



DISPUTE RESOLUTION SERVICE

D00016036

Decision of Appeal Panel

Wrexham MOT Centre t/a Wrexham Minibus Hire

and

Richard Bennit

1. The Parties:

Complainant:

Wrexham MOT Centre t/a Wrexham Minibus Hire
Unit 1b Felin Puleston Industrial Estate
Ruabon Road
Wrexham
LL13 7RF
United Kingdom

It should be noted at the outset that the issue of the precise identity of the Complainant is not straightforward - see Section 5 below.

Respondent:

Mr Richard Bennit
Unit 1 Riverside Yard
Hightown Road
Wrexham
LL13 8ED
United Kingdom

2. The Domain Name:

The domain name in issue is wrexhammotcentre.co.uk (the "Domain Name")

3. Procedural History

This is an Appeal against the decision of Tim Brown (the “Expert”) issued on 6 August 2015 in favour of the Respondent. Definitions used in this decision have the same meaning as set out in the Nominet UK Dispute Resolution Service Policy Version 3, July 2008 (the “Policy”) and/or the Nominet UK Dispute Resolution Service Procedure Version 3, July 2008 (the “Procedure”) unless the context or use indicates otherwise.

The procedural history of relevance to this Appeal is as follows:

5 June 2015	Complaint received
23 June 2015	Response received
26 June 2015	Reply received
16 July 2015	Mediation failed
17 & 28 July 2015	Respondent submitted explanatory paragraphs to explain why he wished to put forward two non-standard submissions under Paragraph 13b of the Procedure. The expert subsequently declined to admit these.
6 August 2015	Expert’s decision in favour of the Respondent
11 September 2015	Appeal Notice filed
23 September 2015	Appeal Response
25 September 2015	Appeal Panel appointment

Nick Gardner, Phil Roberts and Ian Lowe (together, “the Panel”) have each made a statement to the Nominet Dispute Resolution Service in the following terms:

“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 in to question my independence in the eyes of one or both of the parties.”

4. The Nature of This Appeal

Paragraph 10.a. of the Policy provides that: “The appeal panel will consider appeals on the basis of a full review of the matter and may review procedural matters”. The Panel concludes that insofar as an appeal involves matters other than purely procedural complaints the appeal should proceed as a re-determination on the merits. Therefore it is not necessary to analyse the first instance decision in any detail beyond the provision of the following summary:

The Expert in his decision found that the Complainant had Rights in the mark “Wrexham MOT Centre”, by virtue of an informal licence of UK registered trademark no. 3050347, which was a mark that was identical to the Domain Name. He then concluded the Domain Name was not an Abusive Registration. He did so on the basis that the Complainant had not established it had Rights which pre-dated the registration of the Domain Name. The full text of the Expert’s decision is available on Nominet’s website.

For convenience the Panel will continue to refer to the parties as the “Complainant” and “Respondent”.

5. Formal and Procedural Issues

Identity of the Complainant

A matter of some significance is identification of the Complainant. As appears below this case turns upon the nature and extent of Rights in the name “Wrexham MOT Centre”. In order to consider this question it is first necessary to identify the Complainant, who will be the person claiming to have such Rights.

Paragraph 3 of the Procedure provides that “Any person or entity may submit a complaint to us in accordance with the Policy and this Procedure.” It follows that the Complainant must be a “person or entity”. The term “person” refers to a legal or natural person: someone or something which has legal personality – for example an individual, a partnership, or a limited company. However the word “entity” would appear to permit a potentially wider category of complainants where the question of legal personality may be less clear cut – possible examples include trusts, unincorporated associations and bodies formed under foreign legal systems. It is also the case that a given person or entity may adopt one or more trading names or styles which may differ from its legal or usual name. It is for the Complainant to identify who it is, and where necessary to provide appropriate explanation of its identity and trading names or styles. In most cases this is likely to be clear and straightforward and may need no additional explanation beyond identification of the person or entity in question. Where however the position is not clear it is for the Complainant to explain its case. The present case is a paradigm example of lack of clarity.

