

# **DISPUTE RESOLUTION SERVICE**

**D00016794**

## **Decision of Independent Expert**

Global Switchgear Services Ltd

and

R & B Switchgear Services Ltd

### **1. The Parties:**

Lead Complainant: Global Switchgear Services Ltd  
Unit 4D, Buckley Road Industrial Estate  
Rochdale  
Lancashire  
OL12 9EF  
United Kingdom

Respondent: R & B Switchgear Services Ltd  
Zen Internet Ltd  
Generation Centre  
Dane Street  
Rochdale  
Lancs  
OL12 6XB  
United Kingdom

### **2. The Domain Name(s):**

globalswitchgear.co.uk

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

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, which 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.

23 November 2015 13:27 Dispute received  
23 November 2015 13:35 Complaint validated  
23 November 2015 13:56 Notification of complaint sent to parties  
10 December 2015 01:30 Response reminder sent  
14 December 2015 12:26 Response received  
14 December 2015 12:27 Notification of response sent to parties  
17 December 2015 01:30 Reply reminder sent  
18 December 2015 15:15 Reply received  
18 December 2015 15:18 Notification of reply sent to parties  
18 December 2015 15:18 Mediator appointed  
23 December 2015 09:27 Mediation started  
06 January 2016 14:58 Mediation failed  
06 January 2016 14:58 Close of mediation documents sent  
18 January 2016 01:30 Complainant full fee reminder sent  
18 January 2016 16:05 Expert decision payment received

### **4. Factual Background**

- 4.1 The Complainant provides services for switchgear site work, comprising, for example, installation of new equipment, service and maintenance, fault finding and repair. According to its website at [www.global-switchgear.com](http://www.global-switchgear.com) it has done so in numerous countries around the world and deals with many different market sectors. It was set up and incorporated on 29 September 1997. It has web sites at [www.globalswitchgear.co.uk](http://www.globalswitchgear.co.uk) and [www.global-switchgear.com](http://www.global-switchgear.com) and owns other related domain names.
- 4.2 The Respondent also provides switchgear services and competes directly with the Complainant. It was set up and incorporated on 10 July 1991. The Expert has established that date from the online Companies House database.
- 4.3 The Respondent registered the Domain Name on 12 May 2000 and its current expiry date is 12 May 2016. This is based on a Nominet Who-is search carried out by the Expert on 20 January 2016.
- 4.4 From an internet search also carried out by the Expert on 20 January 2016 a notice in the nature of a holding page appears on behalf of Zen Internet Limited (whose premises appear to be the Respondent's address from the above Who-is details). It states that although the name is active, the owner has not yet published their website.

## 5. Parties' Contentions

### The Complaint

- 5.1 The Complainant asserts that it was registered with the Registrar of Companies in 1997 and that this can be confirmed by Companies House. It states that the Respondent is a direct competitor in respect that the type of work they carry out is the same. They state that a former director of the Respondent's company left it to set up the Complainant company. Further they assert that they have evidence of a customer enquiry sent in error by email to the Respondent due to the fact that the Domain Name closely resembles the Complainant's domain name namely 'global-switchgear'. Therefore they indicate that they believe that the Domain Name was registered to disrupt their business. They also assert that the Respondent has no associated companies in its group called Global Switchgear and that the Domain Name was registered with the sole purpose of stopping them from using it. They wish the Domain Name to be transferred.

### The Response

- 5.2 The Respondent asserts that it operates in the marine industry and so classes itself as a global operating industry. It states that it has offices in the USA with representatives in Italy and the Philippines, It claims to have registered the Domain Name because it offers switchgear services globally and that therefore it has a real need to own this Domain Name. Indeed it states that it "categorically" requires to own the Domain Name. It rejects the idea that the Complainant should own it as it is called Global Switchgear Services Limited, because the Domain Name does not represent its company name either. The Expert assumes this is because it claims the Complainant's entire name is Global Switchgear **Services Limited** (bold added for emphasis). The Respondent also states that the similarity between the Domain Name and the Complainant company is "unfortunate" but it is not the only company with the name global in it. It claims that the use and benefit of the Domain Name is a 'legitimate' benefit to it as it represents the industry and location of its scope of supplies. They request that the Complaint be rejected.

### Reply to Response

- 5.3 The Complainant repeats much of what is stated in the Complaint. It refers again to the evidence it says it has in relation to a customer enquiry being sent in error to the Respondent. It goes on to say that "their" response in forwarding it to them was delayed, in an attempt to disrupt their business. It asserts that the Respondent has no link or mention of the Domain Name on any of its websites and has no associated companies within the group with the name Global Switchgear.

## 6. Discussions and Findings

- 6.1 Paragraph 2 (a) of the Nominet Dispute Resolution Policy ("the Policy") states that for a Complainant's Complaint to succeed it 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 The Complainant is required to prove to the Expert that both elements are present on the balance of probabilities.

