

DISPUTE RESOLUTION SERVICE

D00009326

Decision of Independent Expert

QSoft Consulting Limited

and

realphangan

1. The Parties:

Lead Complainant: QSoft Consulting Limited
6th Floor, Queen's House
2 Holly Road
Twickenham
Middlesex
TW1 4EG
United Kingdom

Respondent: realphangan
145, moo1
koh phangan
84280
Thailand

2. The Domain Name(s):

gaydarstore.co.uk

3. Procedural History:

The Complaint was lodged with Nominet on 24 November 2010. Nominet validated the Complaint and informed the Respondent that the Dispute Resolution Service ("DRS") had been invoked and that the Respondent had 15 working days to submit a Response. The Respondent did not respond to the Complaint. The Complainant was informed that a Response had not been filed and given the option of paying for a summary decision or a full decision. On 21 December 2010 the Complainant paid

Nominet the appropriate fee for a full decision of an expert pursuant to paragraph 7 of the Nominet DRS Policy (“the Policy”). On 10 January 2011 Nominet appointed Andrew Clinton (“the Expert”) as the Independent Expert.

The Expert has confirmed to Nominet that he knows of no reason why he could not properly accept the invitation to act as Expert in this case and has further confirmed that he knows of no matters which ought to be drawn to the attention of the parties which might appear to call into question his independence.

4. Factual Background

The Complainant is a limited company that has a number of business interests which have trading styles that consist of, or incorporate, the word GAYDAR. The Complainant has a portfolio of Community Trade Marks and domain names that consist of, or incorporate, the word GAYDAR.

The Respondent registered the Domain Name on 20 October 2010. The documents before the Expert do not disclose any information about the Respondent other a name, an address in Thailand and an e-mail contact address.

The Complainant acted promptly in response to the registration of the Domain Name by lodging the Complaint with Nominet within 5 weeks of the registration.

The Domain Name resolves to a website selling explicit gay videos, sex aids and products described as legal highs.

5. Parties’ Contentions

Complainant

The Complaint, so far as is material, is summarised below.

Rights

The Complainant is the registered proprietor of 8 European Community Trade Marks consisting of, or incorporating, the word GAYDAR, including CTM Numbers 2127264, 2564458, 3804168, 3886256, 3886264, 3886298, 6441919, and 6441927.

The Complainant has established a substantial reputation and protectable goodwill in respect of dating agency services and online introduction services, operated under or by reference to the names GAYDAR and GAYDARGIRLS, and has established a substantial reputation and protectable goodwill in respect of a social networking site operated under or by reference to the name GAYDARNATION, and has established a substantial reputation and protectable goodwill in respect of internet radio services operated under or by reference to the name GAYDARRADIO.

The Complainant owns in excess of 380 domain names consisting of, or incorporating, the word GAYDAR, including gaydar.co.uk, gaydarguys.com, gaydarnation.com and gaydar.eu.

Abusive Registration

The Respondent has no rights in the word GAYDAR.

The Domain Name consists of an expression comprising the Complainant's registered trade mark GAYDAR coupled with the descriptive word "STORE" and this is on all fours with domain names which are in use by the Complainant including gaydargirls.co.uk, gaydarnation.com, and gaydarradio.com. It is inevitable that consumers will believe that the Domain Name is another from the same stable as these and that it belongs to the Complainant.

The Domain Name seeks to take unfair advantage of the Complainant's reputation in the GAYDAR trade mark to sell goods which are likely to be directly detrimental to the established goodwill and reputation enjoyed by the Complainant in GAYDAR. The Domain Name points to a website from which gay pornographic videos, chemical stimulants and sex aids are offered for sale.

Use of the Domain Name will take unfair advantage of the Complainant's goodwill, reputation and registered rights in the name GAYDAR by diverting custom from the Complainant to the website of the Respondent.

The Respondent has been "spamming" members of the Complainant's GAYDAR dating agency website with details of the Respondent's website located at www.gaydarstore.co.uk.

The Complainant seeks a transfer of the Domain Name.

Respondent

The Respondent did not file a Response.

6. Discussions and Findings

General

Under paragraph 2 of the Policy the Complainant has to prove on the balance of probabilities: firstly, that it has Rights in respect of a name or mark which is identical or similar to the Domain Name; and secondly, that the Domain Name is, in the hands of the Respondent, an Abusive Registration.

Complainant's Rights

Rights are defined in the Policy as meaning rights enforceable by the Complainant, whether under English law or otherwise. The Complainant is the registered proprietor of 8 Community Trade Marks consisting of, or incorporating, the mark GAYDAR. These include the Community Trade Mark number 2127264 registered as at January 2003 for the word mark GAYDAR in classes 35 (advertising and sales promotional services provided by means of the Internet), 38 and 42 and Community Trade Mark number 3804168 registered as at November 2005 for the word mark GAYDAR in classes 38 and 41. The Complainant has also produced evidence which shows that it has unregistered rights in the mark GAYDAR by reason of the use of that name in connection with its online business activities. These include a dating agency, a social networking site and an Internet radio station. The Complainant owns in excess of 380 domain names that incorporate the word GAYDAR, the earliest of which (gaydar.co.uk) was registered in May 1999.