A DRS Complaint is created via Nominet’s online system. That system contains clear instructions as to how to create the relevant forms, including instructions as to how representatives acting for a Complainant should fill in the forms. It also provides mechanisms for reviewing the Complaint thereby created and if necessary going back in the process and correcting any errors. There is also a wealth of further guidance on Nominet’s website about how to prepare and file a Complaint. That material includes the “Experts’ Overview”, a paper the purpose of which is, as it states, “to assist all participants or would-be participants in disputes under the DRS Policy by explaining commonly raised issues and how Experts, the members of Nominet’s panel of independent adjudicators, have dealt with those issues to date”. Further reference is made below to various matters where the Experts’ Overview provides relevant guidance.

In the present case a company called Trade Law Consult Ltd (“TLC”) is acting for the Complainant and appears to have prepared and filed the Complaint. That company is not a firm of solicitors nor, so far as the Panel can tell, otherwise professionally qualified. It describes itself in its e-mails as “Legal and Business Consultants”. The text which was entered into the relevant forms in preparing the Complaint is set out verbatim in Section 6 below, under the heading ‘Parties’ Contentions’. This has resulted in the following position:

The Complaint is brought in the name of “Wrexham MOT Centre t/a Wrexham Minibus Hire”. The Panel assumes t/a to be an abbreviation for “trading as” so the relevant Complainant is apparently an entity “Wrexham MOT Centre” which trades under another name “Wrexham Minibus Hire”. The contact details for that Complainant are given as Mr Sanjay Bhalla with a TLC e-mail address. The body of the Complaint is then written in terminology which refers to “our client” as a natural person, as in for example: “Our client confirms that he has historically traded as Wrexham MOT Centre” and “In the more recent past, our client has taken steps to protect his trading style and has registered a Trademark therein (Wrexham MOT Centre)” and “our client is also the owner of registered limited company... (CRN 08540202) WREXHAM MOT CENTRE LIMITED”

Evidence filed with the Complaint includes a copy of the trade mark registration certificate for UK registration no. 00003050347 which is for “Wrexham MOT Centre” and is registered in the name of Robert Ian Griffith¹. Also annexed to the Complaint is a letter dated May 2015 from a firm of accountants (this letter is referred to subsequently in this decision as the “Accountants’ Letter”) which reads:

“To Whom it may concern. We act for Mr & Mrs R.I. Griffith who trade in partnership as Wrexham Tyres and Exhausts at Unit 2, Felin Puleston, Ruabon Road, Wrexham LL13 7RF. Please note that Mr & Mrs Griffiths were appointed by VOSA as an authorised MOT Centre in September 2003 and since then have traded under the name ‘Wrexham MOT Centre’. We have seen documentary evidence which confirms that this is the case and understand that a Trade Mark has been registered. Yours faithfully”

Also filed with the Complaint is a photograph of the exterior of some garage premises, presumably those of the Complainant (this photograph is referred to subsequently in this decision as the “Premises’ Photograph”). This bears a date stamp of 27 March 2015. It shows an industrial building with a number of signs with the most prominent saying “Wrexham Tyres”, the next most prominent saying “Wrexham Car and Van Hire” and then the third most prominent saying “Wrexham MOT Centre”. The latter sign includes on it an image of three equilateral triangles with adjoining apexes in white on a blue background – this logo as the Panel understands it is a statutory requirement that any approved MOT Vehicle Test Station has to display². There are further signs on the building – including “Arvin Timax Exhaust Centre”, “Bosch Cool Car Vehicle Air Conditioning Centre” and “Approved RAC Warranty Repair Centre”. There is also lettering sign-written onto the eaves of the building which reads “Wrexham MOT and Tuning Centre”.

