

DISPUTE RESOLUTION SERVICE

D00015352

Decision of Independent Expert

Mr. Michael Froude

and

Joinery Consultancy Ltd

1. The Parties:

Complainant: Mr. Michael Froude
66 Durham Road
Edinburgh
EH15 1PF
United Kingdom

Respondent: Joinery Consultancy Ltd
44 Melbourne Close
Derby
DE3 9LG
United Kingdom

2. The Domain Name:

ukdirectdoors.co.uk

3. Procedural History:

I 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.

09 February 2015, the Dispute was received.
10 February 2015, the Complaint was validated.

10 February 2015, notification of the Complaint was sent to the Parties.
27 February 2015, a Response reminder was sent.
03 March 2015, a Response was received.
03 March 2015, the notification of the Response was sent to the Parties.
06 March 2015, a Reply reminder was sent.
11 March 2015, a Reply was received.
11 March 2015, the notification of the Reply was sent to the Parties.
11 March 2015, a Mediator was appointed.
18 March 2015, mediation started.
03 June 2015, mediation failed.
03 June 2015, close of mediation documents were sent.
04 June 2015, the Expert decision payment was received.

4. Factual Background

- 4.1 The Complainant is the proprietor of U.K. Trade Mark No. 2448292 (registered on 17 April 2009) in relation to "DIRECTDOORS.COM" and a colour and monochrome rendering of the same (both collectively, the 'Mark').
- 4.2 The Mark is registered in trade mark classes 19 (doors, door frames; door fittings) and 35 (retail services connected with the sale of doors, door frames and door fittings).
- 4.3 The Complainant is a director and major shareholder of The Door Centre Ltd. ('TDCL'), a company incorporated on 3 November 1988 in the UK (Company number SC114318) which operates a website at www.directdoors.com under the name DIRECTDOORS.com where it sells door-related goods/services.
- 4.4 The Respondent's company number is 07798628 and it was incorporated on 5 October 2011.
- 4.5 The Domain Name was registered by the Respondent on 21 March 2012 and is being used by the Respondent to run a website that sell doors, door frames and door fittings.

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 noted that he has a registered trade mark in "DIRECTDOORS.COM" whose trade mark registration pre-dates the registration of the Domain Name "by more than three years."
- The Complainant explained that TDCL provides a one stop shop for all the items associated with the supply and fitting of domestic doors to the trade and public, whether on a DIY or an installed basis.
- The Complainant stated that he is both a director and shareholder of TDCL (evidencing a copy of TDCL's October 2014 Annual Return) and that, in its early days, TDCL traded throughout East Central Scotland and that the business "*expanded rapidly and opened showrooms in Edinburgh, Stirling and Dunfermline.*"
- The Complainant submitted that, through TDCL, he can demonstrate 16 years of usage of "DirectDoors" (the 'Name'), which TDCL uses to promote its goods and services on its website, and substantial associated investment. The Complainant stated that he developed a website for TDCL using the website address www.directdoors.com during 2001, having already registered the domain name <directdoors.com> in 1999.
- The Complainant submitted that he can, therefore, "*demonstrate [the] use of the "DirectDoors" brand in respect of a 'bricks and mortar' business since 1988 and in relation to a website since 2001.*"
- The Complainant stated that the original TDCL website was effectively an online brochure but that, during 2003 to 2004, the Complainant secured funding from "*Scottish Enterprise and Microsoft Scotland*" to develop a proper "*DirectDoors ecommerce website.*" The Complainant stated that that website "*was very successful and began to create sales from the outset.*"
- The Complainant stated that, in 2005, the "DirectDoors website" won the *Best Sales & Marketing Online Regional and Best Customer Care Online Awards* in the Scottish Enterprise E-commerce Awards 2005, and that such awards were promoted by the DTI, British Chambers of Commerce, CBI, Napier University, Information TV and "Inter Forum" which are nationally recognised bodies.
- The Complainant explained that TDCL's trading continued to grow and, in 2007/8, TDCL had sales of just under £2 million; with most of those sales coming from the England/Wales regions and the balance from Scotland. He further stated that, currently, over 90 % of TDCL's sales orders are from England and Wales.

