

DISPUTE RESOLUTION SERVICE

D00013031

Decision of Independent Expert

Woburn Enterprises Partnership

and

Global Publications Ltd

1. The Parties

Complainant: Woburn Enterprises Partnership
The Bedford Office
Woburn
Milton Keynes
Bedfordshire
MK17 9PQ
United Kingdom

Respondent: Global Publications Ltd
Chancery Pavilion
Boycott Avenue
Oldbrook
Milton Keynes
Buckinghamshire
MK6 2TA
United Kingdom

2. The Domain Name

<woburngolf.co.uk>

3. Procedural History

02 July 2013 14:57 Dispute received
03 July 2013 11:58 Complaint validated
03 July 2013 12:23 Notification of complaint sent to parties
22 July 2013 02:30 Response reminder sent
25 July 2013 09:23 No Response received
25 July 2013 09:24 Notification of no response sent to parties
05 August 2013 10:36 Expert decision payment received
08 August 2013 Expert appointed: Steven A. Maier

The Expert has confirmed that he is independent of each of the parties and that to the best of his 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 a such a nature as to call into question his independence in the eyes of one or both of the parties.

4. Factual Background

The Complainant and its predecessor in business have operated a business under the name “Woburn Golf and Country Club” since 1976.

The Domain Name was registered on 19 April 2004.

At the date of the Complaint, the Domain Name did not resolve to any active website.

5. Parties’ Contentions

The Complainant

The Complainant submits that it has Rights in respect of a name or mark that is identical or similar to the Domain Name for the purposes of paragraph 2(a)(i) of the Nominet DRS Policy (“the Policy”).

The Complainant states that its predecessor in business, Woburn Enterprises Limited, founded the “Woburn Golf and Country Club” in 1976. The golf club was one of a number of businesses operated by Woburn Enterprises on the Duke of Bedford’s Woburn Abbey estate, which were reorganised in 2009 under the umbrella of the Complainant.

The Complainant states that the “Woburn Golf and Country Club”, which is also known simply as the “Woburn Golf Club”, comprises three internationally renowned golf courses, and provides evidence that it has staged at least 50 important golfing tournaments since 1979, including the British Masters, the Women’s British Open and others, the majority of which have been televised. The Complainant submits press cuttings from 1979 and from 2004 (the year of

registration of the Domain Name) which report on competitions taking place at “Woburn Golf and Country Club” or “Woburn Golf Club”.

The Complainant submits that it has been highly active over three decades in promoting its business under the names “Woburn Golf and Country Club” and “Woburn Golf Club”. The Complainant exhibits copies of brochures dating from 2004 and Google search results limited to 2004 which refer extensively to “Woburn Golf and Country Club” and “Woburn Golf Club”.

The Complainant also relies on commercial services including sales from its professional shop, indoor fitting and related services, and its clubhouse, which hosts nationally-advertised events and corporate and society golf days. It provides evidence of overall annual turnover of £5.8m of which £701,000 relates to retail sales. The Complainant submits that much of this comprises clothing and other equipment branded with a “Woburn Golf Club” logo, which was launched in 2007 and is promoted by the club’s travelling professional, Ian Poulter.

The Complainant submits that, as a result of the above matters, the terms “Woburn” and “Golf” together have, for many years, been associated exclusively with the Complainant and that the term “Woburn Golf” cannot sensibly refer to any entity other than the Complainant.

While the Complainant does not claim any registered trade mark rights, it asserts on the basis of the above that it has strong unregistered rights in the names “Woburn Golf and Country Club” and “Woburn Golf Club” and that the Domain Name is similar to both of those names.

The Complainant also submits that the Domain Name in the hands of the Respondent is an Abusive Registration for the purposes of paragraph 2(a)(ii) of the Policy.

First, the Complainant contends that the Respondent registered the Domain Name primarily for the purpose of disrupting the Complainant’s business (paragraph 3(a)(i)(C) of the Policy).

The Complainant states that the Respondent’s address is only 5.4 miles from its own address and that in view of this, and the extensive publicity surrounding the Complainant’s golf club and its activities, it is inconceivable that the Respondent did not have the Complainant in mind when it registered the Domain Name. The Complainant also relies on the Google search results which it exhibits from 2004, which refer extensively to the Complainant and do not refer to any other UK entity known as “Woburn Golf”.

