

DISPUTE RESOLUTION SERVICE

DRS 8458

Decision of Independent Expert

1. The Parties:

Lead Complainant: Nimbus Designs Limited

Address: Woodlands
Old School Lane
Stamford
Beds
SG18 9JL
United Kingdom

Other Complainants: TV Cables Limited
Andy Smith

Respondent: Mark Slater

Address: 171 Balmoral Road
Wordsley
Stourbridge
West Midlands
DY8 5JY
United Kingdom

2. The Domain Name(s):

tv-cable.co.uk

3. Procedural History:

3.1 On 26 March 2010 the Complaint was filed with Nominet in accordance with the Nominet UK Dispute Resolution Service Policy (the Policy). Nominet validated the Complaint and sent a copy of the Complaint to the Respondent on 31 March 2010, advising the Respondent that the Complainants were using Nominet's Dispute Resolution Service to complain about the registration or use of the Domain Name, and allowing the Respondent 15 working days within which to respond to the Complaint.

3.2 A Response was received on 6 April 2010. The Complainants submitted a Reply, which was received by Nominet on 13 April 2010. The dispute then entered

Nominet's mediation stage. Nominet was unable to resolve the issue through mediation.

- 3.3 On 13 May 2010 the Complainants paid the relevant fee to Nominet in order for the matter to be referred to an independent Expert for a full Decision. On 18 May 2010 Bob Elliott was duly appointed as Expert.

4. Factual Background

4.1 The Lead Complainant, Nimbus Designs Limited, is a business which was established in 1980, and which trades as TV Cables. It has been using the domain name tvcables.co.uk since 13 January 2003 for the resale of cables associated with televisions. There is an associated company, TV Cables Limited (which is one of the co-Complainants). The third Complainant, Andy Smith, appears to be one of the proprietors of those companies. The Complainants also own the domain names tv-cables.co.uk, tv-cable.co.uk and tvcables.net.

4.2 The Domain Name was registered by the Respondent on 7 May 2009. It was apparently previously registered in the name of another registrant. It is currently used for a SEDO parking page, with sponsored links to websites of companies such as Sky TV and TV aerial companies.

4.3 On 26 March 2010 the Respondent e-mailed the Complainants identifying himself as the owner of the Domain Name, informing the Complainants that the Domain Name was being auctioned through the website www.sedo.co.uk, and asking the Complainants if they would be interested in making a bid. At the time, the current bid on the auction was apparently £450. The Complainants said that they were interested in negotiating a reasonable price for the Domain Name, but declined to take part in the auction. The Respondent declined to negotiate, referring the Complainants to the auction process. The Complainants lodged their Complaint with Nominet, which had the effect of freezing the Domain Name, and the Respondent asked SEDO to cancel the auction.

5. Parties Contentions

Complainants' Submissions

Rights

5.1 The Complainants rely upon their ownership of the registered company TV Cables Limited, the business of Nimbus Designs Limited trading as TV Cables, and the ownership of the various domain names referred to above. On the basis of those trading names, and domain names, the Complainants assert that they have Rights in the name TV Cables which is similar to the Domain Name.

Abusive Registration

5.2 The primary basis of the Complaint is that the Respondent had registered the name for the purposes of selling, renting or otherwise transferring the Domain Name to the Complainants or to a competitor of the Complainants, for valuable consideration in excess of the Respondent's documented out-of-pocket-costs directly associated with acquiring or using the Domain Name, referring to the DRS Policy, paragraph 3.a.i.A.

5.3 As evidence, the Complainants cite the e-mail of 26 March 2010 referred to above, in which the Respondent informed the Complainants that he was auctioning the

Domain Name, and asked whether the Complainants would be interested in making a bid. The Complainants suggest that by sending this e-mail the Respondent had specifically targeted their business with the intention of selling the Domain Name, because he knew that the Complainants already owned the domain name tvcables.co.uk (the e-mail is addressed to sales@tvcables.co.uk and refers to “TVcales.co.uk” (sic)). The Respondent’s attempt to have the Complainants purchase the Domain Name for a minimum of £460 is therefore evidence of an abusive registration, as it exceeds by more than £450 the Respondent’s cost of registering the Domain Name, as a Nominet member. Therefore, the Respondent must have purchased the Domain Name to sell on for profit.