- The Complainant explained that "TDCL managed to survive" the recession and that TDCL decided to "redesign the DirectDoors.com website site at a cost of £60k, of which £12k was a grant from Scottish Enterprise."
- The Complainant submitted that "Direct Doors" had brand usage and awareness on the Internet, and provided the Expert with a breakdown of TDCL's investment in the DirectDoors brand as from April to September 2014 (e.g. Advertising spend £36k, web developer spend £6k).
- The Complainant stated that TDCL had "experienced an increase in turnover of £315k for the first six months of 2014 this financial year compared to 2013" and that "Turnover is expected to be in excess of £3 million during 2015-2016 and £4.5 to £5 million during 2016-17."
- The Complainant also provided as part of his submission statistics related to social media outlets usage such as Facebook and Youtube (e.g. Facebook, 2294 likes, Youtube 157,000 video views).

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 the "principal" of the Respondent, Mr. Shaw, is also the principal of another company named "Vibrant Doors Ltd." which was incorporated on 10 August 2012. The Complainant noted that the date of incorporation of the Respondent and Vibrant Doors Ltd are both many years after the dates on which TDCL was incorporated (1988) and DirectDoors.com was registered (1999).
- The Complainant submitted that it "is probable that the Respondent arrived at the [Domain Name] with reference to and with knowledge of the Complainant's rights, viz both the trade mark and the established goodwill of the Complainant's "Direct Doors" trading style." The Complainant submitted that the most likely explanation is that the principal of the Respondent is using the Domain Name with the intent of trying to capture web traffic and customers intended for the Complainant.
- The Complainant submitted that the Domain Name, if used to promote any business supplying doors and door-related goods and services, would infringe the Complainant's rights as a registered Trade Mark owner for the registered Classes of goods and services.

- The Complainant submitted that the Domain Name was registered as part of a strategy of passing off a connection between "UKDirectDoors" and the Name/Mark. The Complainant further submitted that, in using the Domain Name and the trading style "UK Direct Doors", the Registrant, is *"passing off a connection with the Complainant's established business and seeking to capitalise on the goodwill"* in the Name/Mark name as built up by the Complainant.
- The Complainant submitted that there existed a likelihood of confusion between the two trading names and that it is likely that customers may assume that the two businesses are either the same or connected businesses. In support of his submission, the Complainant referenced phone calls at the Complainant's offices, which he stated had been received by people looking for, in effect, the Respondent.
- The Complainant submitted that the Domain Name seeks unfairly to exploit the goodwill which exists in the Name/Mark by selecting a domain that promotes the same classes of goods and services as those in which the Complainant was already been dealing in prior to registration of the Domain Name, and has been doing for many years.
- The Complainant stated that *"it appears, at least from its annual accounts, the Respondent is not trading."* The Complainant further stated that, if that is so, *"what legitimate reason can the Respondent give to retain the domain."*
- The Complainant also stated that it *"relies upon Mr Shaw's reply to the Complainant's solicitor's letter, dated 23rd January 2014"* referencing, in particular, the Respondent's statement in that letter that, to *"resolve matters he (Complainant) is more than welcome to make an offer to buy the site and the company if he so wishes."*

[The Expert notes that the above referenced correspondence is marked *"without prejudice."* Under Nominet's DRS Policy, at paragraph 6, *"[d]ocuments and information which are 'without prejudice' (or are marked as being 'without prejudice') may be used in submissions and may be considered by the Expert."*]

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 Complainant's Rights

- The Respondent noted that the Complainant had submitted that he could demonstrate his use of the "DirectDoors" brand in *"respect of a 'bricks and mortar' business since 1988 and in relation to a website*

since 2001." The Respondent denied *"the accuracy of that statement"*, and submitted that it appeared to be *"deliberately contrived to try and mislead and exaggerate the use of the DirectDoors brand."*

