

DISPUTE RESOLUTION SERVICE

DRS 17817

Decision of Independent Expert

Mervyn Worsey t/a Black Country Books

Complainant

and

Brewin Books Limited

Respondent

1 The Parties

Complainant:	Mervyn Worsey t/a Black Country Books
Address:	5 Lydiates Close Dudley West Midlands DY3 3ND United Kingdom

Respondent:	Brewin Books Limited
Address:	Doric House Studley Warks. B80 7LG United Kingdom

2 The Domain Name

blackcountrybooks.co.uk (the "Domain Name").

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, which need be disclosed as being of such a nature as to call into question my independence in the eyes of one or both of the parties.

4 August 2016	Dispute received
4 August 2016	Complaint validated
4 August 2016	Notification of complaint sent to parties
5 August 2016	Response received
9 August 2016	Notification of response sent to parties
12 August 2016	Reply reminder sent
23 August 2016	Reply received
23 August 2016	Notification of reply sent to parties
23 August 2016	Mediator appointed
31 August 2016	Mediation started
28 September 2016	Mediation failed
28 September 2016	Close of mediation documents sent
4 October 2016	Expert decision payment received

4 Factual Background

- 4.1 The Domain Name was registered by the Respondent on 8 June 2012.
- 4.2 The Domain Name is currently being used by the Respondent in the URL for a website which describes itself as "Black Country Books – specialising in books on the Black Country". The Respondent sells books through that website about or relating to that part of the West Midlands known as the Black Country (on account of its historical associations with the coal and other heavy industry).
- 4.3 The Complainant, Mr Worsey, is the registered proprietor of a UK device mark comprising an illustration of reeds and the words: "BLACK COUNTRY BOOKS – a bostin' reed", which was registered on 22 February 2008, with a filing date of 17 September 2007 (the "First Registered Mark"). A copy is attached.
- 4.4 The Complainant is also the registered proprietor of a UK word mark BLACK COUNTRY BOOKS which was registered on 27 June 2014, with a filing date of 22 May 2013 (the "Second Registered Mark").

5 Parties' Contentions

Complaint

- 5.1 The Complainant relies on the two registered trade marks referred at paragraphs 4.3 and 4.4 above. He asserts that he has had the rights to "*the trade name*" (undefined) since the filing date of the First Registered Mark, 17 September 2007, and describes the Second Registered Mark, filed on 2 May 2013, as a "*further strengthened claim*".
- 5.2 The Complainant says that he "*set up a book selling business in the 1990s specialising in books of local interest in and an area between Birmingham and Wolverhampton in the West Midlands, called Dudley*". He asserts common law rights in the Black Country Books name from 1997, saying that:

"I have always been known as Black Country Books, even by Brewin Books. My trade name and above address occurs on all their invoices to me.

The name has long identified me as a retailer of books in the area of the Black Country, even the BBS contacting me for information".

- 5.3 No evidence is provided in support of any of those assertions. He says that the phrase "*a bostin' reed*" is "*a smile at the local accent*". However, it is not explained what the word "*bostin*" means in the local dialect. According to online resources consulted by the Expert it means 'very good indeed'.
- 5.4 As to Abusive Registration, the Complainant says that, owing to illness, he overlooked "*the renewal of the domain names*". However, the Complaint does not explain what, if any, domain names he had previously registered, nor what use he may have made of them. In any event, he says that the Respondent, from whom he bought books, "*without consulting me, took both of these names as their property, and began trading under my name. (My trade name)*".
- 5.5 He says that when he discovered this he telephoned the Respondent and wrote to it, but received no response. Annexed to the Complaint is a single email to the email address *admin@brewinbooks.com* dated 14 May 2013.
- 5.6 The Complainant says that, as a result of his illness, he has closed his shop and that the Respondent has unfairly "*effectively blocked my online customers from contacting me, substituting themselves for my business*". No evidence is provided of the existence of any such online custom or customers.

