

DISPUTE RESOLUTION SERVICE

D00009319

Decision of Independent Expert

Knockout Challenge Limited

and

Knockout Roadshow Ltd

The Parties

Lead Complainant: Knockout Challenge Limited
49 Hullbridge Road
South Woodham Ferrers
Essex
CM3 5NG
United Kingdom

Respondent: Knockout Roadshow Ltd
199 Leyland Road Penwortham
Preston
Lancashire
PR1 9SQ
United Kingdom

The Domain Name(s)

itsaknockoutchallenge.co.uk

knockoutchallenge.co.uk

Procedural History

1. On 22 November 2010 Nominet received the Complaint and served it on the Respondent ('KRL') on 24 November 2010. The Response was served on 2 December 2010 and the Reply was served on 9 December 2010. The mediation process concluded in failure on 12 January 2011. The undersigned Stephen Bate was appointed on 14 January 2011 and confirmed to Nominet that he knew of no facts or circumstances that might call into question his independence in the eyes of the parties.

Factual Background

2. The Complainant ('KCL') is a company owned and run by a Mr Phil Pike ('Mr Pike'). Mr Pike is the sole director of the company, which was incorporated on 23 August 2000 and for the past 10 years has carried on a business called 'Knockout Challenge' in the provision of 'It's a Knockout' games packages. Mr Pike had carried on that business since 1992 under the same name and registered the domain name knockout-challenge.co.uk on 17 April 1997.
3. KRL also offers 'It's a Knockout' games packages, but under the name 'Knockout Roadshow'. It is owned and run by a Mr David John Billington ('Mr Billington'), who has worked for the company for 25 years and registered the Domain Names at around the time when he bought the company. The Domain Name knockoutchallenge.co.uk was purchased by KRL on 1 April 2006. He says that the phrase 'knockout challenge' is frequently used in various sporting events and in connection with 'It's a Knockout' events that are not organised by KCL and that he registered the Domain Names because they were relevant to his business.

4. KCL has complained twice to KRL, in 2006 and 2010, that knockoutchallenge.co.uk has been configured so as to point to KRL's web site. On both occasions KRL has ceased this use following complaint made on behalf of KCL.

Parties' Contentions

5. The parties' Statements of Case are relatively short and it is worth setting them out in full.

The Complaint

'I am Phil Pike. I own a company called Knockout Challenge. From 1992 I traded as Phil Pike trading as Knockout Challenge and from 2000 as Knockout Challenge Limited. This name has been registered at Companies House (4058172) from 23rd August 2000.

My company offers the service of "It's A Knockout" which is a package of games for events, fundays, charity fundraising and team building. People are sorted into teams to take part in a fun games show.

At the time of instigation of trading I researched other companies offering similar It's A Knockout services. I thought up and chose the name Knockout Challenge, no one else used these two words together, they were unique.

I bought the domain name knockout-challenge.co.uk in the mid to late 90's.

Over eighteen years I have built the company and brand of Knockout Challenge in relation to supplying It's A Knockout games to being one of the top providers of It's A Knockout entertainment in the UK today.

Why is the domain name an Abusive Registration?

In 2006 a customer contacted me as he had been searching for Knockout Challenge on the internet and had been confused after clicking on knockoutchallenge.co.uk and being re-directed to another companies [sic] website who also offers It's A Knockout (Knockout Roadshow which is owned by Dave John Billington).

I approached the owner (via solicitor Adam Shirley @ Palmers Law in Basildon, Essex). On 19th Sept 2006 the owner said "we will stop pointing the domain to our site immediately" (email available to confirm this). On 6th October 2006 I offered to buy the domain from him (email available to confirm this). This offer was not responded to.

Knockout Roadshow has also maintained the renewal of registration to this date denying me the opportunity to register the domain to Knockout Challenge.

Although I was not happy at not being the owner of the domain and the refusal to sell, as long as the domain was not pointing to his Knockout Roadshow details it was a tolerable situation.

However, once more in 2010 a regular customer stumbled upon the domain being used again and contacted me. I also found that Knockout Roadshow owns itsaknockoutchallenge.co.uk. Once more I contacted him (via solicitor Matthew Poli @ Palmers Law, Basildon Essex). The owner replied by demanding £550.00 + vat for the domain names.

Upon the new correspondence Knockout Roadshow has stopped the pointing of these two sites at the Knockout Roadshow details.

I would preferably request "transfer" of the domains to take the opportunity of Knockout Roadshow once more breaking its agreement. Although the sites have since been un-pointed at their own site, I feel they will once more point them back again as soon as matters die down.