- The Respondent submitted that the Complainant's claims only *"support the presence of the TDCL brand between 1988 and 2001"*, and no evidence had been provided by the Complainant to suggest any use of a *"DirectDoors"* brand by the Complainant anywhere, either physical or online, prior to 2001.
- The Respondent submitted that the Complainant had shown no real *"exposure"* of the *"DirectDoors"* brand until 2003/2004 and there *"is no hard evidence to support the Complainant's assertions."*
- The Respondent noted the Complainant's *"achievement for the DirectDoors website at the Scottish Enterprise E-Commerce Awards 2005"* and submitted that that is not evidence of the DirectDoors brand being known throughout the UK, only in Scotland (noting that the Complainant is a Scottish Company). The Respondent further noted that the only evidence in support of the Complainant's claim was a copy of the award certificate for the *"Best Customer Care Online Category"* and that the award certificate only referenced TDCL and made no reference to a *"DirectDoors"* brand or website.
- The Respondent submitted that the Complainant had registered protection for *"DIRECTDOORS.COM"* and not for *"DIRECT DOORS"*, which it submitted is in common usage and is therefore, arguably, generic. Further, the Respondent submitted that the Complainant had failed to demonstrate the existence of relevant goodwill through use of the *"DirectDoors"* brand accruing to the benefit of either the Complainant or TDCL.
- The Respondent submitted that there was no indication as to how much of the Complainant's business was through its website or how prominent any DirectDoors branding was on its website. The Respondent stated that it *"might be that the majority of the business was at the physical premises of TDCL, or by telephone or through mail order, and the website only played a minimal, if any, role in the marketing and sales of the Complainant's business."* The Respondent submitted that, if that was the case, the consequence would be very little promotion and recognition of the online Direct Doors brand.
- The Respondent submitted that the Complainant's claim that over 90 % of TDCL's current sales orders are from England and Wales did not assist in a claim of any goodwill in England and Wales prior to the registration and use of the Domain Name.
- Further, the Respondent submitted that the forecasted turnover figures the Complaint provided failed to provide any supporting

evidence for the "*efficacy and national awareness of the DirectDoors brand*" as the figures did not indicate how much of the turnover was attributed to sales through the physical stores of TDCL, or by telephone or through mail order, which operate under the TDCL brand.

- The Respondent submitted that the wording of the Complaint suggested that the Complainant and TDCL are separate entities and it was unclear how the Complainant can benefit from the alleged goodwill of TDCL through the claimed use of the "*DirectDoors*" brand, unless the Complainant accepted that the ownership of a domain name (or trade mark registration) does not have to coincide with identity of the business operating through the website.

Abusive Registration

- The principal of the Respondent stated that he refuted "*any assertion that the Domain amounts to an abusive registration.*"
- The Respondent submitted that there "*is no evidence whatsoever to point towards the Respondent being aware of the Complainant's use of DirectDoors either at the time the Domain was registered or at the time business was commenced under the Domain.*" The Respondent further submitted that the evidence adduced by the Complainant "*at best allows for the possibility of local knowledge of the Complainant's business in Scotland under the TDCL brand. The Respondent is based in Derby and would be very unlikely to have such local knowledge.*"
- The Respondent submitted that Section 10(2) of the Trade Marks Act 1994 clearly states that a likelihood of confusion must be present for there to be a finding of trade mark infringement. The Respondent submitted that the Complainant had not provided any evidence of the marketplace in relation to the use of the term "Direct" in relation to doors and door related services which would be necessary to determine any likelihood of confusion between the Domain Name and *DirectDoors.com*.
- The Respondent submitted that, even if the Complainant has goodwill in "Direct Doors", "*the argument for misrepresentation through use of the Domain has not been substantiated.*"
- The Respondent submitted as evidence the first three pages of results from a Google search it had undertaken for the words "direct" and "doors". The Respondent submitted that, from the results of that search, there are a large number of unrelated active websites for the sale of doors and door related services all utilising the adjective "direct" in conjunction with, or in close proximity to, the noun "doors".

- The Respondent submitted that the "*average consumer of doors and door related services*" is "*well used*" to distinguishing between the goods and services of unrelated third parties all using the words "direct" in relation to doors. The Respondent suggested that the inherent distinctiveness of the *DirectDoors.com* mark is very low and "*any claim of obvious infringement of the Complainant's trade mark rights cannot be substantiated.*"
- The Respondent submitted that the Complainant's claim of a passing off strategy could not be maintained on the basis of the evidence of goodwill provided by the Complainant. He further submitted that the Complainant's claims of actual confusion were not supported with evidence and there was no evidence that any goodwill, if it existed to the benefit of either the Complainant or TDCL through use of the "*DirectDoors*" brand, existed outside of Scotland.
- The Respondent submitted that the Complainant made a comparison between the product photographs on the respective websites of the Complainant and the associated Vibrant Doors Ltd company but that the same photographs are used should "*be no surprise as the photographs are for the same product as there are only so many ways in which the same product can be visually represented.*" The Respondent submitted that such an observation cannot support the Complainant's claim that the use of the Domain Name is intended to try and capture web traffic and customers intended for the Complainant.
- The Respondent stated that it had "*obtained analytics for the UK Direct Doors website*" and that less "*than 0.001% of traffic to the UK Direct Doors website has been from the public searching for "direct doors".*" The Respondent submitted that the analytics results were indicative that the Domain Name was not obtained to try and divert business away from "*DirectDoors*" as any such attempt would require more than just the Domain Name due to the number of other traders revealed by a search for "*direct doors.*"
- The Respondent further submitted that the websites of the Respondent and the Complainant were clearly different with regard to branding and get-up (providing the Expert with print-outs for comparison).
- The Respondent stated that the Complainant had asserted that the Respondent's accounts show that it is not trading; however, for online businesses, there is no requirement that the business accounts must be in the same name as the Domain Name registrant and thus, an analysis of the accounts filed for the Respondent cannot be indicative or supportive of an abusive registration.
- The Respondent submitted that "*there was at the outset and there has been and still is an ongoing real and honest intention to use the*

Domain in connection with a genuine offering of goods and services."