- 5.4 The Complaint also contains as an annex some examples of e-mails which are said to cause “customers terrible confusion”. This is not referred to in the Complaint itself, but has subsequently been addressed both in the Response and in the Reply. The evidence of confusion consists of e-mails from 2004 when customers of the Complainants had apparently contacted the e-mail address sales@tvcable.co.uk, by mistake, and those had been redirected by the then proprietor of the Domain Name to the Complainants, and a more recent e-mail from July 2009, which has been forwarded to the Complainants by a customer, having originally been sent to sales@tvcable.co.uk, again by mistake.
- 5.5 The Complaint also attaches screen shots of the website at www.tvcable.co.uk which has as part of its browser title bar “TV Cables and Resources and Information. This website is for sale!” After notifying the Respondent of their intention to file a Complaint, that wording was changed to “Sky TV Resources and Information”.
- 5.6 The Complainants seek the transfer of the Domain Name to themselves (presumably, to the Lead Complainant).

Respondent’s Submissions

Rights

- 5.7 The Respondent “strongly contests” the fact that the Complainants have any rights to the name, on the basis that “TV cable” is a generic term relating to an every day household product, and the Complainants have no trade mark on the terms “TV cable” or “TV cables”.

Abusive Registration

- 5.8 The Respondent says that the Domain Name was registered in good faith and was only on the basis of its generic nature. He is the registrant of several other TV related generic domain names, including lcdtelevisions.co.uk, 3d-tv.co.uk, digitaltvaerial.co.uk and hdtvreceivers.co.uk. The Respondent says that his original plan had been to develop the Domain Name into a TV cable informational site. He says that he has created similar informational sites including virtualisation.co.uk and printservers.co.uk.
- 5.9 The Respondent points out that although the Complainants are in the business of selling TV cables, they are one of thousands of online retailers where a TV cable could be purchased, including many well known high street names. A search on Google for the term “TV cable” produces some 111,000 results.

- 5.10 The Respondent had no previous knowledge of the Complainants' business, prior to 26 March 2010. He has never been involved in the television retail industry, nor had any previous contact with the Complainants prior to that date.
- 5.11 The Respondent says that, having registered the Domain Name in May 2009, the Domain Name has subsequently been parked at SEDO awaiting development. As such, there was no e-mail functionality.
- 5.12 Although not directly referred to in the Complaint, the Respondent deals with the Complainants' assertion of "terrible confusion", by pointing out that most of the examples predate his registration of the Domain Name, but in any event, they essentially appear to show just a mistake in typing by the original sender.
- 5.13 In respect of the complaint of the Domain Name having been registered for the primary reason of selling it to the Complainants for a sum in excess of documented out-of-pocket costs, the Respondent refers to paragraph 4.d of the DRS Policy which says that "Trading in domain names for profit, and holding a large portfolio of domain names, are of themselves lawful activities". The Respondent omits the following sentence in paragraph 4.d which is "the Expert will review each case on its merits".
- 5.14 The Respondent emphasises that he registered the Domain Name solely based on its generic nature with a view to development, and that there was no knowledge or contact with the Complainants prior to 26 March 2010. Therefore, the registration could not be considered abusive. The Respondent says that the auction was triggered by him receiving an offer on SEDO, and that the only way an auction can be initiated on SEDO is if an offer has been received.
- 5.15 The Respondent answers the Complainants' statement that he then specifically targeted their business by saying that the Complainants were one of a number of potential bidders who were contacted to inform them that the Domain Name was on auction. The auction was also advertised on several domain name websites and would have been listed in SEDO's list of running auctions. He notes that it is normal practice in the auction of any generic domain name to try and raise the profile of the auction by contacting potential bidders from the relevant industry sector. He refers as an example to an announcement on www.dnforum.com (although the screen shot he produces shows that the Domain Name had been removed from auction, as a result of the Complainants' freezing of the Domain Name).
- 5.16 The Respondent also notes that, despite being asked to negotiate directly with the Complainants, rather than through the process of the auction, he continued with the auction process, because he did not feel that the Complainants had any rights to the Domain Name, and it was appropriate that the public auction should continue.
- 5.17 In terms of the Complainants' screen shots from www.tvcable.co.uk, the Respondent says that the earlier screen shot (before the Complaint) just shows that the Domain Name was for sale, and it was open to any member of the public to make an offer if they chose. The later screen shot no longer listed the Domain Name as for sale, as once the Domain Name had been locked and a Complaint filed, the Respondent contacted SEDO and asked them to cancel the auction and he logged into his SEDO account and removed the Domain Name from sale. The Complainants were informed by e-mail from the Respondent that he was taking those actions at that time.