The Complainant provides internet archive results from 2004, 2006 and 2008 for the website to which the Domain Name resolved at those dates. In each case the website offered advertising, which in the most recent case included links to goods and services listed as “Golf Breaks”, “Golf”, “Golf Accessories” and “Golf Clothing”. The Complainant submits that these were goods and services offered by the Complainant’s competitors and the Respondent has therefore used the Domain Name to disrupt the Complainant’s business. The Complainant states that, even

though the Domain Name is currently inactive, it has a reasonable apprehension that it will be used for similar advertising purposes in the future.

Secondly, the Complainant submits that the Respondent is 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) of the Policy).

The Complainant relies in particular on “initial interest confusion”. It asserts that internet users who are seeking to find information about the Complainant are likely to type the Domain Name on the assumption that it will lead to the Complainant. The Complainant states that the Respondent undoubtedly selected the Domain Name for that purpose, in order to maximise traffic to its own website on the back of this confusion and to take unfair advantage of the goodwill in the Complainant’s name “Woburn Golf”.

Thirdly, the Complainant submits that the Respondent has been engaged in a pattern of Abusive Registrations. It states that the Respondent has a portfolio of over 950 .uk domain names and that a number of these appear to infringe the rights of trade mark owners. The Complainant also points to a number of previous Nominet DRS cases in which the Respondent has been involved and cites the following cases in which a transfer of the relevant domain name was ordered:

D3840 <wagamammas.co.uk> (2006)

D5815 <bertelsmann.co.uk> (2008)

D6550 <lloydsbanking.co.uk>
<lloydstsbfactoring.co.uk>
<loydsbank.co.uk>
<lloydstsbbank.co.uk> (2009)

D7578 <fsecure.co.uk> (2009)

The Complainant contends that these prior findings should be taken into account even though there are not three findings of Abusive Registration in the two years before the Complaint was filed (paragraph 3(c) of the Policy).

The Complainant also submits that the Respondent will be unable to point to any of the factors set out under paragraph 4 of the Policy which may indicate that a registration is not an Abusive Registration. In particular, the Respondent has not used the Domain Name in connection with any legitimate offering of goods or services, because its activities are not legitimate. Furthermore, while the use of a domain name to link to a pay-per-click site is not in itself objectionable, the Respondent’s use is unfairly detrimental to the Complainant in this case.

The Complainant seeks a transfer of the Domain Name.

The Respondent

No Response has been filed in this case.

The Expert is satisfied that Nominet took the appropriate steps to notify the Respondent of the Complaint in accordance with paragraph 2(a) of the Nominet DRS Procedure (“the Procedure”) by sending the Complaint by first class post and by email to the contact details for the registrant shown in its database and by email to postmaster@woburngolf.co.uk.

It is, of course, the responsibility of a registrant under the Nominet Terms and Conditions of Domain Name Registration to keep Nominet updated with its current contact details.

6. Discussions and Findings

This matter falls to be determined under the Policy and the Procedure. Under paragraph 2 of the Policy:

- “(a) A Respondent must submit to proceedings under the Dispute Resolution Service if a Complainant asserts to [Nominet], according to the Procedure, that:*
- (i) the Complainant 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.*
- (b) The Complainant is required to prove to the Expert that both elements are present on the balance of probabilities.”*

Under paragraph 1 of the Policy the term “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.”

Also under paragraph 1 of the Policy, the term “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.”*

Paragraph 3 of the Policy sets out a non-exhaustive list of factors that may be evidence that a domain name is an Abusive Registration. Paragraph 4 of the Policy sets out a non-exhaustive list of factors that may be evidence that it is not

an Abusive Registration. However, all such matters are subsidiary to the overriding test for an Abusive Registration as set out as in paragraph 1 of the Policy.