Complainant's Reply

5.3 In summary, the Complainant submitted that:

- The Complainant and Respondent are both web-based businesses.
- The Respondent is in the same line of business as the Complainant.
- A registered trade mark is a matter of public record and it *"ought to have been obvious that "ukdirectdoors" used with an online door sales website would risk infringing "Directdoors.com" already in use with an online door sales website."*
- While he accepted that the *"DirectDoors"* brand had only been available via a website since 2001 (the Complainant submitted printouts from the Internet Archive (Wayback machine) which showed there was an active site as at 8 March 2001) nonetheless, this represented fourteen years of web usage.
- TDCL's sales are now *"almost entirely internet based, reflecting its marketing effort"* (the Complainant provided the Management accounts for TDCL, which showed as from 2010 to the end of 2014 a "Sales-web" entry showing sales generated - £1,263,411 from January 2014 to January 2015).
- The award received for the TDCL's website in 2005 is clearly noted as being a Regional award for a National competition and that the award received related to TDCL through its *"DirectDoors.com"* brand.
- There are no physical barriers to trading anywhere in the world; thus, there should be no necessity to provide proof of trading UK-wide in the early days. Further, TDCL being part of the "new" platform for business expansion (i.e the web) would open the door to sales throughout the UK for TDCL through its *"DirectDoors.com"* brand.
- There is not (and there has never been) a web presence for TDCL, TDCL is the company *"that uses"* DirectDoors.com as a *"web trading name"* (the Complainant provided a summary of TDCL's web-based advertising for 2014/2015).
- The Complaint is not about the term *"direct"* used in isolation; rather, it is that the Domain Name used in relation to online door sales must *"inevitably infringe"* the Mark *"directdoors.com"* used in relation to online door sales and that the two domains both incorporate the composite term *"directdoors"*.

- The Respondent did not provide an explanation as to *"how and why the Respondent selected the domain "ukdirectdoors.co.uk" over all possible names for his website."*
- A printout provided from Google Analytics relating to directdoors.com, from 3 Feb 2005 - 5 Mar 2015, details page views (39,804,152) and sessions (6,291,992), noting that 86.71 % of the sessions were from England.
- The Vibrant Doors Ltd website and the Website are virtually identical and the Respondent failed to explain why the Website was needed and why it was set up in the face of the Mark or the Website.
- The Respondent had produced no evidence of any *"strategic plan" or "of the searches it undertook before embarking upon ukdirectdoors.co.uk"*; a Google search or a trade mark search would have *"called attention to a potential problem."*

6. Outstanding formal/procedural issues

Respondent's Non-standard Submission

- 6.1 On 5 June 2015, the Respondent submitted a non-standard submission to Nominet under paragraph 13b of Nominet's DRS Procedure (the 'Procedure'). Nominet sent that submission to the Expert for him to decide whether or not to accept it as a record in the Dispute. The Expert replied accepting the submission and asked that it be sent to the Complainant for his comments. The Complainant replied to that submission on 18 June 2015.
- 6.2 In its cover letter, the Respondent made its request to submit a non-standard submission *"to provide a list of bullet points highlighting issues arising from the complainant's Reply and the Exhibits that were provided, which he was aware of, and withheld, before and during the time in which his complaint was being processed which needs to be considered by the expert in his assessment."*
- 6.3 However, the Respondent used its non-standard submission primarily to repeat various previous submissions it had already made. The Respondent also provided new submissions based on Google Analytics it had collected which, it submitted, questioned the validity of the general usage of the *www.directdoors.com* website.
- 6.4 In response, the Complainant submitted that the Respondent's non-standard submission raised no relevant new issue of fact. Further, the Complainant, in addition to repeating various submissions made previously, submitted some Pay Per Click (PPC) research *"in relation to the Respondent"*

which, it claimed, showed "a *blatant and egregious strategy on the part of the Respondent to target the words "Direct Doors" in the Respondent's PPC campaign.*"

- 6.5 On 18 June 2015, the Respondent requested that it submit a second paragraph 13b submission. However, the Expert, noting paragraph 13b of the Procedure, declined that request by the Respondent.