- 5.18 In relation to the Complainants' suggestion that the wording of the browser title bar somehow targets "TV Cables", the Respondent points out that, throughout his ownership of the Domain Name, it has been parked at SEDO awaiting development. It has never contained any content that would be detrimental to the Complainants' business, or in any way tried to profit from any goodwill surrounding the Complainants' business. The phrases "TV cable" and "TV cables" are both generic and the Complainants have absolutely no right to exclusivity on these. Given the nature of the Domain Name, the Respondent says that it would be reasonable to expect the page title of any page to refer to "TV cable" or "TV cables", and not to (for instance) "the wires which plug into the box in the corner of your room".
- 5.19 The sponsored links on the web page do not refer to the Complainants' business, or to the sale of TV cables.

Complainants' Reply

- 5.20 The Complainants' Reply is itself quite short. However, it purports to be a summary of what is a 27 page attachment to the Reply, which contains some evidence by way of screen shots, but which is otherwise argument. To all intents and purposes, this would appear to be the Complainants' Reply, in an expanded form, and as such falls well outside the allowance of 2000 words in the DRS Procedure. It must be questionable whether such an approach is or should be permitted under the Procedure. However, the Expert has read both the Reply, and its extended annex, and whilst not proposing to set out in his Decision all of the content of those documents, the Expert is prepared on this occasion to have regard to those submissions. Some of the material is in any event repetitious.
- 5.21 The points which the Complainants specifically highlight in their Reply are as set out below (but, given the length of the annex, are inevitably in summarised form).
- 5.22 The Complainants assert that they are the only company which has built goodwill or reputation in the name "TV Cables", having spent considerable time and money building goodwill and reputation on the internet, and thereby acquiring common law trade mark rights. This submission appears to be potentially inadmissible under the Procedure, as outside matters which are newly raised in the Respondent's Response.
- 5.23 The Respondent was using the Complainants' goodwill and reputation to send potential customers to competitor sites to earn pay per click revenue, and therefore specifically targeting the phrase "TV cables". Again, this is potentially inadmissible, effectively trying to expand upon the Complainants' submission as to reputation and confusion. The Complainants provide evidence of magazine advertising, say that they have spent in excess of £20,000 for each of the past 6 years in advertising the website and trading name, and provide some third party recognition of TV Cables as a trading name.
- 5.24 The Complainants spend some time addressing the Respondent's comments upon the e-mails from confused customers. In essence, however, the Complainants' point is that the addresses sales@tvcable.co.uk and sales@tvcables.co.uk could be regarded as very similar to many members of the general public, and are therefore highly confusing. It is not just a question of mis-typing, customers are confused because the domain names are so similar, plural and non plural.
- 5.25 The Complainants take issue with the Respondent as to whether it is necessary to show that the intention to sell the Domain Name arose at the time of registration,

or could have happened at some later stage. The Complainants try to suggest that the timing element for Abusive Registration is to be assessed not only when the Domain Name was registered, but at any later stage, citing an explanation on the Nominet website at www.nominet.org.uk/dispute/drs/abuse, which says that “An Abusive Registration can be found can be found at a number of points in time”.