I conclude by stating that Dave John Billington's company is "Knockout Roadshow". My company is "Knockout Challenge". Because Knockout Challenge is a registered company this is an abusive registration.

Knockout Roadshow also owns itsaknockout.com which does relate to It's A Knockout. Many operators of It's A Knockout own domain names that use the Its A Knockout words or phrase, but the complaint I pursue is the use of Knockout Challenge by Knockout Roadshow.

The owning of knockoutchallenge and itsaknockoutchallenge is a direct attempt to fish for potential Knockout Challenge customers with these domains.

How would you like this complaint to be resolved?

Transfer'

The Response

'I am David John Billington owner of Knockout Roadshow. I run [an] It's a Knockout company with entertainment. I have worked for the company for 25 years and [I] bought the company around the time [I] purchased these domain names that relating [sic] to my business, [I] registered www.itsaknockoutchallenge.co.uk and www.knockoutchallenge.co.uk.

I did not know at the time there was another company called knockout challenge, but knockout challenge is a frequent name used for organisers that arrange these type of events. If you type into goggle [sic] this expression comes up in many cases, along with boxing, football, pool and snooker as well as many It's a Knockout events that are not organised by the company knockout challenge, it is an expression that is widely used, this is why [I] bought the domain name.

I was contacted by Mr Phil Pike solicitors and [I] offered to sell the domain to him as a matter of goodwill, [I] paid over £1650 for one domain [I] use and [I] thought the offer was fair.

He also states on his website that anybody using the expression knockoutchallenge will be sued, [I] cannot see how he can do this as it is a widely used phrase.'

The Reply

'I reply in response to Mr Billington's statement.

I contradict Mr Billington's statement that he did not know of my company when buying the domains. I have an email on file from 21-10-2005 stating the following...

Addressed to info@knockout-challenge.co.uk

"Dear Phil, It was lovely to meet you all at the show , you have a happy crew to be proud of . We came home the next day as we had a pool match (final) and we lost 4-3. but its over 2 legs. If we get any double bookings we will gladly put them on

to you . Spesk [sic] to you soon. Dave (Knockout Roadshow)".

Sent from dave@itsaknockout.com

The show mentioned being the Showman's Show in Newbury, October, 2005 which he visited whilst I was exhibiting there. I have forwarded [sic] this email to Madeline.Stamp@nominet.org.uk to be included in the file.

A Nominet search shows that knockoutchallenge.co.uk was registered [on] 1st April 2006. This was after he had corresponded to [sic] me and also seen the Knockout Challenge exhibition stand. This therefore shows Mr Billington's statement to be incorrect, [sic] he knew me, my company and my company name well before he bought the domains.

Mr Billington suggests that 'Knockout Challenge' is a widely used phrase, but this is not the case. Using examples [sic] based on snooker, pool, boxing etc are not helpful because 'knockout' in that context means something completely different to 'It's a Knockout' style entertainment. The words 'Knockout Challenge', used together in this particular context are solely used in relation to my company, and comprise the goodwill that I have worked for over 10 years to build up. It is a specific company name, rather than [sic] a phrase used generally.

The face value of a .co.uk domain name is under £10.00. It is therefore impossible for the figure mentioned of £1,650.00 or subsequent sale figure of £550.00 to be fair or justified in any way other than profiteering.'

Discussion and Findings

6. The Complainant is required under subparagraphs 2a. and 2b. of the Dispute Resolution Policy ("the Policy") to prove to the Expert on the balance of probabilities that: -

6.1 it has Rights in respect of a name or mark which is identical or similar to the Domain Names; and

6.2 the Domain Names, in the hands of the Respondent, are Abusive Registrations.

7. In making the findings set out below, the Expert has accepted the assertions of fact made by the parties in their Statements of Case, save where otherwise indicated below. The findings are limited to those necessary to dispose of the dispute under the Nominet's dispute resolution Procedure and under the Policy.

Rights

8. By paragraph 1 of the Policy, -

'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.'

9. Between 1992 and the incorporation of KRL on 23 August 2000, Mr Pike carried on business as 'Phil Pike trading as Knockout Challenge' and from 2000 that business was carried on exclusively by KCL, a company owned and run by Mr Pike.

10. KCL provides an 'It's A Knockout' games service, a package of games for events, 'fundays', charity fundraising and team building. People are sorted into teams to take part in a fun games show.