7. Discussions and Findings

General

- 7.1 To succeed in the Complaint, the Complainant has to prove pursuant to paragraph 2 of the Policy that, on the balance of probabilities:

"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."

- 7.2 Addressing each of these limbs in turn:

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

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

- 7.4 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.¹

- 7.5 The Expert notes that, as referred to by the Complainant and as summarised at paragraphs 4.1 and 5.1 above, the Complainant is the proprietor of a trade mark registration in respect of "DIRECTDOORS.COM" which is used by the Complainant's company, TDCL, as its online trading name to promote its online services.

- 7.6 As the above definition of Rights also embraces enforceable rights other than a registered trade (or service) mark, the Expert has considered whether or not such a non-registered enforceable right arises in the Name. In this regard, the definition of Rights includes a reference to "*rights in*

¹ See for example, Nominet Appeal decision, *ghd.co.uk*, DRS No. 03078, at page 9, para 9.2.2.

descriptive terms which have acquired a secondary meaning", such a secondary meaning indicating to the purchasing public the goods/services of TDCL and, in this way, the Complainant.

7.7 While the Expert considers that the Name, "*DirectDoors*", is made up of two common words added together, "*direct*" and "*doors*", the Expert considers that such words are not common together and are capable of acquiring a secondary meaning.

7.8 As to whether they have acquired a secondary meaning, the Expert considers relevant to this consideration is whether:²

(a) the Complainant has used the Name for a not insignificant period and to a not insignificant degree; and,

(b) the Name is distinctive of (i.e. indicates to the purchasing public (including trade purchasers)) the goods or services of the Complainant.

Addressing each of these considerations in turn:

7.9 In relation to consideration (a), the Expert notes that the Complainant's company, TDCL, was incorporated in October 1988, and TDCL set up its online presence using the Name in 2001. Therefore, the Expert considers that the Complainant, in this way, has used the Name for a "*not insignificant*" period.

7.10 In addition, the Expert considers that the use of the Name by the Complainant has been to "*a not insignificant degree*." As mentioned above, for example, the Complainant has run TDCL for over 14 years, in 2007/2008 TDCL had sales of "*just under £2 million*", and the Complainant has generated sufficient business and consequent turnover to keep TDCL running for that length of time (e.g. the Complainant provided TDCL's Management Accounts for year ending 2010 – 2014).

7.11 In relation to consideration (b), the Expert considers that, on the balance of probabilities, there is sufficient goodwill and reputation in the Name to indicate to the purchasing public the goods or services of TDCL and, thus, the Complainant.

7.12 The Respondent submitted that the Complainant's evidence only supported the presence of the "*TDCL brand between 1988 and 2001*" and that no evidence had been provided by the Complainant to suggest any use of the Name/Mark by the Complainant prior to 2001. The Respondent also submitted that there was no evidence of the "*DIRECTDOORS*" brand being known throughout the UK, "*only [...] in Scotland*".

² See, for example, paragraph 2.2. of Nominet's DRS Experts' Overview.

- 7.13 In addition, much was made by the Respondent as to general usage of the TDCL's website based on Google analytics that had been provided as part of the Respondent's 13b Policy non-standard submission.
- 7.14 The Expert considers that, on the balance of probabilities, the Complainant's company, TDCL, has used the "*DirectDoors*" Name/brand at least since 2001, TDCL has had at least a UK online presence since 2001 (as referenced for example by the Scottish Enterprise E-commerce Awards, 2005) and TDCL has generated considerable sales (noting the Complainant's reference to TDCL generating sales of "*just under £2 million*" in 2007/8 and TDCL's management accounts).
- 7.15 There are references in the Respondent's submission as to whether, in effect, the Complainant is the correct person to have brought the Complaint as the use of the Name/Mark in trading has been by the Complainant's company, TDCL, and not by the Complainant himself.
- 7.16 In this regard, the Expert notes paragraph 1.1 of the Nominet Experts' Overview,³ which sets out that the Complainant should be the owner/licensee of the Rights in the name or mark. In this context, the Complainant is the proprietor of the Mark and, through TDCL's use of the Name/Mark, the Complainant's company (noting that the Complainant is both a director and major shareholder in TDCL) has generated sufficient goodwill in the Name.
- 7.17 Finally, the Expert considers that the Domain Name prefix 'uk' as a geographic indicator does not sufficiently distinguish the Domain Name from the Mark/Name.
- 7.18 Given those factors, and noting that the requirement to demonstrate 'Rights' is not a particularly high threshold (Nominet appeal panel decision, *Seiko-shop* DRS 00248), the Expert considers that, at the time of the Complaint, the Complainant had Rights in the Name/Mark which is similar to the Domain Name. In concluding the above, the Expert has disregarded the Domain Name suffix "*co.uk*".