- 5.26 The Complainants dispute the legitimacy of the auction referred to by the Respondent. The suggestion is that the Respondent deliberately left the Domain Name parked for some months before sending the Complainants the offer to start bidding on it, having had that intention all along. As to the alleged existing bid on the Domain Name, the Complainants suggest that it could have been from the Respondent himself, or even an associate.
- 5.27 Even if the auction was available to the general public, the Complainants still say that the Respondent specifically targeted them, and they believe that was always his intention.
- 5.28 Both Google and Yahoo searches for “tvcable.co.uk” show “did you mean tv.cables.co.uk”, showing that even the largest search engines on the planet acknowledge the similarity and show the confusion. Many of the Google search results for “TV cables” refer to the Complainants or its affiliates.

6. Discussion and findings.

- 6.1 In order to succeed in these proceedings, paragraph 2.6 of the Policy requires the Complainants to prove on the balance of probabilities that both elements of the test set out in paragraph 2.a are present, namely that :
- i. the Complainants have Rights in respect of names or marks which are identical or similar to the Domain Name; and
 - ii. the Domain Name, in the hands of the Respondent, is an Abusive Registration.

Complainants’ Rights

- 6.2 Although the Respondent has asserted that the Domain Name is wholly generic, it appears to the Expert that the Complainants have done sufficient to show that they have common law rights in the name “TV Cables” which get them over this hurdle. It is by no means clear precisely which of the Complainants has Rights (and at least two of the domain names relied upon are registered in the name of Julie Smith, not one of the Complainants). However, it does seem that the Complainants are connected, and the evidence which they have produced (albeit some at the Reply stage) shows that there appears to be at least some recognition of “TV Cables” as a trading name, and the Expert finds that the Complainants do have Rights in the name “TV Cables” which is similar to the Domain Name.

Abusive Registration

- 6.3 The Complainants have to show that the Domain Name is an Abusive Registration. Paragraph 1 of the Policy defines “Abusive Registration” as a Domain Name which either:-
- i. Was registered or otherwise acquired in a manner which, at the time 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.
- 6.4 A non-exhaustive list of factors which may be evidence that the Domain Name is an Abusive Registration is set out in paragraph 3.a of the Policy. Those include: "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" (paragraph 3.a.i.A); and "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" (paragraph 3.a.ii).
- 6.5 The former of these is expressly relied upon by the Complainant. The latter seems, obliquely, to be part of the Complainants' case, but it is not easy to discern quite what case the Complainants seek to make out in that respect.
- 6.6 As noted above, some of the material upon which the Complainants rely has appeared for the first time in its Reply. The Reply is in itself probably not in accordance with paragraph 6 of the DRS Procedure. However, in this case, separating the admissible material from the potentially inadmissible material would not be an easy task, and the Expert feels that it would be unfair to the Complainants to disregard the annex to its Reply in its entirety, as it has been accepted by Nominet. For the reasons which appear below, the Expert does not feel that the Complainants are prejudiced by the form of the Reply, and therefore the Expert is not proposing formally to declare any of the Reply material as inadmissible.
- 6.7 Taking first the complaint in respect of paragraph 3.a.i.A, there is a dispute between the parties as to whether this question should be judged at the time of acquisition of the Domain Name, or whether it can be assessed at some other time. In the Expert's view, the position is clearly to be judged at the time of registration or acquisition of the Domain Name. The guidance on Nominet's website referred to by the Complainants addresses all types of Abusive Registration, and not the particular circumstances referred to in paragraph 3.a.i.A, the wording of which clearly refers to registration or acquisition.
- 6.8 The Complainants have not come up with any evidence, other than conjecture, as to what the Respondent's intentions were in registering the Domain Name. The Complainants effectively say that they are sufficiently well known that the Respondent must have had them in mind. In respect of the e-mail sent in connection with the auction, the Complainants say that this shows that the Respondent specifically targeted them at that time, and must have had that approach in mind when he first acquired the Domain Name. The Complainants also suggest that the auction was not in fact a genuine one (although clearly they have no evidence to support that assertion).
- 6.9 The Respondent says that he was unaware of the Complainants, until March 2010, when the auction started, having been triggered by what appears to be a relatively modest bid of £450. He says that he was attracted to the Domain Name, because of its generic nature, and because it fitted in with his other business activities. He says that he intended to develop a site for informational purposes, although at the same time, the Domain Name was available for