11. At the time when he commenced trading in 1992, Mr Pike researched other companies offering similar 'It's A Knockout' services. He thought up and chose the name Knockout Challenge, because his researches showed that no one else used these two words together at the time in the field of 'It's A Knockout' games.

12. He bought the domain name knockout-challenge.co.uk in the mid - to late 90's. Over a period of eighteen years he, and thereafter KCL built the business and brand of Knockout Challenge in connection with the supply of

'It's A Knockout' games to being one of the top providers of 'It's A Knockout' entertainment in the UK today. Mr Pike's case on these matters was not the subject of direct challenge in the Response and I accept it.

13. KRL does say that the words 'Knockout Challenge' are not distinctive of services provided by KCL, because of the descriptive uses of 'Knockout Challenge', a phrase widely used in the context of both particular sports and also 'It's a Knockout' games generally. The phrase also frequently refers, he says, to organisers of 'It's A Knockout' games. He says that he 'did not know at the time [of registration of the Domain Names] that there was another company called knockout challenge'.
14. The Expert rejects this part of KRL's case in view of the evidence in the Reply that Mr Billington had gone to a trade fair and visited the 'Knockout Challenge' exhibition stand in 2005 and had sent a follow-up email on 21 October 2005 to Mr Pike at the email address info@knockout-challenge.co.uk. The Domain Name knockoutchallenge.co.uk was registered on 1 April 2006. Thus, when Mr Billington registered this Domain Name on behalf of KRL he must have been aware that Mr Pike's business, i.e. KCL's, was called 'Knockout Challenge'. As he registered both Domain Names at or about the same time, it follows that he must have been aware when he registered itsaknockoutchallenge.co.uk that Mr Pike's business traded under the name of 'Knockout Challenge'
15. That being so, the Expert finds it to be likely that KRL registered the Domain Names, not because they were descriptive of the type of 'Its a Knockout' games provided by KRL or because 'Knockout Challenge' was a phrase widely in use to refer to such games or their organisers, but because it was a name used by a trade rival.
16. The Expert has also taken into account KRL's reaction to being asked to 'unpoint' knockoutchallenge.co.uk in 2006 and 2010. Following a letter from Palmers solicitors sent on behalf of KCL in about September 2006, Mr Billington replied by email dated 19 September 2006, in which he agreed

on behalf of KRL to ensure that this Domain Name ceased pointing to KRL's web site. Had the words 'Knockout Challenge' been descriptive or otherwise a widely used phrase in the context of It's A Knockout games, they would not have been distinctive of KCL's business. KRL would have been able to say, 'We are at liberty to use these domain names to capture internet traffic based on searches for It's a Knockout games'. That position was not taken. Instead, Mr Billington agreed to ensure that knockoutchallenge.co.uk no longer pointed at KRL's web site.

17. By late 2010, both the Domain Names were pointing at KRL's web site, notwithstanding the previous assurance in relation to knockoutchallenge.co.uk. On 4 November 2010 Palmers wrote a further letter to Mr Billington in his capacity as a director of KRL. The letter asserted that KRL owned the goodwill in the words 'Knockout Challenge' and asserted an exclusive right to use the name, based on passing off. The upshot was that KRL took steps to ensure that neither Domain Name pointed at its web site. That was the position at the date of the Complaint. Prior to receipt of the Complaint by Nominet on 22 November 2010 there was no challenge in any form to the assertion of exclusivity in the words 'Knockout Challenge' in answer to the letter of 4 November 2010.
18. The Expert accepts KCL's case in the Reply that the words 'Knockout Challenge', used together in the context of 'It's A Knockout' competitions, have been used solely in relation to KCL's business, and comprise the goodwill that KCL, by Mr Pike, worked for over 10 years to create. The words 'Knockout Challenge' are therefore distinctive of services supplied by KCL and members of the public with knowledge of this phrase would associate them with KCL's business of 'Knockout Challenge' and not with 'It's A Knockout' games generally or particular organisers or in relation to types of sporting activity.
19. For all these reasons, the Expert finds that KCL has sufficient goodwill and reputation in the words 'Knockout Challenge', which are distinctive of its business, to support an action in passing off. Thus, KCL has Rights in a

name, that is to say Knockout Challenge, which is similar to each of the Domain Names.