The Domain Name comprises the mark GAYDAR together with the descriptive, non-distinctive word STORE. The Expert finds that the Complainant has Rights in the mark GAYDAR which is similar to the Domain Name. The Complainant has therefore succeeded in proving the first element required under paragraph 2(a)(i) of the Policy.

Abusive Registration

Abusive Registration is defined in paragraph 1 of the Policy to mean 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.

Factors pointing to Abusive Registration – paragraph 3 of Policy

A non-exhaustive list of factors which may be evidence of an Abusive Registration is set out in paragraph 3 of the Policy. The factors that are potentially relevant to this dispute are:

- a(i) Circumstances indicating that the Respondent has registered or otherwise acquired the Domain Name primarily:
 - A. [not relevant];
 - 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 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;

It is clear from the wording of the Policy that the list of factors at paragraph 3 is non-exhaustive and that a Complainant can succeed in proving Abusive Registration without necessarily being required to prove any of those factors. However, in order to do so it is necessary to prove that the definition of Abusive Registration, as set out in paragraph 1 of the Policy, has been satisfied.

Factors pointing against Abusive Registration – paragraph 4 of Policy

There is a non-exhaustive list of factors which may be evidence that the Domain Name is not an Abusive Registration at paragraph 4 of the Policy.

Discussion and findings regarding Abusive Registration

There has been no Response and there is therefore no dispute as to the material facts:

1. The Complainant has a large collection of domain names that consist of, or incorporate, the word GAYDAR together with descriptive, non-distinctive words such as those set out below:

<u>Domain Name</u>	<u>Date of Registration</u>
gaydarradio.com	9 May 2001
gaydardirect.co.uk	14 March 2006
gaydargift.co.uk	16 January 2009
gaydargirls.co.uk	30 November 2001
gaydarshop.com	23 December 2000
gaydarworld.com	13 April 2005
gaydarnation.com	17 June 2005

2. The Complainant operates online businesses from the following domain names: gaydar.eu, gaydar.co.uk, gaydar.us, gaydarguys.com, gaydar.net, gaydarnation.com, gaydarradio.com and gaydargirls.com.
3. The Respondent has no commercial connection to the Complainant.
4. The Domain Name resolves to a website that sells various goods and services that have no connection to the Complainant.

A Domain Name can be an Abusive Registration either because it was registered with an abusive intent or because it has been used in an abusive manner. The Complainant alleges both abusive registration and abusive use.

Abusive registration

The primary complaint in terms of abusive registration (as opposed to use) is made under paragraph 3(a)(ii) of the Policy which concerns confusing use of a domain name. For these purposes, the “confusion” is confusion as to the identity of the person/entity behind the domain name. The Complainant’s case is that an Internet user is likely to believe that the Domain Name belongs to, or is in some way connected with, the Complainant. The Experts’ Overview, published by Nominet, discusses “initial interest confusion” and phrases the issue by asking the following question:-

“Will an Internet user seeing the domain name or the site to which it is connected believe or be likely to believe that the domain name is registered to, operated or authorised by, or otherwise connected with the Complainant?”

If the answer to that question is yes then the Internet user will have been drawn to the website by use of the mark of the Complainant and that is not a “legitimate” use of the mark. It is relatively straightforward if the domain name is identical to the mark (i.e. without any adornment) and it cannot sensibly refer to anyone other than the Complainant. In cases where the domain name is similar (but not identical) to the mark then it will be the nature of the adornment that is the critical factor when considering initial interest confusion. The further away the domain name is from the Complainant’s mark the less likely it is that there will be a finding of Abusive Registration.

As the Experts’ Overview points out, the activities of registrants who attach as an appendage to the Complainant’s mark a non-distinctive term indicating that they are a trader in the Complainant’s goods or services have been condemned. The Appeal Panel in *Seiko UK Ltd –v- Wanderweb* DRS 00248 held that a trader in Seiko products was not allowed to retain the domain name *seiko-shop.co.uk* as it made, or was liable to be perceived as making, a representation that there was something approved or official about the website.

The Appeal Panel in *Toshiba Corporation –v- Power Battery Inc* DRS 07991 also considered this issue. In that case the Appeal Panel referred to a number of principles, which included:

1. A registration will be abusive if the effect of the respondent's use of the domain name is falsely to imply a commercial connection with the complainant.
2. Such an implication may be the result of "initial interest confusion" and is not dictated only by the contents of the website.
3. Whether or not a commercial connection is implied, there may be other reasons why the reseller's incorporation of the domain name is unfair. One such reason is the offering of competitive goods on the respondent's website.

