

DISPUTE RESOLUTION SERVICE

D00015356

Decision of Independent Expert

Dominic Walker

and

Identity Protect Limited

The Parties

Lead Complainant: Mr Dominic Walker

Rest Harrow

The Street

West Clandon

Surrey

GU4 7SY

United Kingdom

Complainant: Mr Alan Williams

8 Merrick Court

Merchants Quay

Bristol

BS1 4RL

United Kingdom

Respondent: Identity Protect Limited
PO Box 795
Godalming
Surrey
GU7 9GA
United Kingdom

The Domain Name

theinstituteofcertifiedlocksmiths.co.uk

Procedural History

1. 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.
2. The following are the main procedural steps and events in this case, -

16 January 2015	Complaint received by Nominet.
04 February 2015	Response received by Nominet.
10 February 2015	Reply received by Nominet.
22 April 2015	Mediation failed.
06 May 2015	Expert decision payment received.

Factual Background

3. The Lead Complainant ('the Complainant') is a founder member of the Institute of Certified Locksmiths ('ICL' or 'the Institute') and the owner of UK registered trade mark no: 00002511132 consisting of a stylised version of the words THE INSTITUTE OF CERTIFIED LOCKSMITHS. ICL was established in 2005 and is an association representing professional locksmiths,

which certifies the quality of the services of its members and also provides locksmith training services.

4. The Respondent registered the Domain Name on 28 November 2014. The Domain Name has been linked to a web site at www.needalocksmith.com, a web site for locksmiths who advertise their businesses on an online directory, and include persons listed in the directory as being members of ICL.

Parties' Contentions

5. The Complaint alleges, -
 - 5.1 ICL was set up by a group of locksmiths in 2005. The Institute has since carried on its activities from a web site at www.theinstituteofcertifiedlocksmiths.org. That domain name was registered on 29 January 2005 by Mr Alan Williams, the second Complainant, on behalf of the Complainant.
 - 5.2 The Domain Name is, at the third level, identical to the verbal element of the Complainant's trade mark, which was registered on 24 July 2009.
 - 5.3 Therefore, ICL was in existence and carrying on its activities for many years before registration of the Domain Name.
 - 5.4 The Complainant owns significant goodwill in the mark 'THE INSTITUTE OF CERTIFIED LOCKSMITHS' in relation to locksmiths' services certified by ICL and in training services provided by ICL as a result of the continued use of the web site at www.theinstituteofcertifiedlocksmiths.org and continued use of the trade mark. As a result, the Complainant has rights in passing off in the words 'THE INSTITUTE OF CERTIFIED LOCKSMITHS'.
 - 5.5 The Domain Name is an Abusive Registration because the registration took unfair advantage of, and has been unfairly detrimental to, the

Complainant's Rights and has been used in a manner which has taken unfair advantage of, and been detrimental to, those Rights because -

- 5.5.1 The Respondent has registered no trade mark rights that include the term 'THE INSTITUTE OF CERTIFIED LOCKSMITHS'.
- 5.5.2 The Domain Name is a deliberate imitation of the .org domain name under which the activities of ICL are and have been carried on since 2005.
- 5.5.3 The Respondent is not a paying member of ICL and has no obvious justification for registering the Domain Name. The person behind the Respondent has been revealed to be a Mr Richard Breslin (Mr Breslin). The Domain Name was registered with the primary purpose of disrupting the business of the Complainant who authorised ICL, of which he is the founding member, to use his registered trade mark for its business, the certification of locksmith services.
- 5.5.4 Before the Complainant's legal representatives contacted the Respondent in December 2014, requesting that the Respondent cease and desist from causing another domain name including the words 'the instituteofcertifiedlocksmiths' to divert to the Respondent's own web site, persons visiting the Domain Name were diverted to the Respondent's web site, needalocksmith.com.
- 5.5.5 The redirection of traffic from the Domain Name to the Respondent's own web site created a link between the two web sites which will have led or may lead the public to wrongly believe that the Respondent's business is affiliated to ICL, to the detriment of the Complainant's Rights and in particular the good reputation of ICL and the trade mark associated with it.

5.5.6 There is a severe risk that an Internet user guessing the URL for ICL would use the Domain Name to find it online. Visitors to any web site operated by the Respondent from the Domain Name will be visiting it in the expectation that such web site is operated or authorised by or otherwise connected with the Complainant(s). Therefore, the Respondent has used the Domain Name in a way which “is likely to confuse people or businesses into believing that the Domain Name is registered to or operated or authorised by, or otherwise connected with the Complainant within paragraph 3a.ii. of the DRS Policy.

