

**DISPUTE RESOLUTION SERVICE**

**D00014644**

**Decision of Independent Expert**

The Goodwood Estate Company Limited

and

Mr J. A. Weller

**1. The Parties:**

Complainant: The Goodwood Estate Company Limited  
Goodwood  
Chichester  
West Sussex  
PO18 0PX  
United Kingdom

Respondent: Mr J. A. Weller  
Heathfield Cottage  
Bepton Road  
Midhurst  
Hampshire  
GU29 9HH  
United Kingdom

**2. The Domain Name:**

*grrc.co.uk*

### **3. Procedural History:**

12 August 2014, the Dispute was received by Nominet.  
12 August 2014, the Complaint was validated by Nominet.  
12 August 2014, the Notification of the Complaint was sent to the Parties.  
01 September 2014, the Response reminder was sent.  
03 September 2014, the Response was received.  
03 September 2014, the Notification of the Response was sent to the Parties.  
05 September 2014, the Reply was received.  
08 September 2014, the Notification of the Reply was sent to the Parties.  
08 September 2014, the Mediator was appointed.  
11 September 2014, Mediation was started.  
06 October 2014, Mediation failed.  
06 October 2014, the close of mediation documents were sent to the Parties.  
14 October 2014, the Expert decision payment was received.

I 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 Respondent registered the Domain Name on 17 August 2011.
- 4.2 The Complainant filed a UK trade mark application on 23 May 2013 in respect of various trade mark classes for the "GRRC" logo, which was granted on 30 August 2013 (UK00003007285). The Complainant also filed a UK trade mark application on 11 February 2014 in respect of various trade mark classes for the word "GRRC", which was granted on 6 June 2014 (UK00003041923).
- 4.3 The Respondent established a UK company called the Gentleman's Real Racing Company Ltd. which was incorporated on 13 August 2014 (registration number 09174505).

### **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 it has Rights in respect of a name or mark which is identical or similar to the Domain Name.
- The Complainant stated that it is the owner of Goodwood Road Racing Club (the 'Club'), has been trading since 1989 using that name, and since its inception it has been "*invariably referred to by its acronym "GRRC"*" (the 'Name'). It stated that the Club has over 5,000 members, of whom the Respondent is one.
- The Complainant submitted that it holds long-standing "*unregistered rights*" in the Name. In support of its submission, the Complainant evidenced copies of its 1998 and 1999 "Festival of Speed" programmes (to each of which, the Complainant stated, there were in the region of 100,000 attendees) and photographs showing the lapel membership badges made for the "*1998 and 1999 GRRC membership*", which the Complainant stated were sent to all its members in those years.
- The Complainant submitted that, since at least 2004, it has maintained pages at [www.goodwood.co.uk](http://www.goodwood.co.uk) through which the Complainant has promoted the Club and offered for sale "GRRC" branded merchandise (such as baseball caps and ties).
- The Complainant noted that it had registered a UK trade mark for the "GRRC" logo and also for the word "GRRC".

### **Abusive Registration**

- The Complainant submitted that the Domain Name, in the hands of the Respondent, is an Abusive Registration as the Domain Name has been used and/or was registered or otherwise acquired in a manner which took unfair advantage of or was unfairly detrimental to the Complainant's Rights.
- The Complainant submitted that its solicitors had written to the Respondent on 1 April 2014 requesting a transfer of the Domain Name to it and offering to pay the Respondent's "*reasonable out of pocket expenses for doing so.*"
- The Complainant submitted that its solicitors had spoken with the Respondent, in which conversation the Respondent had stated that he "*was a racing driver and had registered the Domain Name for an intended project called the "Gentleman's Real Racing Club".*" The Complainant stated that the Respondent had confirmed the same in correspondence with the Complainant.

- The Complainant submitted that, despite the Respondent having registered the Domain Name on 17 August 2011, the Respondent had, to the Complainant's knowledge, made no attempt to establish a web page at the Domain Name.
- The Complainant submitted that, on the balance of probabilities, the Respondent was aware of the Complainant's rights in the Name at the time of the registration of the Domain Name.
- The Complainant stated that the Respondent has been a member of the Complainant's Horse Racing Club since February 2004, Aero Club since September 2006 and Club since February 2013.
- The Complainant also stated that, in addition to the membership of the Complainant's ancillary clubs prior to registration of the Domain Name, the Respondent had been involved in motor racing since the late 1980s. In support of which, the Complainant provided an Internet profile of the Respondent which stated that the Respondent *"in a former life was a professional racing driver."*
- Therefore, the Complainant submitted, both at the time of the registration of the Domain Name and beforehand, the Respondent was active in a niche area which included the Complainant's business and would have been *"well aware of the Complainant's long-standing rights in the mark "GRRC"."*
- The Complainant submitted that, in correspondence which the Complainant evidenced, it had offered the Respondent his *"out of pocket expenses in registering the domain name [...] as well as a substantive uplift goodwill gesture"*. The Complainant stated that it had received no response from the Respondent in relation to that offer.
- The Complainant submitted that, not only is the Domain Name identical or similar to the Name in which the Complainant holds Rights, the Respondent is *"apparently proposing to use the Domain Name for a road racing club."*
- Accordingly, the Complainant submitted that the Respondent is using or threatening to use the Domain Name in a way which 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.
- In the alternative, the Complainant submitted that the Respondent has registered or otherwise acquired the Domain Name primarily:
  - o for the purposes of selling, renting or otherwise transferring the Domain Name to the Complainant for valuable consideration in excess of the Respondent's documented out-of-pocket costs directly associated with acquiring or using the Domain Name; or

- as a blocking registration against a name or mark in which the Complainant has Rights.