Rights

The Complainant does not have any registered trade mark rights in this case. However, the Expert is satisfied that the Complainant (or its predecessor in business) have traded under the names “Woburn Golf and Country Club” and “Woburn Golf Club” since 1976. The Expert is also satisfied that, by virtue of the golf tournaments organised by the Complainant, the publicity undertaken by it and its commercial activities including the sale of branded goods, the Complainant has Rights for the purposes of the Policy in the names “Woburn Golf and Country Club” and “Woburn Golf Club”. While both names are descriptive of a location and of services, the Expert finds that both names have acquired secondary meanings which are distinctive of the Complainant and its business. If, for example, a third party were to open a golf club named “Woburn Golf Club” in reasonable proximity to the Complainant, it is clear to the Expert that the Complainant would have at least an arguable case for passing off in that regard.

The Expert also finds that, since the terms “Woburn” and “Golf” describe the Complainant’s location and one of its key services, the Complainant’s names “Woburn Golf and Country Club” and “Woburn Golf Club” are similar to the Domain Name. The absence of the terms “Club” or “and Country Club” from the Domain Name does not serve to distinguish it from the Complainant’s names.

In the circumstances, the Expert finds that the Complainant has Rights in respect of a name or mark that is similar to the Domain Name.

Abusive Registration

While the Complainant relies on a number of provisions set out under paragraph 3 of the Policy, the crux of its case is that the Respondent must be assumed to have known of the Complainant’s names “Woburn Golf and Country Club” and “Woburn Golf Club” and to have registered the Domain Name for the purpose of taking unfair advantage of the Complainant’s goodwill in those names. The Complainant argues that the Respondent cannot have been unaware of the Complainant’s names given the geographical proximity of the parties and the Complainant’s significant reputation and internet presence when the Domain Name was registered in 2004. The Complainant submits that the Respondent has profited from pay-per-click and other advertising on the back of the Complainant’s goodwill and has gained an unfair advantage and has caused unfair detriment to it accordingly. The Complainant contends that Respondent’s record in other DRS cases also points to an Abusive Registration in this case.

Given the descriptive nature of each the two elements that comprise the Domain Name, this is not a case in which it is impossible to conceive of any legitimate use that could be made of the Domain Name otherwise than by the Complainant. However, the Expert accepts on the basis of the Complainant’s submissions summarised above that the Complainant has made out a *prima facie* case of an Abusive Registration on the part of the Respondent; in other words, the Complainant has established, at least, a case for the Respondent to answer.

However, no Response has been filed in this case. Nor is there any other evidence available to the Expert to contradict the Complainant's submissions or to suggest that any of the matters set out under paragraph 4 of the Policy apply in this case, or that there is any other legitimate basis for the Respondent's registration and use of the Domain Name.

The Expert therefore concludes on the balance of probabilities that the Respondent registered and has used the Domain Name in the knowledge of the Complainant's Rights, and that it has used and is 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) of the Policy). The Expert accepts that the Domain Name gives rise to "initial interest confusion" in this regard and that the Respondent is likely to have profited from this confusion by virtue of the links that have from time to time been included on its website, including links to competitors of the Complainant. (Since there has been no direct communication between the parties, the "threat" in this instance is implied and arises from the Respondent's previous use of the Domain Name.)

While the Expert finds that the other Nominet DRS cases that have been decided against the Respondent contribute to the *prima facie* case referred to above, this matter is not in itself determinative of the Complaint.

The Expert notes that the Complainant did not bring a Complaint concerning the Domain Name for over nine years following the date of registration and that the Complainant offers no explanation for this delay. The Expert concludes that the Complainant is unlikely to have been damaged by any significant actual confusion arising from the Domain Name or its use for advertising purposes during the periods identified by the Complainant. However, in the view of the Expert, this does not detract from the Complainant's case based on "initial interest confusion" and the Respondent having taken unfair advantage of the Complainant's goodwill by virtue of its registration and use of the Domain Name.

Accordingly, the Expert finds that the Domain Name was registered and has been used in a manner which took unfair advantage of, or was unfairly detrimental, to the Complainant's Rights, and is therefore an Abusive Registration.

7. Decision

The Expert has found that the Complainant has Rights in respect of a name or mark which is identical or similar to the Domain Name and that the Domain Name in the hands of the Respondent is an Abusive Registration. Accordingly the Complaint is upheld and it is ordered that the Domain Name <woburngolf.co.uk> be transferred to the Complainant.

Steven A. Maier

13 August 2013