

DISPUTE RESOLUTION SERVICE

D00019268

Decision of Independent Expert

Glasgow Gin Company Limited

and

Glen Moore

1. The Parties:

Complainant: Glasgow Gin Company Limited
272 Bath Street
Glasgow
Strathclyde
G2 4JR
United Kingdom

Respondent: Mr Glen Moore
Kilwinnet Steading,
69 Strathblane Road
Campsie
Glen Glasgow
G66 7AX
United Kingdom

2. The Domain Name:

<glasgowgin.co.uk> (“the Domain Name”)

3. Procedural History:

23.08.17 Dispute received
23.08.17 Complaint validated
23.08.17 Notification of complaint sent to parties
06.09.17 Response received

06.09.17 Notification of response sent to parties
06.09.17 Reply received
06.09.17 Notification of reply sent to parties
12.09.17 Mediator appointed
12.09.17 Mediation started
03.10.17 Mediation failed
03.10.17 Close of mediation documents sent
05.10.17 Expert decision payment received

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 into question my independence in the eyes of one or both of the parties.

4. Factual Background

The Complainant is a Scottish company incorporated on 20 October 2016.

The proprietor and sole director of the Complainant is the registered proprietor of European Union Trade Mark Registration No. 016489221 registered on 13 July 2017 (application filed 20 March 2017) in classes 33 and 35 for gin-related goods and retail services. The mark in question, a device mark, is depicted below:



The Domain Name was registered on 27 September 2012 and is connected to a parking page featuring a variety of advertising links relating to gin or the city of Glasgow (see below).

glasgowgin.co.uk
This domain name has just been registered.
[Why is this page displayed?](#)

Search Ads

Related Links

- Glasgow City Centre Hotel >
- Bombay Gin >
- My Glasgow >
- Jobs Glasgow Scotland >
- Hotels in Glasgow >
- Late Rooms in Glasgow >
- Holidayinn Express Glasgow >
- Hilton Glasgow >

JETZT DOMAINS CHECKEN
Wunsch-Domain.de **prüfen** ▶

immo.berlin .biker .de .guru .spor .shop .music .web .mail .hotel 1&1

WEBSITES
1&1 MyWebsite
0,99 €/Monat*

✓ OHNE VORKENNTNISSE
✓ FÜR ALLE BRANCHEN
✓ DOMAIN INKLUSIVE 1&1

NEU!
NEXT LEVEL HOSTING!
✓ Einfache Skalierbarkeit mit wenigen Klicks
✓ Schnellere Ladezeiten mit HTTP/2
✓ PHP 7.1 + OPcache 1&1

5. Parties' Contentions

Complainant

The essence of the Complainant's objection to the Domain Name in the hands of the Respondent is set out in paragraph 4 of the Complaint, which reads as follows:

"The registered owner of glasgowgin.co.uk cannot use the domain name of glasgowgin.co.uk fairly in the future because the domain name description alludes to having an association with the registered trade mark 'Glasgow Gin' which will be detrimental to my business and will cause confusion to the internet user and the consumer. It would also be unfairly detrimental to my rights over the trade mark 'Glasgow Gin' that is registered to me."

Respondent

The Respondent states that he has been working in the spirits industry in and around Glasgow for over 30 years. He states that he registered the Domain Name to offer to his gin clients to assist them with the marketing of their products.

He contends that the Complainant's trade mark is not "Glasgow Gin", but a device mark in which "Glasgow Gin" features with a drawing and other text. Moreover, he contends that the words "Glasgow" and "Gin" are descriptive words in which the Complainant cannot claim exclusivity.

The Respondent contends that the Complainant must have been aware of the Domain Name before he adopted his company name and applied for his trade mark.