The Response

6. The Response is in the form of a letter written by Mr Breslin. It alleges, -
 - 6.1 Needalocksmith.com (NAL) is a free trade web site for locksmiths who wish to advertise their business on a locksmith directory.
 - 6.2 ICL contacted NAL a few years ago and requested NAL to list its logo and to list their members free of charge on the NAL directory. NAL agreed. The site has grown and many ICL-accredited locksmiths are very happy to be listed on NAL’s directory free of charge. NAL derives no financial gain from listing ICL- accredited locksmiths.
 - 6.3 The NAL directory shows a list of ICL members ‘paid or not’ and this is a way for locksmiths to try and get further work and be seen on a web site of good quality. This also promotes consumer confidence.
 - 6.4 ‘The redirection of the domain ref: theinstituteofcertifiedlocksmiths.co.uk was set up purely for those internet search terms that include a domain extension and this was forwarded to the ICL members on the NAL web site. It was not and never has been used to demote, attack, pass off or cause any harm or

interference with the ICL or its members. It is only seen by members as a benefit and another way to secure work free of charge.’

- 6.5 Securing the Domain Name to redirect Internet users to another web site listing ICL locksmiths can only be a benefit.
- 6.6 Once NAL has established that members of the public can find members on the NAL web site, it may in the future list the domains ‘for sale to the ICL of whom will get [sic] first refusal. If this is not taken up we will either carry on redirecting the domain to ICL members on NAL or park the domain until such time the ICL wish to purchase or lease the domains.’
- 6.7 NAL is prepared ‘to cease any direction to NAL-listed members if ICL sees fit that its members do not wish or see any benefit to redirection’. NAL’s only intention is to promote ICL locksmiths.

The Reply

7. The Reply alleges, -

- 7.1 The fact that the Respondent intends to offer the Domain Name for sale to ICL is clear evidence that the purpose of registering it was ‘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 .. the Domain Name’, under paragraph 3a.i.A of the DRS Policy.
- 7.2 The suggestion that registration of the Domain Name can only be a benefit to ICL’s members is a nonsense. Visitors to the Domain Name were redirected to the Respondent’s own web site and the Respondent is not in a position to know who is and is not an ICL member.

- 7.3 Had the Respondent's intention been purely to secure the Domain Name for the benefit of paying members of ICL, it would have agreed to transfer the Domain Name to the Complainant when the Respondent was contacted by the former's legal representatives in December 2014. The fact that the Respondent did not do so is ample evidence that the primary purpose of registering the Domain Name was to disrupt the business of the Complainant and/or derive valuable consideration from selling or leasing it to him.
- 7.4 The Respondent's claim that the Domain Name was not purchased with any improper motive is implausible. Having received emails from the Complainant's legal representatives on 19 November 2014 and 26 November 2014 regarding unauthorised use of the ICL trade mark, the Respondent proceeded to register the Domain Name.
- 7.5 Most of the Response is not relevant to the issues in this dispute, because it addresses the alleged purposes of NAL. However, for the sake of completeness, the following points should be made, -
- 7.5.1 The Respondent's web site has regularly advertised the provision of listing services for a monthly charge; for example on 25 November 2014 it advertised 'Locksmiths Listed from 19.99 per month.'
- 7.5.2 Members of ICL who fail to pay their membership charges cease to be members. The Respondent is not in a position to verify whether anyone advertising on its web site are or are not current members of ICL. The Respondent's web site has repeatedly listed, describing them as members of ICL, individuals and businesses who have long since ceased to be members of ICL.

Discussion and Findings

8. A Complainant is required under subparagraphs 2a. and 2b. of the DRS Policy to prove on the balance of probabilities that: -

8.1 he has Rights in respect of a name or mark which is identical or similar to the Domain Name; and

8.2 the Domain Name, in the hands of the Respondent, is an Abusive Registration.

I have limited the findings in this Decision to those necessary to dispose of the dispute in accordance with the DRS Policy and accordingly it is not necessary to resolve all the issues raised by the parties.