The case concerned the domain name *toshiba-laptop-battery.co.uk* and involved a website that offered Toshiba products as well as those of Toshiba's competitors. The Appeal Panel held by a majority that, so far as the domain name itself was concerned, the two extra hyphenated words turned the domain name as a whole into a rather clear description of the main goods offered on the website (replacement batteries for Toshiba laptop computers) and there had been no "initial interest confusion".

Does the attachment of the descriptive, non-distinctive word STORE to the Complainant's mark imply a commercial connection to the Complainant? In the *Seiko* case it was felt that the word SHOP made the representation "we are the official UK Seiko watch shop". In the Expert's view, the attachment of the word STORE to the Complainant's mark does imply that there is a commercial connection to the Complainant. As long as the word GAYDAR is sufficiently distinctive of the Complainant (as to which see below) the Domain Name does imply that "we are the official store that sells GAYDAR products". As the Experts' Overview points out, it does not matter that immediately upon arriving at the website the Internet user becomes aware there is no connection to the Complainant as the user will still have been deceived.

Abusive use

Although the Appeal Panel in the *Toshiba* case did not find that there had been "initial interest confusion" they did make a finding of Abusive Registration on the basis that

the Domain Name had been used in an abusive manner. The Appeal Panel said that if and insofar as it is fair for a retailer to incorporate a trade mark into its domain name (without the trade mark owner's consent) that fairness is likely to be dependent upon the retailer only selling the trade mark owner's genuine products. The Appeal Panel felt that to do otherwise was likely to take unfair advantage of the Complainant's rights by "riding on its coat-tails" for the benefit of the Respondent. The element of unfair advantage remains, even where little or no detriment to the Complainant has been demonstrated.

In this case the website has been used to sell products that are not offered for sale by the Complainant so there is no suggestion that the Complainant has suffered any detriment in terms of diverted sales. However, that is not a requirement for a finding of Abusive Registration as the definition covers both taking unfair advantage of and causing unfair detriment to the Complainant's rights.

The Expert's view is that using the Complainant's mark in order to promote the Respondent's own products and services does take unfair advantage of the Complainant's rights. In addition, if Internet users remain confused, i.e. having arrived at the website they believe there is a commercial connection to the Complainant, the nature of the material on display (which appears to be of a far more explicit nature than the material that appears on the Complainant's websites) may cause damage to the Complainant's brand and that would be enough to amount to unfair detriment to the Complainant's rights.

Gaydar

Had the Respondent submitted a Response it is conceivable that it might have made submissions that, whilst the word SEIKO cannot sensibly refer to anyone other than the owner of the SEIKO trade mark, the word GAYDAR is not distinctive of the Complainant. The word GAYDAR is a portmanteau of the words GAY and RADAR and it is defined in the Oxford English Dictionary (from at least the 2005 edition) as the supposed ability of homosexuals to recognise one another by means of very slight indications. The word is said to have its origins in the 1980s. It might have been submitted that GAYDAR is a descriptive term and that the Respondent registered the Domain Name without knowledge of the Complainant's rights in the word. However, there is no such submission before the Expert. The evidence shows that the Complainant began building its portfolio of domain names that consist of, or

incorporate, the word GAYDAR in 1999 and obtained its first trade mark registration for the word GAYDAR in 2003. The Complainant asserts that it has established a substantial reputation and goodwill through its online business activities and has provided screenshots of 7 separate websites that operate from domain names that incorporate the word GAYDAR. On the basis of the available evidence (to which there is no challenge) the Expert finds that the word GAYDAR has acquired a degree of distinctiveness owing to its use by the Complainant.

The Complainant says that the Respondent has been “spamming” members of the Complainant’s GAYDAR dating agency website with details of the Respondent’s website. This is an aggravating factor and supports the view that GAYDAR members are very likely to have been confused by the Respondent’s activities even if a random member of the public might not have been.

The Expert finds on the balance of probabilities that the Domain Name is, in the hands of the Respondent, an Abusive Registration both because the Domain Name was registered with an abusive intent (under the principle of initial interest confusion) and because it has been used in an abusive manner. That is not to say that this decision can, or should, be relied upon as establishing that the Complainant has a monopoly in the word GAYDAR for all purposes or exclusivity in it for the purposes of domain name registrations. This decision is confined to its particular facts.

7. Decision

The Expert finds, on the balance of probabilities, that the Complainant has Rights in a mark which is similar to the Domain Name and that the Domain Name is, in the hands of the Respondent, an Abusive Registration. The Expert directs that the Domain Name be transferred to the Complainant.

Signed Andrew Clinton

Dated 31 January 2011