Abusive Registration

- 7.19 For the reasons set out below, the Expert considers that the Domain Name is an Abusive Registration as understood by the Policy.
- 7.20 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

³ http://www.nominet.org.uk/sites/default/files/drs_expert_overview.pdf

ii. has been used in a manner, which has taken unfair advantage of or has been unfairly detrimental to the Complainant's Rights;"

- 7.21 *In relation to i. above*, the Expert considers that the Domain Name was an Abusive Registration at the time the Domain Name was registered.
- 7.22 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;*"
- 7.23 In relation to the above factor, the generally held view amongst DRS Experts and one the Expert agrees with is that in cases of this sort, the Respondent should have had knowledge of the Complainant and/or its Rights when registering the Domain Name. In this regard, in particular, the Expert notes that TDCL has had an online presence since 2001 and TDCL and the Respondent are in the '*same line of business*' (i.e. the sale of Doors/fitting of Doors). Indeed, as referenced by the Respondent, TDCL's and the Respondent's web portals offer for sale similar doors.
- 7.24 Further, as the Respondent's intent was to set up a UK-wide online business competing with TDCL and others, the Expert considers that the principal of the Respondent would have researched the market he was looking to enter into and it is highly likely that he would have found reference to the TDCL, its brand and its *directdoors.com* domain name prior to the Respondent registering the Domain Name.
- 7.25 Given the above, the Expert considers that the Respondent would have been well aware of TDCL, and thus the Complainant's Mark/Name, at the time of the registration of the Domain Name.
- 7.26 Indeed, on the balance of probabilities, the Expert considers that the Respondent specifically chose to register the Domain Name to benefit from TDCL's goodwill and reputation in order to compete against the Complainant and his company, by attracting to any website that was set-up using the Domain Name users who would be looking for TDCL.
- 7.27 Therefore, for the reasons set out above, the Expert considers that the registration of the Domain Name took unfair advantage of, and was unfairly detrimental to, the Complainant's Rights.
- 7.28 *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.
- 7.29 The Expert considers that paragraph 3 a. ii. of the Policy is relevant, whereby a factor which may be evidence that the Domain Name is an Abusive Registration is:

"Circumstances indicating that 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 or authorised by, or otherwise connected with the Complainant;"

- 7.30 The Expert considers that anyone accessing the website linked to the Domain Name (the 'Website') would likely be confused, at least initially, into thinking that the Website is the Complainant's company, TDCL, or is somehow commercially connected with the Complainant's company.
- 7.31 In this regard, the Expert is not persuaded by the argument that a person accessing the Website would soon realise his/her mistake because of the differences between the Website and TDCL's website (including, for example, the Respondent's use of a different logo); the damage to the Complainant's business would already have been done. Indeed, the Expert considers that it is likely some persons accessing the Website would have done so because of the Complainant's company's goodwill and reputation in the Name/Mark.
- 7.32 The Expert considers that, by using the Domain Name as described, the Respondent has taken unfair advantage of the Complainant's Rights. Also, that such use of the Domain Name as described is unfairly detrimental to the Complainant's Rights as the Complainant's company is likely to have lost direct sales due to the Respondent's use of the Domain Name.
- 7.33 The Expert has considered whether or not there is evidence before him to demonstrate that the Domain Name is not an Abusive Registration (noting in particular the submissions made by the Respondent relating to the Domain Name being generic or descriptive and the Respondent is making fair use of it (paragraph 4. C. ii. of the Policy)) but does not consider there is. In this regard, the Expert particularly notes his comments regarding whether or not the Domain Name is generic or descriptive at paragraphs 7.6 *et seq.* above.
- 7.34 Therefore, for the reasons set out above, the Expert considers that the use of the Domain Name took unfair advantage of, and was unfairly detrimental to, the Complainant's Rights.

8. Decision

- 8.1 The Expert finds that, on the balance of probabilities, the Complainant has Rights in respect of the Name/Mark which is at least similar 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 14 July 2015