

DISPUTE RESOLUTION SERVICE

D00016994

Decision of Independent Expert

Oliver Partridge t/a Tring Web Design

and

Mr Gary Ison

1. The Parties:

Complainant:

Oliver Partridge t/a Tring Web Design
8 Station Road, Long Marston
Tring
Hertfordshire
HP23 4QS
United Kingdom

Respondent:

Mr Gary Ison
98 Vicarage Road
Leighton Buzzard
LU7 9EY
United Kingdom

2. The Domain Name(s):

tringwebdesignteam.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 of such a nature as to call into question my independence in the eyes of one or both of the parties.

24 January 2016 Dispute received
25 January 2016 Complaint validated
25 January 2016 Notification of complaint sent to parties
25 January 2016 Response received
25 January 2016 Notification of response sent to parties
27 January 2016 Reply received
27 January 2016 Notification of reply sent to parties
27 January 2016 Mediator appointed
01 February 2016 Mediation started
22 February 2016 Dispute resolved during mediation
17 March 2016 Dispute opened
17 March 2016 Mediation failed
17 March 2016 Close of mediation documents sent
31 March 2016 Complainant full fee reminder sent
31 March 2016 Expert decision payment received

4. Complainant's non-standard submission

The Complainant filed a supplemental submission (and accompanying documents) on 5 April 2016. Because this submission was not part of the standard process (complaint, response and reply), it is a non-standard submission under paragraph 13b of the DRS Policy. I am willing to take into account some parts of the non-standard submission, which are factual and relate to the Complainant's business. Because of the factual nature of the parts which I am willing to accept, I find that there is nothing to be gained by allowing the Respondent to respond to them. This is all the more the case since my decision in this case would have been the same even if I had not accepted these parts of the Complainant's non-standard submission.

5. Factual Background

The Nominet records show that the Domain Name was registered on 7 September 2015.

Based on the parties' submissions (see section 6 below) and a review of the materials annexed to the Complaint, the Reply and the Complainant's further submission, I set out below are the main facts which I have accepted as being true in reaching a decision in this case:

- a. The Complainant has carried on business, providing web services, under the "Tring Web Design" trading name since at least 2009.

- b. In carrying on its business, the Complainant has used the "Tring Web Design" trade name across all aspects of its activities, including on its website at www.tring-web-design.co.uk, on its business materials, in directories and general advertising and promotion.
- c. The Respondent carries on business under the trading name "Tring Web Design Team", also providing web services, including through a website under the Domain Name, and has done so since 2015.
- d. Both the Complainant and the Respondent are based in close proximity to the town of Tring.

6. Parties' Contentions

Complaint

The Complainant's submissions are set out below:

The Complainant has rights in respect of a name and mark which is identical or similar to the Domain Name:

- (1) The Complainant has traded under the Tring Web Design name for a not insignificant period and to a not insignificant degree.
- (2) The Tring Web Design name is recognised by the trade/public as indicating the goods or services of the Complainant (e.g. by way of advertisements and advertising and promotional expenditure, correspondence/orders/invoices from third parties and third party editorial matter such as press cuttings, Yell.com listings and search engine results).

The Domain Name, in the hands of the Respondent, is an abusive registration:

- (1) The Domain Name is very similar to the Complainant's trading name (as registered with HMRC).
- (2) The Domain Name has been primarily registered to unfairly disrupt the Complainant's business, or threatening to unfairly disrupt that business, by potentially confusing an Internet user seeing the domain name or the site to which it is connected as being registered to, operated or authorised by, or otherwise connected with the Complainant.

Response

A summary of the Respondent's submissions is set out below:

- (1) The Respondent purchased the Domain Name in good faith and intends no conflict or competition with the Complainant.

- (2) The Respondent's trading name is "Tring Web Design Team", serving customers in the Tring location via its team of web developers and designers.
- (3) The Respondent has no interest in competing for business with the Complainant.

Reply

The Complainant's submissions in reply are set out below:

- (1) It is highly unlikely that the Respondent chose the name "Tring Web Design Team" by chance in what is a relatively small and localised market, taking into consideration geographic proximity and the nature of both parties' businesses.
- (2) Adding the word "Team" is not enough to differentiate the Domain Name from the Complainant's trading name. The use of the Domain Name in connection with the provision of competing web design services is taking unfair advantage of the Complainant's rights.
- (3) The Respondent does intend to competing for business with the Complainant since it has set up as "web developers and designers" "serving customers in the Tring location" under the Domain Name, which is in direct conflict with what the Complainant's already established business has been doing for over 6 years.
- (4) The Complainant believes that the Respondent was aware of its business when the Domain Name was registered and is therefore using the name "Tring Web Design" suffixed with "Team" to create confusion among users searching for the Complainant's business name via a search engine or through a listing directory.
- (5) The Respondent is using the Domain Name in a way that is likely to confuse people or businesses into believing that the Domain Name is connected with the Complainant's business due to the nature of the services being offered and similarities in the name. The Domain Name implies that the Respondent is the "team" that work at "Tring Web Design".
- (6) The Complainant is an established business of nearly 7 years operating in the local website design and development sphere, and has a good reputation with the many businesses that it has dealt with in the provision of website services.
- (7) The Complainant started using tring-web-design.co.uk on a formal basis from 6 April 2009 and registered as a sole trader with HMRC using the trading name of "Tring Web Design".
- (8) The Complainant has full accounts for the last 6 tax years of trading as Tring Web Design.
- (9) The Complainant uses its trading name across all aspects of its business: on its website, on its business documents (business correspondence and invoices), on

its emails, in all of its advertising (online or print), in directories and on social networks, including Twitter and Facebook (as shown by documents annexed to the Reply).