### **Complainant's Rights**

6.3 Under paragraph 1 of the Policy 'Rights' are 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."*

6.4 The Complainant says it was founded in 1997. It was registered as the company under that name on 29 September 1997. This is evident from an online search at Companies House. That means, assuming it started trading on or around the same time, it has been trading for around 18 years to date. There is no indication given in the Complaint that it owns any registered trademarks for its name or a similar term or terms. Nor is it stated or is there any evidence produced by the Complainant of when it actually started to trade using its name. Furthermore there is no evidence provided in relation to the level of use in terms of the Complainant's turnover, accounts and sales figures and number of clients and customers. In addition there is no evidence of its advertising and marketing expenditure under its name. The Complainant merely refers to its company registration founding date and its website at global-switchgear.com.

6.5 The Expert has reviewed the Complainant's website at global-switchgear.com. Its content suggests that the Complainant company is of a not insignificant size and that it has worked in numerous countries internationally.

6.6 In terms of paragraph 2.2 of the Nominet Expert's Overview *"if the right is an unregistered trademark, evidence needs to be put before the Expert to demonstrate the existence of the right. This will ordinarily include evidence to show that (a) the Complainant has used the name or mark in question for not an insignificant period and to a not insignificant degree (e.g. by way of sales figures, company accounts etc.) and (b) the name or mark in question is recognised by the purchasing trade/public as indicating the goods or services of the Complainant (e.g. by way of advertisements and advertising and promotional expenditure, correspondence/order/invoices from third parties and third party editorial material matters such as press cuttings and search engine results.)"*

6.7 The evidence which the Complainant has put forward here is very limited. Thus there is very little material to support a decision that the Complainant has unregistered rights which fulfil the definition of Rights as specified in the Policy. Indeed the Complainant in its Complaint does not even assert directly that it has any Rights.

- 6.8 The name Global Switchgear Services Limited, as the name of the Complainant, is a descriptive one" in the Expert's view and indicates the nature of the business and services that the Complainant provides. However neither does the Respondent challenge any Rights which may be owned by the Complainant. The Respondent merely notes the similarity between the Domain Name and the Complainant's company name and states that it is "unfortunate".
- 6.9 The Respondent hints that the term "global" should not be one which is capable of being monopolised by the Complainant and that it is not the only company with the word global in its name. While it is correct that the term "global" is descriptive the Respondent does not itself use it as part of its name or brand.
- 6.10 It seems likely that the Complainant has been trading using its name for a significant period, possibly for around 18 years or so to date. Its website also portrays a not insignificant size of company and business. However the Expert does not consider that the Complainant has established that 'Global Switchgear Services' has acquired a secondary meaning as being distinctive of the Complainant's services given its high level of descriptiveness and the lack of detailed evidence of use and goodwill provided. Nonetheless the Expert is satisfied on the balance of probabilities that the Complainant has Rights on which to found a Complaint. In this respect the Expert notes that the question of Rights is a test with a low threshold to overcome.
- 6.11 It is accepted practice under the Policy when comparing the Domain Name to the name in which Rights are asserted to discount the dot.co.uk suffix. The comparison to be made is with the Complainant's name Global Switchgear Services Limited. The only difference apart from the dot.co.uk suffix are the words "Services Limited". As these are a purely descriptive terms the Expert discounts these from the comparison. Accordingly the Expert finds that paragraph 2 (a) (i) of the Policy is satisfied in that the Complainant has Rights in respect of a name (Global Switchgear) which is identical or similar to the Domain Name.

### **Abusive Registration**

- 6.12 It therefore requires to be considered whether the Domain Name in the hands of the Respondent, is an Abusive Registration. Paragraph I of the Policy defines an Abusive Registration as the 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 It is sufficient to satisfy either of the limbs for there to be a finding of an Abusive Registration.

### **Abusive Registration Under Paragraph 1 (i) of the Policy**

- 6.14 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.

6.15 Under the Policy paragraph 3 (a) (i):

*"(i) circumstances indicating that the Respondent has registered or otherwise acquired the Domain Name primarily:*

*B as a blocking registration against the name or mark in which the Complainant has Rights; or*

*C for the purposes of unfairly disrupting the business of the Complainant. "*

6.16 The Complainant claims that the Domain Name was registered to disrupt its business and for the sole purpose of stopping it from using it and thus relies upon these above grounds. It refers to having evidence of a customer enquiry sent in error by email to the Respondent due to close resemblance of the Domain Name to its Domain Name global-switchgear. The Complainant suggests this is evidence of the registration of the Domain Name to disrupt its business. The Complainant has not produced the alleged customer email. It suggests in its Reply to the Response that the email was forwarded to it by the Respondent but it delayed in doing so and that the ' delay was an attempt to disrupt its business. The circumstances of this email and how it came to the Complainant's attention are unclear and as the email itself is not provided it is difficult to make much of this. The Expert has accordingly disregarded it in reaching her decision.