### **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 he had "*an idea going back a few years whilst on one of our yearly trips to Le Mans and Angouleme [being] a Gentleman's club meeting four times a year at different circuits around Europe but with a really British feel to it, a private club for wealthy investors in cars.*" He further submitted that this "*was done by also wearing Tweed and incorporating this specific Tweed within our logo.*"
- The Respondent stated that he "*felt there would be no rush in bringing this idea to reality.*" The Respondent further stated that he was "*surprised*" when he received the Complainant solicitor's letter asking for him to return the Domain Name to the Complainant "*after over 3 years of ownership.*"
- The Respondent also stated that he had always held the Complainant with "*high esteem and [was surprised] for them to treat a member of the public this way and especially one who has been a member with them for many years.*"
- The Respondent stated that he had not approached the Complainant in anyway but that he wanted the Domain Name "*for our own use.*"
- The Respondent submitted that, earlier in 2014, he had given the "*go ahead*" to a web design company called Skye Creative and that they "*are making the website ready for the launch later this year.*" To this end, the Respondent evidenced a logo that Skye Creative had prepared.
- The Respondent further stated that he had set up a registered company, the Gentleman's Real Racing Company Ltd. (the 'Company'), which has a bank account, and that his club is an "*ongoing project with money already invested by our clients into the cars.*"

### **Complainant's Reply**

5.3 In summary, the Complainant submitted that:

- the Respondent had not denied that the Respondent "*was aware of the Complainant's rights at the time of registration of the Domain Name.*" The Complainant referenced the Respondent's response that it had "*always held [the Complainant] with high esteem.*"

- The Complainant submitted that the Respondent did not state when Skye Creative had been instructed by the Respondent to prepare a website for launch (other than, it submitted, the vague assertion that it was "*earlier in the year*"). The Complainant further stated that the Respondent had produced no evidence of work carried out by Skye Creative other than the logo submitted as part of the Response.
- The Complainant noted that Skye Creative Limited had not been incorporated until 11 July 2014 (evidencing its Incorporation Certificate) and the Complainant submitted that the logo could not have been designed before then.
- The Complainant submitted that, as the Company was incorporated on 13 August 2014, the bank account cited by the Respondent cannot have been set up before then.
- The Complainant submitted that the "*stock image of tweed [in the Respondent's logo] is of no relevance.*"
- The Complainant submitted that the Respondent had "*clearly manufactured evidence in his Response for the sole purpose of persuading the Expert that he had a long standing plan for use of the Domain Name.*"
- The Complainant further submitted that "*such a plan simply did not exist*" and "*that the Domain Name was registered for the sole purpose of exploiting the Complainant's rights.*"

## 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 probabilities:<sup>1</sup>

*"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*

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<sup>1</sup> 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/>.

6.3 The Expert considers that, for the reasons set out below, the Complainant has Rights in a name or mark which is identical to the Domain Name.

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 [...]"*

The Complainant must have the Rights in question at the time of the complaint.<sup>2</sup>

6.5 The Expert notes that, as referenced by the Complainant and summarised at paragraphs 4.2 and 5.1 above, the Complainant is the proprietor of a number of trade mark registrations in respect of the Name, including one of the Name in word version.

6.6 In any event, the above definition of Rights also embraces enforceable rights other than a registered trade (or service) mark.

6.7 In this regard, the definition of Rights includes a reference to unregistered trade marks which indicate to the purchasing public the goods and/or services of the Complainant (i.e. that the Complainant has generated sufficient goodwill and reputation in the name).<sup>3</sup>

6.8 The Expert considers that through the Complainant advertising its services using the Name (since at least 1998), offering for sale its goods such as caps and keyrings branded with the Name, and its general longevity in the market place (trading since 1989), the Complainant has developed considerable goodwill and reputation in the Name sufficient for the Name to be indicative of the Complainant's business.

6.9 Given those factors, the Expert considers that, at the time of the Complaint, the Complainant had Rights in the Name/Mark, which is identical to the Domain Name. In concluding the above, the Expert has disregarded the domain suffix 'co.uk' and the hyphens.

6.10 Thus, 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 sufficient to establish that, at the time of the Complaint, the Complainant had relevant Rights in relation to the Domain Name.

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

<sup>3</sup> 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.

*ii) Abusive Registration*

6.11 For the reasons set out below, the Expert considers that the Domain Name is an Abusive Registration as understood by the Policy.

6.12 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;"*

6.13 *In relation to i. above* – the Expert considers that the Domain Name was an Abusive Registration at the time the Domain Name was registered.