A further filing with the Complaint is a “cease and desist” letter from TLC to the Respondent dated 12 March 2015. This correspondence is clearly designed to imitate a “letter before action” of the type that might be received from solicitors. It is prominently headed “Our Client: Wrexham Car and Van Hire of Unit 2, Felin Puleston, Ruabon Road, Wrexham, LL13 7RF” but then commences by stating “This

¹ Mr Griffith’s name is spelt this way on the certificate. In other documents it is spelt “Griffiths”. The Panel uses “Griffith” except where quoting from documents.

² See Section 6 below under the heading “The Facts”

Company is instructed by the above named client (hereinafter “R I Griffith T/A Wrexham MOT Centre” or “our client”)³.

Further confusion is introduced in the Reply filed on behalf of the Complainant. This stated (in response to the Respondent pointing out that Wrexham MOT Centre Limited was a dormant company) “The complaint was NOT issued by a dormant Company, but by R I Griffiths T/A Wrexham MOT Centre (amongst others)”. That statement is not correct – the Complaint was not issued in Mr Griffith’s name - his name does not appear anywhere in the body of the Complaint as filed, only in the annexed materials as noted above.

All of this conflicting material is highly confusing and could have been avoided particularly as the Experts’ Overview expressly deals with this area – see paragraph 1.1(a): “The Complainant should be the owner/licensee of the Rights in the name or mark, which the Complainant contends is identical or similar to the domain name in dispute. Surprisingly often, complaints under the DRS Policy (“the Policy”) are lodged in the names of persons and entities not demonstrably the proprietor of the relevant Rights”. Given that there does not appear to be any dispute that Wrexham MOT Centre Limited is dormant it seems likely that what the Complaint should have done was to identify Mr Griffith (either alone or in partnership with his wife) as the relevant Complainant, using a trading name of “Wrexham MOT Centre”. However it is not for the Panel to rewrite the Complaint to set out what the Panel surmises might be the position - the Complainant of record is “Wrexham MOT Centre t/a Wrexham Minibus Hire” and the Panel will proceed on that basis. The Panel would however add that even if the Complaint had been brought in Mr Griffith’s name that would not, on the evidence before it, have altered the Panel’s decision.

Admissible material on Appeal

Nominet’s DRS system is intended to be a relatively informal, quick and economic means of resolving disputes about domain names, where the disputes fall within the ambit of the Policy. It is not essential for parties to be represented, whether by solicitors or others. The system does however have rules which do need to be followed and parties need to prepare their case in accordance with those rules. This is essential if a fair, consistent and predictable system is to be available to determine these disputes. As well as the rules there are also guidelines promulgated by Nominet which are available to assist parties in preparing their case thoroughly. All of this is clearly explained on Nominet’s website.

In the present case neither party seems to have paid much, if any, attention to the rules or the guidelines. The papers that were before the Expert in the form of the Complaint, the Response and the Reply were all extremely short. As indicated above the Complaint and the Reply were very confusing in identification of who the Complainant was. The papers were conspicuously devoid of relevant

³ While this has formed no part of its reasoning in this appeal, the Panel feels it should mark its disapproval of the regrettable correspondence emanating from TLC in this dispute. The tone is gratuitously aggressive and the letters contain threats of immediate legal action even though TLC is not a firm of solicitors. It is also inaccurate in many respects including for example suggesting that the losing party in a Nominet DRS procedure may become liable for costs.

information such as details of or reference to the contents of both the Complainant's and the Respondent's websites. The Respondent subsequently sought to introduce further material which the Expert declined to allow, on the basis it could all have been included with the Response.

Both of the Parties have now sought to introduce further evidence in the course of the appeal process. The Complainant for its part seeks to introduce material about other domain names it says the Respondent has registered. The Respondent for his part seeks to introduce evidence about other companies and trading names which he says are associated with Mr Griffith and which show he is attempting to monopolise a wide range of generic motor-trade related terms in the Wrexham area.