Response

- 5.7 The Respondent explains that it was established in 1976 and specialises in publishing books on Birmingham and the Black Country. It explains that it is a publisher of books "*that actually incorporate the wording 'Black Country' within their titles*". Examples are provided and photocopies of the relevant book covers are annexed to the Response. They include evocative titles like *Memories of West Bromwich, Memories of Dudley, Black Country Memories* and *The Good Faggot Guide*.
- 5.8 The Respondent asserts that:
- "by definition these are books about the Black Country or, to be more concise, Black Country books, which is regularly how our customers refer to them. As far as we are concerned this is therefore a generic phrase, descriptive of the products that we produce and sell".*
- 5.9 The Respondent says that the director who registered the Domain Name in "*December 2012*" (it was in fact registered on 8 June 2012) "*was unaware that the Complainant existed*". It says that the Domain Name was registered "*as a descriptive term*", together with the domain name *Birminghambooks.co.uk*, registered on 8 June 2012.
- 5.10 Further, the Respondent says that at the time it registered the Domain Name, a search was carried out on the Wayback Machine and "*no trace of any previous website could be found at this address*".
- 5.11 The Respondent says that by the time it was contacted by the Complainant by email on 14 May 2013, "*several months had elapsed since registration and the site had subsequently been developed*".

- 5.12 It points out that the only registered trade mark at the time the Domain Name was registered, was the First Registered Mark. It asserts that there was no infringement of the *"non-generic part of the Complainant's trade mark name and logo 'A Bostin' Reed'"*.
- 5.13 The Respondent asserts that its business of producing and selling Black Country books *"pre-dates the Complainant's business by many years"*. No evidence is provided in this regard.
- 5.14 Further, the Respondent says that its website has always clearly stated, in the 'about us' section, that it is owned and operated by Brewin Books Limited. It says it only sells books published by it and its imprints.
- 5.15 As to the Complainant's assertion that he is, or was, a customer of the Respondent, the Respondent says that it has examined its accounts system and has *"found that the Complainant was an occasional customer placing his last order in 2010"*. It points out that the Domain Name was registered more than two years later. It contends that it is surprising that the Complainant placed no orders over that two year time period, *"considering that we have published several hundred books on Birmingham and the Black Country and that the complainant claims he is a specialist retailer in this field"*.
- 5.16 The only correspondence it has received from the Complainant in relation to the Domain Name is the email of 14 May 2013. It does not understand why the Complainant has initiated this DRS proceeding, in light of his admission that he has closed his shop due to ill health and *"appears never to have had a website at any time"*.

Reply

- 5.17 The Complainant points out that both his trade marks have been granted by the IPO and that the Respondent had an opportunity to oppose registration but did not do so.
- 5.18 He also says that he had a website using the Domain Name. No further details are provided, save to say that *"if Nominet would like to know who hosted the website, please ask"*.
- 5.19 The Complainant contends that the Respondent's use of the Domain Name is abusive because it *"has prevented my customers from contacting me, and vice versa. All enquiries to Black Country Books are directed to Brewin Books, effectively eliminating me"*. He says that the Respondent has cut off all access to his customers and are *"redirecting the internet to themselves"*.
- 5.20 He says that the directors of the Respondent *"knew full well who Black Country Books were, as I dealt with [sic] all through the years ... Brewin Books are a small family run business. To say that they did not know Black Country Books existed is ridiculous"*.
- 5.21 The Complainant does not dispute that the Respondent pre-dated his business *"by many years"*, but says that *"they had every opportunity to register Black Country Books as a trade mark long before I came on the scene, but chose not to do so"*.

Non-standard submission

- 5.22 On 18 October 2016 Nominet informed the Expert that the Complainant had submitted a non-standard submission pursuant to paragraph 13(b) of the Procedure in force for the purposes of this DRS proceeding, namely version 3. Paragraph 13(b) provides inter alia as follows:

"Any non-standard submission must contain as a separate, first paragraph, a brief explanation of why there is an exceptional need for the non-standard submission. We

will pass this explanation to the Expert, and the remainder will only be passed to the Expert at his or her sole discretion."