6.14 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, the Expert considers that the factor set out at paragraph 3 a. i. C. is relevant: namely, where the Respondent has registered the Domain Name primarily "*for the purpose of unfairly disrupting the business of the Complainant;*"

6.15 In relation to the above factor, the Respondent's knowledge of the Complainant when registering the Domain Name needs to be shown.<sup>4</sup> In this regard, the Expert notes that the Respondent stated that he was "*a member with [the Complainant] for many years*", and that the Respondent had been a professional racing driver prior to the registration of the Domain Name.

6.16 Given the above, and that the Complainant had developed considerable goodwill and reputation in the Name by the registration date (see paragraphs 6.7 and 6.8 above), the Expert considers that the Respondent would have been well aware of the Complainant and its Name at the time of his registration of the Domain Name.

6.17 The Expert considers that the Respondent specifically chose to register the Domain Name to benefit from the Complainant's goodwill and reputation in order to attract to any website he set-up using the Domain Name users who would be looking for the Complainant.

6.18 The Complainant also submitted that the Respondent had registered the Domain Name primarily for the purposes of selling the Domain Name to the Complainant for valuable consideration "*in excess of the Respondent's documented out-of-pocket costs directly associated with acquiring or using the Domain Name*" (as set out at paragraph 3. a. i. A. DRS Policy).

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<sup>4</sup> Based on previous DRS decisions (e.g. DRS appeal decision *verbatim.co.uk* (DRS 4331)).



- 6.19 However, the Expert does not consider there is sufficient evidence to support such a submission. In this regard, the Expert notes that in the correspondence between the Parties the Respondent did not respond when the Complainant proposed a sum of £500 to acquire the Domain Name, which the Complainant stated reflected the Respondent's out of pocket expenses and a "*substantive uplift goodwill gesture.*"
- 6.20 The Complainant also submitted that the Respondent had registered the Domain Name primarily as a blocking registration against the Name. However, again the Expert does not consider that there is sufficient evidence to support such a submission.
- 6.21 Indeed, based on the evidence before him, and as submitted by the Respondent, the Expert considers that it was the Respondent's intention to set up a website linked to the Domain Name to promote the car racing club he intended to run, albeit he choose to register the Domain Name to benefit from the Complainant's goodwill and reputation as described above.
- 6.22 Therefore, for the reasons set out above, the Expert considers that the registration of the Domain Name took unfair advantage of, and/or was unfairly detrimental to, the Complainant's Rights.
- 6.23 In relation to (ii) above – the Expert also considers that the Domain Name was an Abusive Registration as a result of its manner of use by the Respondent.
- 6.24 The Expert considers paragraph 3 a. ii. of the Policy as relevant, whereby a factor which may be evidence that the Domain Name is an Abusive Registrations 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;"*
- 6.25 The Expert considers that the Respondent is threatening to use the Domain Name in a way that 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.
- 6.26 The Respondent submitted that he intends to set-up a car club "*meeting four times a year at different circuits around Europe*" and that he had given the "*go ahead*" to a design company to make the Domain Name's website ready for launch "*this year.*"

- 6.27 The Expert considers that anyone accessing a website set-up using the Domain Name would likely be confused, at least initially,<sup>5</sup> into thinking that that website is the Complainant's or is somehow connected with the Complainant. The Expert is not persuaded by the argument that a person accessing that website would soon realise their mistake, the damage to the Complainant's business would have already been done. Those persons accessing that website would have only done so because of the Complainant's goodwill and reputation in the Name/Mark.
- 6.28 The Expert considers that, by using the Domain Name as described above, the Respondent has taken at least unfair advantage of the Complainant's Rights.
- 6.29 As mentioned above in relation to the first limb of Abusive Registration, the Policy sets out a non-exhaustive list of factors which may be evidence that the Domain Name is not an Abusive Registration. However, the Expert considers that the evidence before him does not support the Respondent's contention that the Domain Name is not an Abusive Registration.
- 6.30 In particular, as referenced above at paragraphs 6.15 and 6.16, the Expert considers that the Respondent would have been aware of the Complainant's cause for complaint at the time of the registration of the Domain Name and therefore the Respondent cannot rely on the factors set out in paragraph 4. a. i. of the DRS Policy as evidence that the Domain Name is not an Abusive Registration.
- 6.31 Further, while the Expert notes that the Respondent has incorporated a company under the name "Gentleman's Real Racing Company Ltd." (the Company having been registered the day after the Complaint was logged with Nominet), the Expert considers that the mere registration of a name cannot by itself give rise to a right within the definition of Rights above. To this end, the Expert does not consider that the Respondent has provided any compelling evidence that he has Rights in the Name.

## **7. Decision:**

- 7.1 The Expert finds that, on the balance of probabilities, the Complainant has Rights in respect of the Name/Mark which is identical to the Domain Name and that the Domain Name in the hands of the Respondent is an Abusive Registration. Therefore, the Expert directs that the Domain Name be transferred to the Complainant.

**Signed: Dr Russell Richardson**

**Dated: 7 November 2014**

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<sup>5</sup> 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). See also the DRS Experts' Overview at paragraph 3.3.