Abusive Registration

20. Paragraph 1 of the Policy states, -

'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 other 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 states -

'3. Evidence of Abusive Registration

a. A non-exhaustive list of factors which may be evidence that the Domain Name is an Abusive Registration is as follows:-

- i. Circumstances indicating that the Respondent has registered or otherwise acquired the Domain Name primarily:
A....
B. as a blocking registration against a name or mark in which the Complainant has Rights.; or
C. for the purpose of unfairly disrupting the business of the Complainant.*
- 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 to, the Complainant.'

iii.

iv. The Complainant can demonstrate that the Respondent is engaged in a pattern of registrations where the Respondent is the registrant of domain names ... which correspond to well-known names or trade marks in which the Respondent has no apparent rights and the Domain Name is part of that pattern.'

Paragraph 4 of the Policy states, -

'4. How the Respondent may demonstrate in its response that the Domain Name is not an Abusive Registration.

a. A non-exhaustive list of factors which may be evidence that the Domain Name is not an Abusive Registration is as follows:

i. Before being aware of the Complainant's cause for complaint (not necessarily the 'complaint' under the DRS), the Respondent has:

A. used or made demonstrable preparations to use the Domain Name or a domain name which is similar to the Domain Name in connection with a genuine offering of goods or services;

B. been commonly known by the name or legitimately connected with a mark which is identical or similar to the Domain Name; or

C. made legitimate non-commercial or fair use of it.

.....'

21. The Expert makes the following findings on the issue of Abusive Registration. Persons visiting knockoutchallenge.co.uk would expect to find

KCL's online business and by re-directing them to the online presence of a trade competitor KRL was seeking to lure KCL's customers to its own site. By pointing the Domain Names to its own web site in 2006 (knockoutchallenge.co.uk) and 2010 (both Domain Names), KRL was engaged in 'fishing' for KCL's customers. There is no other reason why KRL pointed those Domain Names at its own site. As indicated, it was not attempting to pick up traffic based on a descriptive use of 'It's A Knockout services, i.e. 'generic' traffic. This was conduct designed to confuse people into believing that the Domain Names were registered to, operated or authorised by, or otherwise connected to, KCL.

22. The fact that Mr Billington, conversant with the market in 'It's A Knockout' games, set out to mislead visitors to the Domain Names in this way indicates that he probably achieved what he set out to do. When asked to stop the offending use, Mr Billington did not say that internet users are unlikely to be confused. Two customers were confused into believing that knockoutchallenge.co.uk was connected with KCL. The clear inference from the evidence is that they typed in the words of this Domain Name, expecting to go to a web site operated by or authorised by, or connected to, the person running 'Knockout Challenge', i.e. KCL.
23. Mr Pike discovered the existence of itsaknockoutchallenge.co.uk in 2010, pointing at KRL's web site. That was another attempt to fish for KCL's customers and is likely to have caused confusion of the same kind as that referred above to in relation to knockoutchallenge.co.uk. The presence of the word 'its' in the Domain Name is unlikely to have prevented confusion (quite the contrary) and the fact that Mr Billington stopped the abuse in relation to itsaknockoutchallenge.co.uk shortly before the Complaint indicates that he knew that this conduct could not be justified.
24. In view of the findings made in paragraph 18 and 21-23 above and the fact that 'knockoutchallenge.co.uk' is virtually identical to KCL's trade name and that 'itsaknockoutchallenge.co.uk' is also very close to that

name establish that confusion of the description set out in paragraph 3a.ii. of the Policy has occurred in relation to both Domain Names.

25. The correspondence and events since 2006 establish the likelihood that KRL will recommence this abuse of the Domain Names at some point in the future with the result that internet users will again be confused into believing that the Domain Names are operated or authorised by, or connected with the providers of Knockout Challenge, namely KCL. The implied threat that this may occur unless KCL pays what KRL demands for those Domain Names is also in itself unfair use of the Domain Names.
26. The abusive use that has already taken place justifies an order of transfer on its own. Allied with what the Expert has found to be the real risk of future misuse and unfair use, there is no justification for KRL to keep the Domain Names. It follows that none of the grounds specified in paragraph 4 of the Policy has been made out or any other reason shown why the registration is not an Abusive Registration.
27. In the circumstances, the Expert finds that the Domain Names have been used in a manner which has taken unfair advantage of, and has been unfairly detrimental to, the Complainant's Rights; and finds that the Domain Names, in the hands of the Respondent, are therefore Abusive Registrations.

Decision

28. The Complainant has Rights in a name or mark, which is identical or similar to the Domain Names, and the Domain Names in the hands of the Respondent are Abusive Registrations. The Expert therefore determines that the Domain Names `knockoutchallenge.co.uk` and `itsaknockoutchallenge.co.uk` be transferred to the Complainant.

Signed Stephen Bate

Dated 31.01.11