purchase, and that the auction was triggered by a bid from a third party. He also provides some evidence that the auction was publicised, and suggests that his contact with the Complainants was in order to try to generate interest in the auction from somebody who would clearly be interested given their ownership of the tvcables.co.uk domain name. However, there is clearly other evidence which could have been produced by the Respondent (such as the contacts he says he made with other potential bidders) which would have strengthened this evidence, but which has not been produced.

- 6.10 A process such as the Nominet DRS is not ideal for resolving such issues. However, the Expert reminds himself that the onus is on the Complainants to prove their case on the balance of probabilities. In this respect, the Expert finds that the Complainants have not done so in respect of this ground. Although they have provided some evidence of reputation, it is far from being the kind of evidence of reputation which would suggest that the Respondent could only have had the Complainants in mind when he registered the Domain Name. There are no surrounding circumstances to suggest that the Respondent did in fact have the Complainants in mind, except for the e-mail correspondence which ensued once the auction process had started. It is possible, of course, that the auction process might not have been entirely above board, but it seems unlikely, judged by the Respondent's reaction to the replies from the Complainants. He effectively invited them to take part in the auction process, and did not follow the Complainants' suggestion of individual negotiations with them. It would have been comparatively easy for him to have followed the latter course, if the auction process had in fact been a sham. Also, the price involved (£450 plus) does not appear excessive for an apparently attractive generic name (assuming that no one entity had cornered the market in that name, by acquiring sufficient distinctiveness). On balance, the Expert finds that the Respondent's version of events is more plausible than that put forward by the Complainants, and that this case is the "right side of the line" contemplated by paragraph 4.d of the Policy.
- 6.11 As regards paragraph 3.a.ii of the Policy, the material relied upon by the Complainants seems largely to be misdirected e-mails, and the suggestion (in the Reply and its annex) that the use of the Domain Name for the SEDO parking service is in some way taking advantage of the Complainants' Rights in an abusive way.
- 6.12 The Expert finds the misdirected e-mails to be unconvincing evidence of confusion. As the Respondent has pointed out, they seem essentially to be instances of customers mis-typing an e-mail address, because the domain names are clearly very similar. The majority of instances are in any event before the Respondent acquired the Domain Name, and the only instance which comes from a date after the acquisition of the Domain Name by the Respondent seems to be a question of a customer having realised her mistake, and sending the e-mail again (the Respondent's submission is that the original e-mail would have bounced back because there was no e-mail functionality through the SEDO parking site). None of this seems to the Expert to amount to the Respondent using the Domain Name in a way which has confused people into believing that the Domain Name is registered to, operated or authorised by, or otherwise connected with the Complainants.
- 6.13 As regards the use of the name "TV Cables" in the browser bar, and the sponsored links on the www.tvcable.co.uk website, the Expert feels that there is some force in the Respondent's submission that "TV Cables" is a natural heading to use. The sponsored links do not refer either to the Complainants, or to similar products to those sold by the Complainants. Someone looking for the products sold by the

Complainants (TV cables) would not therefore find what they were looking for. It is difficult to see how this could suggest a commercial connection to the Complainants. Therefore, the Expert also finds that this ground is not made out.

6.14 Therefore, the Complaint fails.

7. Decision

7.1 The Expert finds that the Complainants have rights in the name TV Cables which is similar to the Domain Name.

7.2 However, the Expert finds that the Complainants have not shown that the Domain Name, in the hands of the Respondent, is an Abusive Registration. The Complaint therefore fails and the Expert directs that there should be no action taken in relation to the Domain Name.

Signed: Bob Elliott

Dated 7 June 2010