9. I refer to the matters set out in paragraphs 3 and 4 above and adopt them as findings of fact.

Rights

10. By paragraph 1 of the DRS Policy, -

'Rights means 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 UK trade mark no: 000025111132 owned by the Complainant consists of a circular device, a dial from a safe lock, which includes the words 'THE INSTITUTE OF CERTIFIED LOCKSMITHS' in its circumference and 'ICL' in its centre. The trade mark was registered and subsists in the following classes, namely class 6 (locks, locking systems etc.), class 37 (locksmithing repair services etc.), class 41 (training etc.) and class 45 (security and anti-theft services etc.).

11. As a result of his ownership of that trade mark, the Complainant has established that he has Rights in the name or mark 'THE INSTITUTE OF CERTIFIED LOCKSMITHS'. It is not necessary to consider whether he also owns unregistered rights.
12. In those circumstances, I conclude that the Complainant has Rights in a name or mark, namely 'THE INSTITUTE OF CERTIFIED LOCKSMITHS', which is identical or similar to the Domain Name.

Abusive Registration

13. By paragraph 1 of the DRS Policy, -

'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 has taken unfair advantage of or has been unfairly detrimental to the Complainant's Rights.'*

By paragraph 3 of the Policy, -

'3. Evidence of Abusive Registration

- a. A non-exhaustive list of factors which may be evidence that the Domain Name is an Abusive Registration is as follows:*
 - i. Circumstances indicating that the Respondent has registered or otherwise acquired the Domain Name primarily:*
 - A. for the purposes of selling, renting or otherwise transferring the Domain Name to the Complainant or to a competitor of 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;*

- B. as a blocking registration against a name or mark in which the Complainant has Rights; or*
- C. for the purpose of unfairly disrupting the business of the Complainant;*
- ii. 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;*
-”*

By paragraph 4 of the Policy, -

‘4. How the Respondent may demonstrate in its response that the Domain Name is not an Abusive Registration

a. A non-exhaustive list of factors which may be evidence that the Domain Name is not an Abusive Registration is 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;*
- B. been commonly known by the name or legitimately connected with a mark which is identical or similar to the Domain Name;*
- C. made legitimate non-commercial or fair use of the Domain Name;*
- or*

ii. The Domain Name is generic or descriptive and the Respondent is making fair use of it;

.....

b.

c.....

d. Trading in domain names for profit, and holding a large portfolio of domain names, are of themselves lawful activities. The Expert will review each case on its merits.

..... ”

14. The Appeal Panel in DRS 04331 *verbatim.co.uk* determined that, for a complaint to succeed, -

“the Complainant must satisfy the Panel, as an opener, that the Respondent was aware of the existence of the Complainant or its brand at the date of registration of the Domain Name or at commencement of an objectionable use of the Domain Name.”

I adopt that approach, which is appropriate to this type of case.

15. When the Respondent registered the Domain Name, it was plainly aware of the Institute. The explanation given in the Response for the Respondent’s use of the Domain Name demonstrates this. The Domain Name was registered for use in connection with an online directory of locksmiths. Despite the agreement for the display of the ICL logo or device on the NAL directory web site, there was no express or other authorisation given to the Respondent to use the words ‘The Institute of Certified Locksmiths’ in the registration of a domain name.
16. A substantial number of individuals or businesses looking for the Institute on the Internet are likely to use the words ‘the institute of certified locksmiths’ in a Google or other online search and will be likely to experience ‘initial interest’ confusion when they come across the Domain Name. That is the starting point for considering the issue of confusion in this case. The Domain Name is identical to the name of the Institute and the search results are very likely to identify the Domain Name. Other Internet users searching for ICL on the Internet are likely to try and guess its URL by typing the Domain Name into a search bar and then experience initial interest confusion when they

perform that search, believing that the search result displaying the Domain Name relates to ICL, when that is not the case.