5.23 In this case, the Complainant's explanation read (in full) as follows:

"I would like to rectify the mis-information the Complainant has provided by Brewin Books in their reply. As an independent trader, I would like to submit my full submission."

5.24 Given that the intended meaning of that explanatory paragraph was unclear to the Expert, Nominet was requested to provide the further submission in its entirety.

5.25 The Expert has considered the non-standard submission, together with the explanatory paragraph. The further submission is in effect simply an addendum to the Reply, in that it reiterates points already made in the Reply or raises points which could have been made in the Reply. It is difficult to see any need for this further submission, let alone "*an exceptional need*", and the Complainant has not provided any assistance in this regard.

5.26 Accordingly, this non-standard submission will be disregarded.

6 Discussions and Findings

General

6.1 To succeed under the Policy, the Complainant must prove on the balance of probabilities, first, that he has Rights (as defined in the Policy) in respect of a name or mark that is identical or similar to the Domain Name (paragraph 2(a)(i) of the Policy), and secondly, that the Domain Name is an Abusive Registration in the hands of the Respondent (paragraph 2(a)(ii) of the Policy).

6.2 Abusive Registration is defined in paragraph 1 of the Policy in the following terms:

"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 took unfair advantage of or was unfairly detrimental to the Complainant's Rights."

Complainant's Rights

6.3 Paragraph 2(a)(i) of the Policy requires the Complainant to prove that he "*has Rights in respect of a name or mark which is identical or similar to the Domain Name*". "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*".

6.4 The Complainant has not identified a relevant name or mark. This decision therefore proceeds on the assumption that the Complainant's intention is to rely on his rights in the name or mark BLACK COUNTRY BOOKS.

- 6.5 Given that the Complainant owns a UK registered trade mark in BLACK COUNTRY BOOKS, he owns the requisite Rights (as defined in the Policy). That trade mark was registered on 27 June 2014 with a filing date of 22 May 2013, i.e. post-dating registration of the Domain Name.
- 6.6 The Complainant also owns a device mark registered on 22 February 2008, with a filing date of 17 September 2007, incorporating the words BLACK COUNTRY BOOKS (attached). Given the prominence in that device mark of those words, the Complainant also has Rights by virtue of that registered mark, which pre-date by almost five years registration of the Domain Name.
- 6.7 In addition, the Complainant seeks to assert common law rights in the mark on the basis that he has been trading by reference to the Black Country Books name since 1997. In the case of an unregistered trade mark right, as the Experts' Overview (which is available to Complainants on the DRS website) explains at paragraph 2.2:

"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 a not 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/orders/invoices from third parties and third party editorial matter such as press cuttings and search engine results)."

- 6.8 Not only has no such case been made by the Complainant, but, in any event, no such evidence has been provided. Further, the Complainant himself concedes that he "came on the scene" "many years" (it would appear approximately 20 years) after the Respondent. Accordingly, the Complainant has failed to discharge the burden of proving on the balance of probabilities that he has common law rights in the BLACK COUNTRY BOOKS name. His case must rest on the registered trade marks alone.
- 6.9 The next question is therefore whether the mark BLACK COUNTRY BOOKS is identical or similar to the Domain Name. Given that, as is well established under the DRS, the second and top level domains (i.e. the *co.uk* suffix) are ignored for these purposes, plainly it is.
- 6.10 Accordingly, pursuant to paragraph 2(a)(i) of the Policy, the Complainant has Rights (as defined) in respect of a name or mark, BLACK COUNTRY BOOKS, that is identical or similar to the Domain Name.

Abusive Registration

- 6.11 The Complainant does not identify on which of the factors set out in paragraph 3 of the Policy he relies. However, in effect, the Complainant appears to be relying on paragraph 3(a)(i)(C) (registration primarily for the purpose of unfairly disrupting the business of the Complainant) and/or paragraph 3(a)(ii) (use or threatened use of 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).
- 6.12 Turning first to the latter, no evidence has been provided of actual confusion. The Complainant's case therefore rests on likelihood of confusion. In this case, as explained above, the Domain Name is identical to the mark in question, with the exception of the generic domain suffix. Accordingly, for the reasons explained in paragraph 3.3 of the Experts' Overview, the chances of confusion are, ostensibly at least, high, on the basis of initial interest confusion, i.e. a prospective customer of the Complainant who entered the mark into the web browser would be taken to the Respondent's website.