6.17 There is little doubt here that the Respondent had prior knowledge of the Complainant, its domain name and its business. The Respondent appears to have been trading before the Complainant set up its business in 1997 and registered the Domain Name in 2000 some three years after the Complainant was founded. The Complainant asserts that one of its Directors left the Respondent's business to set it up and this is not denied by the Respondent (nor does it assert that it registered the Domain Name when it was unaware of the Complainant or its business). Mere prior knowledge is not necessarily enough to establish an Abusive Registration. However here the Respondent registered the Domain Name with that knowledge and knowing it was identical or at least similar to the Complainant's name. Indeed it acknowledges the position in the Response and states "the similarity between the Domain Name and the company making the complaint is unfortunate."

6.18 The Respondent's name is R&B Switchgear Services Limited. Its name incorporates the distinctive initials R&B. These are also present in its domain names RBswitch.co.uk and RBswitch.com. It does not appear to have any subsidiaries or group companies which use the term global in their names. As above the Respondent appears to have been trading before the Complainant set up its business in 1997. It is not clear however how long it had in fact been trading prior to that. It seems odd that it did not register the Domain Name before 1997 when the Complainant was set up or at least before the year 2000 when it was in fact registered. This is particularly given that the Respondent itself states that it "categorically" requires to own the Domain Name because it offers switchgear services globally.

6.19 In addition the Respondent does not even now seem to be using the Domain

Name actively for a website or otherwise. It does not have a link to it on any of its other websites. This is also inconsistent with its apparent "categorical" need to own the Domain Name. On the other hand the Domain Name has been registered by the Respondent for some 16 years. No evidence is presented of its active use as a trading website. It seems odd that the Complainant has done nothing about the Domain Name being in the hands of the Respondent until now. The Expert can only surmise that it has only recently become aware of it as a result of the customer email incident to which it refers.

- 6.20 There is a non-exhaustive list of factors under the Policy which may be evidence that the Domain Name is not an Abusive Registration. One of these is at paragraph 4 (a) (ii) of the Policy which is:

*"the Domain Name is generic or descriptive and the Respondent is making fair use of it."*

This appears to be what the Respondent is relying on here as evidence of non-Abusive Registration. Here though, as above, it appears that the Respondent is not actively 'using' the Domain Name at all. It has merely registered it and is holding it. In any event if it did use it, it would be likely in the Expert's view not to amount to fair use and rather would take unfair advantage of the Complainant's Rights. However it seems to the Expert that the definition of an Abusive Registration under paragraph 1 (i) of the Policy which is more relevant here is as follows:

*"The Domain Name 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. "*

- 6.21 Here the Respondent had prior knowledge of the Complainant and its business. It is a direct competitor of the Complainant and the Domain Name is very similar, if not identical to the Complainant's company and trading name and in which the Expert considers the Complainant has Rights. The Respondent appears to have traded for a period prior to the Complainant setting up its business without the benefit of the use of the Domain Name. It has done so using a different name R & B Switchgear Services. It has not demonstrated any reason for its legitimate use or registration of the Domain Name. It only registered it 3 years after the Complainant set up in competition. These factors all point to the Respondent having registered the Domain Name deliberately to take advantage of the Complainant's Rights. Indeed in the Expert's view there is no other credible reason for the registration.
- 6.22 The Expert notes again the descriptive nature of the Domain Name and the limited evidence provided to establish goodwill and unregistered rights in it. These matters mean that the case for the 'Rights' being established is not a particularly strong one. However the evidence of an Abusive Registration is powerful and tilts the balance in favour of the Complainant.
- 6.22 Accordingly the Expert finds that the Complainant has Rights in the Global Switchgear name and brand, that the Domain Name is identical or similar to it and that the Respondent had prior knowledge of the Complainant. In addition the registration of and continuing to hold the Domain Name was primarily as a blocking

registration and for the purposes of unfairly disrupting the business of the Complainant and this was registered primarily to take unfair advantage of the Complainant's Rights. Overall on the balance of probabilities the Expert considers that there is sufficiently persuasive evidence to support a finding of Abusive Registration of the Domain Name by the Respondent.

## **7. Decision**

- 7.1 The Expert finds the Complainant has Rights in a name or mark which is identical or similar to the Domain Name.
- 7.2 For the reasons above the Expert finds that the Domain Name in the hands of the Respondent is an Abusive Registration.

The Expert directs that the Domain Name be transferred to the Complainant.

**Signed Gill Grassie**

**Dated 28 January 2016**