17. The Domain Name has been used to link to the Respondent's web site, an online directory for locksmiths. The print-out of the web site exhibited to the Reply states, 'Needalocksmith.com are the only locksmith directory to list only ICL Certified Locksmiths and MLA Approved Companies'. The web site lists the names of locksmiths held out as being members of ICL, as the Response put it, 'paid or not'. However, the likelihood is that these include persons who are no longer members of ICL, because a member who has not paid the Institute's membership fee ceases to be a member of ICL. The web site also provides 'Advice and Help On' various matters concerned with locksmithing services and training for locksmiths is also offered. However, there is no disclaimer on the site making it clear that this is not an authorised web site of the Institute. To the contrary, the Respondent's site included the words, 'I-CAL – The Institute of Certified Auto Locksmiths in association with the Institute of Certified Locksmiths' featured prominently. This is likely to reinforce the confusion experienced by the visitor to the site who has attempted to guess the URL of the Institute.
18. In view of the identity between the name of the Institute and the Domain Name and the content of the web site registered at its URL, it is inevitable that visitors to the web site hosted at the Domain Name who have carried out a Google or like search or attempted to guess the URL of the Institute will have concluded that that web site is in some way connected to, and has been sanctioned by, the person or entity behind the Domain Name. The re-direction of persons searching for ICL online to a web site hosted by the Respondent for the benefit of (those believed by the Respondent to be) members of ICL will have reinforced the initial interest confusion suffered by those searching for ICL on the Internet and caused further confusion. Those persons will have been led to believe that ICL had given its approval to a site containing a list of ICL-certified locksmiths (when unknown to them some of those are no longer members of the Institute) and 'MLA Approved Companies', and which dispenses advice on locksmithing services and offers training courses.

19. The Respondent has made it clear that if it decides to offer the Domain Name for sale and it is not purchased by or for ICL, the Respondent may continue to use the Domain Name to re-direct Internet traffic to or for the benefit of individuals it says are members of ICL in the NAL online directory.
20. In those circumstances, I conclude that the Complainant has established that there are circumstances indicating that the Respondent is using and threatening to use the Domain Name in a way which has both confused, and 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 for the purposes of paragraph 3a.ii. of the DRS Policy.
21. The Respondent has shown none of the exculpatory grounds in paragraph 4 of the DRS Policy to exist. The use of the Domain Name and any prior preparations for its use did not take place before the Respondent became aware of the Complainant's cause for complaint. That is because the Respondent was already aware of the Institute when it registered the Domain Name and it chose to use the name of ICL to create a false representation of an authorised connection between ICL and the Respondent's online directory of locksmiths. In any event, 'there is no genuine offering of goods or services' within paragraph 4i.a. of the DRS Policy, the activities of the Respondent being designed to take unfair advantage of the Complainant's Rights for the reasons set out below.
22. The Respondent has in effect impersonated ICL on the Internet, and has made a continuing false representation to persons or businesses searching for The Institute of Certified Locksmiths on the Internet and deliberately misled them into believing that there is a real commercial connection between the Domain Name and the Complainant as the person behind the Domain Name. It has created the impression of a trade connection where none exists.
23. The impression is not only incorrect but was made without the consent of either the Complainant or ICL. It also compromises the essential purposes of ICL as a body that certifies honest and competent locksmiths. The listing of

individuals in circumstances where they have ceased to be members of ICL and where ICL has no control over the listing is detrimental to those purposes and there was no proper justification for that state of affairs. The listing is also indicative of a more general risk to the reputation of ICL posed by the re-direction of Internet traffic to a web site or web sites over which the Complainant has no control, but over which the Respondent does exercise control.

24. It is difficult to see any legitimate buyer of the Domain Name other than the Complainant or another person on behalf of ICL. The Respondent's indication that it may offer the Domain Name for sale to the Complainant and either continue the use complained of or 'park the domain' until it is purchased (or leased) for the Institute shows a willingness on the part of the Respondent to leverage its improper use of the Domain Name to gain an unfair commercial benefit at the expense of the Complainant.
25. For all these reasons, I conclude that the Domain Name has been used in a manner which has both taken unfair advantage of and has been unfairly detrimental to the Complainant's Rights. Therefore, the Domain Name is an Abusive Registration.
26. The Complainants have not stated which of them is to be the transferee of the Domain Name. Mr Alan Williams was added as a Complainant only because he registered the .org domain name, having been retained by the Lead Complainant to carry out of that registration on his behalf. In those circumstances, the Lead Complainant is the appropriate transferee of the Domain Name.

Decision

27. The Complainant has Rights in a name or mark, which is identical or similar to the Domain Name, and the Domain Name in the hands of the Respondent is an Abusive Registration. Therefore, in view of the matters referred to in

paragraph 26 of this Decision, I determine that the Domain Name 'theinstituteofcertifiedlocksmiths.co.uk' be transferred to the Lead Complainant, Mr Dominic Walker.

Signed STEPHEN BATE

Dated: 01.06.15