- 6.13 However, in this case the Complainant does not seek to argue that he is currently running a business. Certainly, he provides no evidence of having traded at any time since registration of the Domain Name in June 2012.
- 6.14 Indeed there is a dearth of evidence as to the Complainant's trading history generally. No evidence has been provided as to the existence of the business since 1997, save for the trade marks themselves, which are registered to Mr Worsey personally.
- 6.15 It is common ground that the Complainant no longer has a shop, although no date is put on the closure. The Respondent asserts that the Complainant has never had a website "*at any time*". The Complainant says that he "*had my own website*" but offers no explanation as to when or why this ceased to be the case or indeed any evidence of its existence. A cursory online search carried out by the Expert has not disclosed any website operated by the Complainant. Moreover, the earliest website using the Domain Name disclosed by a search of the Wayback Machine is that of the Respondent, dated 3 December 2012, which would fit with its registration of the Domain Name in June 2012.
- 6.16 By contrast, the Respondent has pleaded and evidenced use of the Domain Name in connection with its book selling business.
- 6.17 In a nutshell, there is no evidence, and barely any pleaded case, that the Complainant actually has an operational business, or indeed has done at any time since the Domain Name was registered.
- 6.18 For practical purposes, the question of confusion can only arise in circumstances where the Complainant has a business which is up and running and trading by reference to the name or mark in question. It is very far from clear that this is the case. The Complainant has been unable to provide any evidence that he is running a business, or indeed that he ever did. He has made assertions as to the existence of a business in the past, but has provided no evidence of it at all. As to the present, he has not even made a case that he is still running a business. He has closed his shop and his use of the past tense in relation to his website strongly suggests that, even on his own case, if in the past he operated a website, he does not do so any more. In the absence of any business, it is difficult to see how any confusion could arise, except in a purely theoretical sense.
- 6.19 The question of initial interest confusion of the type envisaged by the Court in the *One in a Million* case, and in numerous DRS decisions since then, would appear to be otiose in circumstances where there is no operational business with which consumers will be confused.
- 6.20 By the same token, if in reality the Complainant has no business, it cannot be said that the Respondent is in any real sense disrupting it, let alone that its primary motivation in registering the Domain Name was to do so.
- 6.21 It is for the Complainant to prove on the balance of probabilities, that the Domain Name is an Abusive Registration in the hands of the Respondent, as defined by the DRS, by reference to the factors set out in paragraph 3 of the Policy (or any other factors on which he may wish to rely). The burden of proof is on him; it is not for the Respondent to displace any presumption of Abusive Registration.
- 6.22 Moreover, in this case the Respondent advances a positive case as to why the Domain Name is not an Abusive Registration. Again, like the Complainant, the Respondent has failed to identify the relevant provisions of the Policy on which it relies, but its case appears to be that it is not an Abusive Registration because:

- 6.22.1 before being aware of the Complainant's cause for complaint, it had used the Domain Name in connection with a genuine offering of goods or services (Policy, paragraph 4(a)(i)(A)); and/or
- 6.22.2 the Domain Name is generic or descriptive and the Respondent is making fair use of it (Policy, paragraph 4(a)(ii)).
- 6.23 As to 6.22.1, the Experts' Overview makes clear (paragraph 4.2) that if a Respondent is to succeed on this ground, the circumstances "*are only likely to constitute satisfactory answers to the Complaint if they commenced when the Respondent was unaware of the Complainant's name or mark*".
- 6.24 It is common ground that the Second Registered Mark, i.e. that which is identical to the Domain Name, was filed some time after registration of the Domain Name. Indeed, it was filed only after the Complainant had notified his cause for complaint to the Respondent in his email of 14 May 2013, the application having been filed on 22 May 2013.
- 6.25 The Respondent asserts that the director responsible for the Domain Name registration was at that time unaware of the existence of the Complainant's business. That assertion is rejected by the Complainant, primarily on the ground that he was a customer of the Respondent. The Respondent seeks to minimise the extent of that custom. It may be relevant in this regard that the Respondent is located about 25 miles from the Complainant. It might therefore reasonably be expected that it would be aware of a competitor, operating in the same geographical area and selling books on the same (fairly esoteric) subject.
- 6.26 However, as against that, the Complainant has been unable to provide any evidence, whether direct or circumstantial (e.g. invoices to it from the Respondent), to make good his assertion that the Respondent must have known of the existence of his business.
- 6.27 As to 6.22.2, the Experts' Overview expressly considers whether it is possible for a Respondent to make fair use of a domain name where (a) that name is also the Complainant's trade mark and (b) the Respondent's use of the Domain Name is causing confusion (paragraph 4.7). As the Overview explains, the answer is yes because:
- "While, ordinarily, a confusing use of such a domain name will be regarded as unfair, it may not be regarded as unfair where, for example, the Respondent's registration and use of the domain name predates the Complainant's rights, the Respondent has not changed his use of the domain name to take advantage of the Complainant's rights and the Respondent's behaviour has been unobjectionable."*
- 6.28 In this case, as explained, it is doubtful that the Respondent's use of the Domain Name is, in any meaningful sense, causing confusion. A fortiori, its use of the Domain Name may still be fair.
- 6.29 On the other hand, while the Respondent has not changed his use of the domain name to take advantage of the Complainant's rights and its behaviour has on the whole been unobjectionable (subject perhaps to its failure to answer the Complainant's email), it has not established that its "*registration and use of the domain name predates the Complainant's rights*". Apart from anything else, registration of the Domain Name substantially post-dated the Complainant's First Registered Mark.
- 6.30 The Overview also states that:

"Another use, which may not be regarded as unfair within the terms of the DRS Policy, is where the Complainant's name or mark is a dictionary word or a combination of dictionary words and not well-known and the Respondent reasonably registered and has been using the domain name in ignorance of the Complainant's rights. In such circumstances, if the confusion is likely to be very limited, an Expert might conclude that it would be unjust to deprive the Respondent of his domain name."

- 6.31 As to whether or not the Respondent was aware of the Complainant's Rights at the time that it registered the Domain Name, the Respondent's case is not entirely convincing. Even the Respondent concedes that the Complainant was, or at least had been, a customer. The parties are in the same geographical area. The Respondent does not dispute having received the Complainant's email of complaint, but none the less appears to have made a conscious decision to ignore it, which may (or may not) be indicative of a guilty conscience. Accordingly, it is not sufficiently clear that the Domain Name was registered in ignorance of the existence of the Complainant's rights.
- 6.32 The merits of the Respondent's case on why there is no Abusive Registration are therefore evenly balanced. But ultimately the Complainant's failure, for the reasons explained at paragraphs 6.11 to 6.20 above, to discharge his burden of proving, on the balance of probabilities, the existence of the circumstances set out at paragraph 3(a)(i)(C) or paragraph 3(a)(ii) of the Policy (see paragraph 6.11 above), or of any other relevant circumstances, means that, notwithstanding any remedy which he may wish to pursue elsewhere as a matter of trade mark law, he has failed, on the basis of his pleaded case and the evidence in support, to prove Abusive Registration under the DRS.
- 6.33 Accordingly, the Complainant has succeeded in proving, on the balance of probabilities, that he has Rights in respect of the BLACK COUNTRY BOOKS name or mark; and that the name or mark is similar or identical to the Domain Name; but has failed to prove that the Domain Name is an Abusive Registration in the hands of the Respondent.

7 Decision

- 7.1 The Expert finds that the Complainant has Rights in a name or mark which is identical or similar to the Domain Name, but that the Domain Name is not, in the hands of the Respondent, an Abusive Registration.
- 7.2 It is therefore determined that no action be taken in respect of the Domain Name.

Signed: **David Engel**

Dated: 31 October 2016



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