Complainant's Reply

The Complainant essentially reiterates its contention that use of the Domain Name by the Respondent will cause consumer confusion and infringe the Complainant's trade mark rights, but fails to respond to the Respondent's suggestion that the Complainant must have been aware of the Domain Name when it adopted its corporate name and the trade mark. The Complainant states:

"The use of domain name www.glasgowgin.co.uk infringes my earlier rights as then owner of European Union Trade Mark Registration no 016489221 "GLASGOW GIN 10 Botanicals it's pure gallus!" registered for class 33 and 35 products and services:, since not only the names are identical, but the owner is using a domain name which markets alcoholic beverages, which is the field of activity of my business. This identity will lead consumers to error, as they will not be able to distinguish my products and services from the products and services provided by www.glasgowgin.co.uk."

6. Discussions and Findings

General

Pursuant to paragraph 2.a.i of the Policy, for the Complainant to succeed in this Complaint it must prove to the Expert 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

"Abusive Registration" is defined in paragraph 1 of the Policy 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.

Rights

There can be no dispute that the Complainant (whether directly or indirectly through its owner and director) has trade mark rights in respect of the device depicted in section 4 above. The Complainant contends that the registration is for "Glasgow Gin", but that is plainly wrong. "Glasgow Gin" is a feature of the trade mark, but the trade mark features much in addition. No way can the trade mark and the Domain Name be said to be identical. Whether the two can be said to be similar is an interesting question, but not one that the Expert need resolve in light of the Expert's finding below under 'Abusive Registration'.

The Complainant's corporate name is certainly similar to the Domain Name, but the Expert has not been provided with any evidence to indicate that the Complainant has acquired any enforceable rights in respect of its corporate name. There is nothing before the Expert to indicate that the Complainant has even started trading. The Expert notes that the trade mark registration upon which the Complainant relies is not held by the Complainant, but by its director, but nothing turns on that for the purposes of this decision.

The issue as to whether registration of a corporate name can of itself give rise to relevant rights in the absence of any evidence as to trading activity is dealt with in paragraph 1.7 of the Experts' Overview, a valuable resource appearing under 'DRS Guidance' on the Nominet website. Paragraph 1.7 ends: *"The consensus view of recent Experts' meetings has been that mere registration of a company name at the Companies Registry does not of itself give rise to any rights for this purpose. An appeal panel in DRS 16594 (polo.co.uk) agreed with that approach."*

Abusive Registration

Paragraph 3 of the Policy features a non-exhaustive list of factors, which may be evidence that a domain name is an Abusive Registration.

The Complainant does not contend that 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"*; nor could it do so given that the Respondent registered the Domain Name four and a half years before the Complainant acquired any potentially relevant rights.

Thus the Complainant's complaint is restricted to the Respondent's use or planned use of the Domain Name. The relevant sub-paragraph of paragraph 3 is sub-paragraph 3.a.ii of the Policy, which reads:

“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 only use that the Respondent is making of the Domain Name is to connect it to a parking page featuring advertising links which, naturally, given the descriptive nature of the Domain Name comprise links concerning Glasgow and gin.

The Response is singularly uninformative when it comes to evidential support for the Respondent’s claimed intentions for the Domain Name (i.e. to offer it to his gin clients to support their marketing efforts), but equally there is nothing before the Expert to support any claim that the Respondent, who registered the Domain Name over four years before the Complainant’s trade mark registration, has targeted or has any intention of targeting the Complainant’s trade mark rights.

Whether or not the Respondent’s use of the Domain Name is likely to constitute infringement of the Complainant’s rights (something that the Respondent says that he is keen to avoid) will depend upon the breadth of protection that the court allows the Complainant’s trade mark and the manner of the Respondent’s future use of the Domain Name. These are not straightforward questions. The Complainant’s trade mark is complex and far from being a simple registration of the name “Glasgow Gin”. Moreover, the Complainant has come forward with no evidence to demonstrate how the trade mark is being used, if indeed it is being used. The Expert sees no reason to make any assumptions in the Complainant’s favour.

The Complainant has failed to satisfy the Expert that the Domain Name, in the hands of the Respondent, is an Abusive Registration.

7. Decision

The Complaint is denied.

Signed Tony Willoughby

Dated 11 October, 2017