The general rule under the Procedure is very clear: no new evidence on appeal. Paragraph 18c of the Procedure states (with emphasis added) "An appeal notice should not exceed 1000 words, should set out detailed grounds and reasons for the appeal, but shall contain **no new evidence or annexes**" and paragraph 18f states (with emphasis added) "An appeal notice response must not exceed 1000 words, should set out detailed grounds and reasons why the appeal should be rejected but should contain **no new evidence or annexes**". This is the general rule, subject to the limited exception set out in paragraph 18h of the Procedure: "The appeal panel should not normally take into consideration any new evidence presented in an appeal notice or appeal notice response, unless they believe that it is in the interests of justice to do so."

Neither party has made any formal application for permission to introduce this new material or to justify to the Panel why it would be in the interests of justice to consider such new material. All of the material appears to the Panel to be material which would have been available to the parties at the time they filed the original Complaint (or Response or Reply). In all the circumstances the Panel declines to admit any of this further material.

6. The Facts

The position with regard to the Complainant (whoever it is – see Section 5 above) and its business is wholly unclear. It does not seem to be in dispute that motor trade related activities are carried out from the premises at Unit 2, Felin Puleston, Ruabon Road, Wrexham which premises are those shown in the Premises' Photograph. The Panel is unable on the material before it (see below), to disentangle exactly what entities are carrying out what businesses at those premises – it appears clear that multiple trading names are being used in respect of the businesses carried out there and one or more legal persons (most likely either Mr Griffith and/or Mr Griffith in partnership with his wife) are conducting those businesses. In the circumstances the Panel refers to these businesses collectively as the "Felin Puleston Motor Trade Businesses". See further discussion on this issue below.

It is not disputed that the Respondent runs a garage business in Wrexham which trades as Riverside Auto Centre and which amongst other activities carries out MOT tests. The Respondent registered the Domain Name in 2007 and since then it

has been used to redirect searchers to his business's web site at www.riversideautos.co.uk.

Neither Party has provided the Panel with any information about MOT tests, presumably considering this is a matter of general knowledge. The following information is derived from the Government web site – www.gov.uk. An MOT test is a test which by law certain vehicles must have carried out annually. The MOT test checks that a vehicle meets road safety and environmental standards. In most cases it has to be carried out once a vehicle is three years old and then annually thereafter. The test has to be carried out by an approved examiner at an approved testing location. It is an offence to drive a vehicle which requires an MOT test certificate on the public highway if it does not have a current certificate. The Government's website refers to approved locations as "MOT Test Stations" but also uses the term "MOT test centre" or "MOT centre" to refer to these locations - for example "You must use an approved MOT test centre to get your MOT" and "Contact an MOT centre to book an MOT. Only centres showing the blue sign with 3 white triangles can carry out your MOT".

There does not appear to be any restriction on the number of MOT Test Stations that can exist in a given geographic location. A simple Google search for the words "MOT" and "Wrexham" reveals there are many MOT Test Stations in Wrexham. Establishing the exact number is not straightforward as many of the entries returned by the search are for sites providing directory listings of MOT Test Stations or similar aggregation sites, but for the purposes of this Appeal it suffices to note that there are certainly in excess of a dozen such stations, including that of the Respondent, and that associated with the Complainant, which is discussed further below.

The Parties' Contentions

Given the criticisms that have been made by the Panel of the form and substance of the Complaint, Response and Reply, and because the material the Parties put before the Expert was relatively short, the material is set out verbatim below, subject only to omission of cross-references and duplication.

The Complaint

This reads as follows:

"What rights are you asserting?"

Our client confirms that he has historically traded as Wrexham MOT Centre, for an approximate period of fifteen years from one or more sites within Felin Puleston Industrial Estate, Ruabon Road, Wrexham. In the more recent past, our client has taken steps to protect his trading style and has registered a Trademark therein (Wrexham MOT Centre). The basis upon which the Trademark was accepted was that of historical trading in the name Wrexham MOT Centre, accepted to have originated approximately fifteen years ago. Our client's registered Trademark is UK00003050347 WREXHAM MOT CENTRE in Class 42.