- (10) The Complainant also owns the domain name tringwebdesign.co.uk which redirects to its website at www.tring-web-design.co.uk.

Further submissions by the Complainant

Those parts of the Claimant's further submissions (pursuant to paragraph 13b of the Policy), which I am willing to take into account in this case, are summarised below:

- (1) Confirmation of the Complainant having used the name Tring Web Design since 2009 comes from the HMRC document submitted as supplemental evidence by the Complainant.
- (2) Copies of the Complainant's accounts show that it has been in business since 2009.
- (3) The Wayback Machine screenshot of website history between 2008 and 2016, together with four screengrabs at key junctures in Tring Web Design history, proves that a website has been live under its Tring Web Design website, promoting its web design services in Tring, since 2008.

7. Discussions and Findings

General

Paragraph 2 of the Policy provides that, to be successful, the Complainant must prove on the balance of probabilities that:

- 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 (as defined in paragraph 1 of the Policy).

Complainant's Rights

The Complainant has carried on business under the trading name of "Tring Web Design" since at least 2009, and promoted itself under that name. Although it is a small business, this is sufficient to mean that the Complainant has Rights in the Tring Web Design name, in the form of goodwill in the name in the locality of Tring. Disregarding the generic .co.uk suffix, the Domain Name is similar to the name in which the Complainant has Rights.

I therefore find that the first limb of paragraph 2 of the Policy is satisfied.

Abusive Registration

Paragraph 1 of the Policy defines an "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."

Paragraph 3 of the Policy sets out a non-exhaustive list of factors which may be evidence that a Domain Name is an Abusive Registration. The factor under paragraph 3a on which the Complainant relies in this case is as follows:

- "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"*

The Complainant and the Respondent provide identical, or at least very similar, services. Combined with this, the fact that their trading names (including, in the case of the Respondent, the Domain Name) are extremely similar- both starting with the identical words "Tring Web Design" and the Respondent's name adding no more than the word "Team" at the end- makes it inherently likely that confusion will arise as a consequence. I should add at this point that the absence of any evidence of actual confusion having arisen to date does not mean that confusion has not occurred or, even if it has not done so yet, that it is not likely to occur in the future.

The fact that both the Complainant and the Respondent are based in close proximity to the town of Tring reinforces the likelihood of confusion arising amongst their local target customers.

There is nothing on the home page of the Respondent's website to make it obvious that the Respondent's business has no connection with the Complainant. Given the extremely similar names, it is also difficult to countenance how this could effectively be otherwise.

However, the fact that confusion is likely to arise is not in itself necessarily enough to mean that the Complaint should succeed. It is still necessary to prove that the Domain Name is an Abusive Registration. For that, the crux is whether the Respondent's registration and use of the Domain Name is unfair.

When assessing the issue of fairness, I find, on the balance of probabilities, that the Respondent was aware of the Complainant's trading name and website address at the time when it registered the Domain Name. In reaching that finding, I take into account that the Respondent's business is based in very close proximity to that of the

Complainant; that the Complainant had been active in that locality for more than 5 years prior to the Respondent registering the Domain Name, including in directories; and that, in selecting the Domain Name, the Respondent will almost certainly have checked similar domain names and probably also carried out Google searches. My conclusion is reinforced by the Respondent not having stated in its Response that it was not aware of the Complainant's business and trading name.

Taking into account my finding that the Respondent was aware of the Complainant's business and trading name at the time it selected its own trading name and the Domain Name, the question then arises of what choices the Respondent had. The Respondent states that it intends no conflict with the Complainant. Although it does not say so as such, the Respondent's position is implicitly that it is a web design team based near Tring, so why should it not call itself "Tring Web Design Team" and register a corresponding Domain Name?

The answer to this rhetorical question is that there were alternative name options reasonably open to the Respondent. By way of example only, the Respondent's actual address is Pitstone, so it could have selected a name starting with Pitstone instead of Tring.

By proceeding with the trading name and Domain Name "Tring Web Design Team", when (according to my finding) it was aware of the Complainant's trading name, and when other name options were available to it, my conclusion is that the Respondent acted unfairly and not in full good faith. Since confusion with the pre-existing business of the Complainant (in terms of the Respondent's business and Domain Name/website being mistaken by some people as being the Complainant's business or connected with it) is inherently likely, it follows that the registration of the Domain Name and its use has taken unfair advantage of, and is unfairly detrimental to, the Complainant's Rights.

It is unfairly detrimental to the Complainant's Rights because, when inevitable confusion arises amongst at least some actual or potential customers, the Respondent's website will divert and/or distract people who are looking for the Complainant. The flip side of this is that the Respondent's registration and use of the Domain Name also takes unfair advantage of the Complainant's Rights by attracting customers to the Respondent's website by use of the confusingly similar name and then seeking to sell competitive services to them.

In other words, it follows that the Domain Name is an Abusive Registration.

8. Decision

Having found that the Complainant has Rights in respect of a name which is similar to the Domain Name, and that the Domain Name in the hands of the Respondent is an Abusive Registration, the Expert directs that the Domain Name *tringwebdesignteam.co.uk* be transferred to the Complainant.

Signed
Jason Rawkins

Dated: 25 April 2016