complainant also maintains that the circumstances of the registration and the subsequent use of the Domain Name and the Respondent’s offer to sell the Domain Name (all of which are described in the Factual Background section of this decision) mean that the Respondent’s activities fall within the scope of the examples of factors which may be evidence of abusive registration set out in paragraphs 3(a)(i)(A), 3(a)(i)(C), 3(a)(ii), and 3(a)(v) of the Policy.

Response

- 5.3 Given its brevity it is convenient to set out the key sections of the Respondent’s Response in full. In particular, the Respondent states as follows:

“We registered the domain in good faith as part of a sales proposal. We registered the domains to enable us to provide an effective demonstration of the services we were proposing. We were invited to propose our services as a sub-contractor to Impact research who in turn had been invited to propose a solution by B&Q themselves.

The domain was originally used to demonstrate a survey solution. It has subsequently being left on a holding page from our domain tag holders. We do not profit in any way from any advertising shown on this page.”

We have offered to transfer the [Domain Name] to B&Q (NB the £600 quoted was to transfer 2 domains - the cost for this single .co.uk would have been £300). We regard that as a fair reflection of our costs in registering the [Domain Name], dealing with the complainant and transferring the domain.

We feel the complainant is using this process to obtain our time for free. We feel we have behaved in an entirely reasonable way and have proposed an entirely reasonable solution. We did not register this domain to profit from it. In transferring it we intended to do no more than cover our cost.”

Reply

- 5.4 In its Reply the Complainant contends that notwithstanding the Respondent’s claim that it registered the Domain Name “in good faith as part of a sales proposal”, the Complainant did not at that time authorise the Respondent to register the Domain Name.

6. Discussions and Findings

General

6.1 To succeed under the Policy, the Complainant must prove first, that he has Rights in respect of a "name or mark" that is identical or similar to the Domain Name (paragraph 2(a)(i) of the Policy) and second, that the Domain Name is an Abusive Registration in the hands of the Respondent (paragraph 2(a)(ii) of the Policy). The Complainant must prove to the expert that both elements are present on the balance of probabilities (paragraph 2(b) of the Policy).

6.2 Abusive Registration is defined in paragraph 1 of the Policy in the following terms:

"Abusive Registration means a Domain Name which either:

(i) was registered or otherwise acquired in a manner which, at the time when the registration or acquisition took place, took unfair advantage of or was unfairly detrimental to the Complainant's Rights:

OR

(ii) has been used in a manner which took unfair advantage of or was unfairly detrimental to the Complainant's Rights."

Complainant's Rights

6.3 Although the Domain Name is not identical to any trade mark in which the Complainant has rights, it is similar to such a trade mark.

6.4 In this respect I accept that the term "bandq" is an obvious way to represent the Complainant's B&Q word mark in circumstances where an ampersand cannot appear in a domain name. I also accept that the Domain Name can be sensibly read as a combination of the ordinary word "tell", the term "bandq" and the ".co.uk" suffix. The "tell" and ".co.uk" elements of the Domain Name do not so detract from the "bandq" element so as to prevent a finding of similarity, particularly when one bears in mind that this is "intended to be a relatively low-level test" (see Dispute Resolution Service – Experts' Overview Version 2, section 2.3)

6.5 In the circumstances, the Complainant has made out the requirements of paragraph 2(a)(i) of the Policy.

Abusive Registration

6.6 This is case where there is little or no dispute about the underlying facts. It seems clear that the Domain Name was registered with the Complainant's B&Q mark and name in mind, and in circumstances where the term "bandq"

incorporated within the Domain Name was intended to refer to that name and mark and to take advantage of that association.

- 6.7 The Respondent contends that this was “in good faith as part of a sales proposal” and in order to provide an “effective demonstration of the services [it was] proposing”. I am prepared to accept that the Respondent at that time may have honestly thought that this was a legitimate thing to do. However, in the absence of the Complainant’s consent to the use of its trade mark in this manner (and the Respondent does not appear to claim that any such consent was given), then I am of the view that this constitutes an abusive registration for the purposes of the Policy.
- 6.8 Although registration in such circumstances does not obviously fall within any of sets of circumstances listed in paragraph 3(i)(a) of the Policy, this is expressly stated to be a “non-exhaustive list” of factors that might evidence abusive registration or use. Ultimately, the test is whether the registration or use “took unfair advantage of or was unfairly detrimental to the Complainant’s Rights”. I think that test is satisfied in the circumstances of this case. For the Respondent to have adopted a Domain Name that incorporates the trade mark of a potential client in order to promote its or another’s services without that potential client’s consent, takes unfair advantage of the Complainant’s rights..
- 6.9 Further, regardless of whether the registration was legitimate, to continue to hold the Domain Name thereafter once the Respondent knew that those services were not wanted in the circumstances of this case constitutes abusive use.
- 6.10 In that respect it is clear from the discussion and correspondence between Mr Murphy of the Respondent and the Complainant’s representatives in February and March 2014 that the Respondent only interest in the Domain Name by that time was as an asset that might be sold to the Complainant for more than it had paid for it because it incorporated and would be perceived as associated with the Complainant’s mark. There is no suggestion that the Domain Name might be used or retained by it for some legitimate purpose.
- 6.11 Further, there is the fact that the Domain Name has been used for the display of a pay-per-click parking page that promoted links to competitors of the Complainant. This alone constituted abusive use “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” within the meaning of paragraph 3 (a)(ii) of the Policy.
- 6.12 The fact that the Respondent’s “domain tag-holders” set up this pay-per-click parking page and the Respondent did not profit from the advertising shown on that page does not matter. As is recorded in section 4.7 of the Dispute Resolution Service Experts’ Overview Version 2:

“where the domain name is connected to a parking page operated on behalf of the Respondent by a third party (eg a hosting company), the Respondent is unlikely to be able to escape responsibility for the behaviour of that third party”

- 6.13 It is a position with which I agree for the reasons I set out in some detail in *Oasis Stores Limited v J Dale* DRS 6365.
- 6.14 In the circumstances, the Complainant has made out the requirements of paragraph 2(a)(ii) of the Policy.

7. Decision

- 7.1 I find that the Complainant has Rights in a trade mark, which is similar to the Domain Name, and that the Complainant has shown that the Domain Name, in the hands of the Respondent, is an Abusive Registration.
- 7.2 I, therefore, determine that the Domain Name be transferred to the Complainant.

Signed

Dated 21st August 2014

Matthew Harris