Notwithstanding the foregoing Trademark, our client is also the owner of registered limited company, registered within the past few years after trading in

the protected name for a considerable number of years, as outlined above, with Company Registration Number 08540202 WREXHAM MOT CENTRE LIMITED

Having established our client's intellectual property above, by:-

A his long established trading history of approximately fifteen years in the trading name(s) aforesaid; and

B the registered Trademark in the name of Wrexham MOT Centre; and

C the registered limited company detailed [cross reference omitted] above;

Why is the domain name an Abusive Registration?

[duplication of above text omitted]

It is abundantly clear that the registrant has registered the domain name subsequent to our client's advertising thereof, some years ago. It is clear that the registrant's use of our client's registered Trademark in Wrexham MOT Centre is intended to cause confusion to customers of our client and amounts to passing off and/or an attempt to divert business from our client to the said registrant's business and therefore amounts to abusive registration. It is clear that the registrant does not have a business in the protected trading name, cannot therefore provide any evidence of his usage, insofar as he has not traded as Wrexham MOT Centre historically nor does he do so currently".

The Response

This reads as follows:

"I have had the above domain name since the 24th May 2007, since that time I have used that domain and also wrexhammotcentre.com linked to my business of Riverside Auto Centre. Before registering the domain we did an internet search on Google and Yahoo and also Company House to ensure that there was no one trading in that name.

My family and I have been trading in car parts for over 30 years in Wrexham and did not know anyone trading as such.

We first become aware of an interest in the domain name when a competitor got Trade Law to send letters demanding the transfer of domains that I have registered, the letters were threatening legal action, claims for compensation etc. an associate was threatened so much that he transferred a domain to them because they had threatened to sue and they had also listed his home address, the domain was wrexhamcarparts.com. I was abroad at the time and unreachable. I have checked on Company House website and the registered company Wrexhammotcentre is a dormant company and not trading. What we are getting of Trade Law is harassment and threats of legal action, they have even registered intellectual property on the domain names, we will be complaining to Intellectual property about they [sic] way this has been done. We previously offered to come

to yourselves and they refused. We have asked for proof of trading, ie letter from Accountant etc and this also has been refused.

We have attached latest letter and also previous emails and also copy of Company House info. I would if successful like the domain of wrexhamcarparts.com returned back to me⁴. I believe that this complaint is purely malicious action by a competitor”.

The Reply

This reads as follows:

“The response by the respondent is misguided and entirely without merit or substance. The complaint was NOT issued by a dormant Company, but by R I Griffiths T/A Wrexham MOT Centre (amongst others). It has been made abundantly clear that a company has been registered latterly to protect infringements of intellectual property together with the registration of a trademark within the name Wrexham MOT Centre.

Proof of R I Griffiths trading history has been provided and the respondent appears to be obfuscating the matter. It is denied that false details were submitted and the respondent is put to a strict onus of proof in respect of this allegation. Supporting evidence has been submitted to this complaint”.

Appeal Materials

The documents filed by the Parties on this Appeal contain a significant amount of new material which the Panel has not taken into consideration for the reasons set out in Section 5 above, under the heading 'Admissible material on Appeal'. Accordingly, in the following sections the Panel summarises, so far as it can, those parts of the Appeal Notice and Response which are admissible.

Appeal Notice

The Procedure requires that Appeal Notices contain "detailed grounds and reasons for the appeal". It is difficult to discern any such grounds or reasons from the present Appeal Notice. For example, the Complainant protests that there was no delay in the Complaint being made, but delay formed no part of the Expert's reasoning for denying the Complaint. It also explains that it did not submit any financial information with the Complaint because it would have been commercially sensitive and the Respondent is a competitor.

The Appeal Notice goes on to say that "It was stated by the [Complainant] within the Complaint that the Respondent has not traded in any of the names contained within the domain names registered by him, that the respondent has a track record of registering domain names used and advertised by the [Complainant] subsequent to advertising by the [Complainant]."

⁴ This request indicates a misunderstanding of the Nominet DRS process and is not within the jurisdiction of the Appeal Panel.

The entirety of the Complaint is set out above but, as is apparent, the Complaint did not make any such statement. It did say that "the registrant does not have a business in the protected trading name."

The Appeal Notice also says that "the decision of the expert dated 6 August 2015 in this matter accepts that the Complainant has acquired rights within the name (including BT Phonebook advertising from 2006...) yet...does not find the registration abusive."

In this connection the Panel observes that this is a misreading or mischaracterisation of the Expert's Decision. The only Rights found by the expert were such rights as arise from the registration of the UK trademark "Wrexham MOT Centre" and nowhere in his decision does he find that the Complainant had acquired rights from BT Phonebook advertising.

The Complainant also suggests that the registration is abusive because the registrant of the Domain Name is Richard Bennit but the name of the person making the Response is Richard Bennett, and because "the domain the subject of this dispute and appeal, is directed to a company which is not named Wrexham MOT Centre."

Notwithstanding the absence of any identified flaws in the Expert's reasoning, as this Appeal is a re-determination rather than a judicial review of the first instance Decision, the Panel will nonetheless proceed to determine the dispute on its merits.

Appeal Response

The Appeal Response repeats points made in the original Response, but does not make any further admissible submissions.

7. Discussion and Findings

General

In order to succeed the Complainant must prove, on the balance of probabilities, two matters, namely 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.

First Element – Rights

"Rights" are defined in the Nominet DRS Policy as follows:

“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.”

As a general proposition (and leaving aside the registered trade mark relied upon which is considered below) the Panel takes the view that 'Wrexham MOT Centre' is a descriptive term within the meaning of the definition of 'Rights'. As indicated above the term “MOT Centre” appears to refer to any location which is approved to carry out MOT tests (and that term is used in this way by the Government on its website explaining the MOT test system – see above) and the term Wrexham simply adds a geographical and non-distinctive element to that term. As noted above there are many locations in Wrexham which carry out MOT tests.

The Panel accepts that what is an inherently non-distinctive term may however acquire distinctiveness through use. Whether in this case it has done so is a question of evidence, although given there are many MOT centres in Wrexham the Panel considers substantial evidence would be needed to establish 'secondary meaning', that is to say distinctiveness acquired through use. Leaving aside bare assertion, the evidence before the Panel of relevance to this question is as follows:

1. The Premises' Photograph.
2. The Accountants' Letter (but not the “documentary evidence” to which it refers, which was not provided with the Complaint).
3. A Yellow Pages advertisement (undated) which is two columns wide and is approximately the same depth. It is headed Wrexham MOT Centre with underneath that the words “Wrexham's No 1 MOT Centre”. Below that is a box with a heading “Wrexham Tyres and Garage Services[®]”. At the foot of that box is a web site reference www.wrexhamtyres.co.uk. At the foot of the advertisement in small print is the rubric “Wrexham Tyres[®] and Wrexham Tyre and Garage Services[®] are both Registered Trade Marks”. The body of the advertisement contains text describing services offered, two photographs of technicians at work and a map.
4. A half page advertisement from an undated BT directory. This is headed Wrexham MOT Centre in large letters with under that the words “Wrexham Tyres and Garage Services”. No website address is cited and there is no reference to registered trademarks.
5. An invoice dated 3/2/2005 addressed to Wrexham Tyres for supplying and fitting three signs, described as “Car and Van Hire”, “Wrexham MOT Centre” and “Brake Specialist”.

No evidence has been presented from either customers of or suppliers to a business of the Complainant known as “Wrexham MOT Centre” and the Panel has not been provided with any detail at all of customer numbers, or sales or turnover figures or any other financial information in respect of any such business (or any other business of the Complainant). The likely need for such evidence is highlighted in the Experts' Overview –see paragraph 2.2 : “If the right is an unregistered trade mark right, evidence needs to be put before the Expert to demonstrate the existence of the right. This will ordinarily include evidence to show that (a) the Complainant has used the name or mark in question for a not insignificant period and to a not insignificant degree (e.g. by way of sales figures, company accounts etc) and (b) the name or mark in question is recognised by the

purchasing trade/public as indicating the goods or services of the Complainant (e.g. by way of advertisements and advertising and promotional expenditure, correspondence/orders/invoices from third parties and third party editorial matter such as press cuttings and search engine results). Given the paucity of evidence in the present case, in combination with the complete confusion as to the identity of the Complainant, the Panel is unable to accept that the Complainant has established that the term Wrexham MOT Centre had become distinctive of any business operated by it. It appears to the Panel to be a descriptive term always used in combination with one or more other business names and it appears to be either or both of the business names "Wrexham Tyres" and "Wrexham Tyre and Garage Services" which are used as the primary trading names of the businesses concerned.

In a further consideration of this issue the Panel has reviewed the website referred to in the Yellow Pages advertisement relied upon by the Complainant at www.wrexhamtyres.co.uk. That website clearly relates to the Felin Puleston Car Trade Businesses and carries a banner headline Wrexham Tyre and Garage Services with under that the words "Wrexham Car and Van Hire". The address that appears on the "contact us" page is "Wrexham Tyres and Garage Services, Unit 2, Felin Puleston, Ruabon Road, Wrexham, LL13 7RF". The "About Us" page commences with "Wrexham Tyre and Garage Services is here to provide a professional, efficient and cost-effective service to our customers...". Nowhere on the website, so far as the Panel can see, is the term "Wrexham MOT Centre" used. There is a page devoted to MOTs which is headed "MOT Testing 7 Days a Week" and which commences "We can carry out MOT tests while you wait..."

If matters rested at this point the Panel would have declined to find that the Complainant had established that it has Rights in the name "Wrexham MOT Centre". The Felin Puleston Car Trade Businesses promote themselves as Wrexham Tyres, Wrexham Tyres and Garage Services, and Wrexham Car and Van Hire. In doing so they sometimes but not always also use the term Wrexham MOT Centre. The Panel does not consider that the evidence establishes that that term has been used in such a way as to achieve sufficient distinctiveness as to be recognised as identifying the Complainant's business, particularly when there are many other MOT Centres in Wrexham.

Matters do not however rest there as the Complainant also relies on UK registered trademark 00003050347 for the words WREXHAM MOT CENTRE in Class 42. This was applied for on the 7 April 2014 and granted on 27 February 2015. The proprietor is Robert Ian Griffith. Correspondence from the Intellectual Property Office (the "IPO") was also included with the Complaint. In a letter dated 8 December 2014 the IPO states "Thank you for your response of 5 December 2014. The application will proceed by way of distinctiveness acquired through use". It would appear from this evidence that the IPO was persuaded to allow this application to proceed on the basis of evidence filed by the proprietor establishing distinctiveness acquired through use. The Panel does not know what that evidence was but has not, so far as it can tell, been provided with it. Given that the Panel has not had the benefit of seeing the evidence in question it is unable to ascertain on what basis the IPO was prepared to grant a registered trade mark for a term which on its face appears entirely descriptive. In the circumstances the Panel accepts that the Complainant has established it has Rights, assuming it has the

benefit of this trademark. Given that it would appear that Mr Griffith is the driving force behind the Felin Puleston Car Trade Businesses the Panel considers that the Complainant (whoever it is) is likely to have the benefit of an informal licence to use this trademark and accordingly has established that it has Rights, with effect from 27 February 2015.

Second Element – Abusive Registration

Abusive Registration is defined in the Nominet DRS Policy as follows.

“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”

The Respondent says that before he registered the Domain Name he carried out Google and Yahoo searches and checked Companies House. He also says that he and his family have traded in Wrexham for 35 years and he was not aware of anyone trading “as such” by which the Panel assumes he means trading as “Wrexham MOT Centre”. He registered the Domain Name in 2007. Given the evidence the Panel sees no reason to doubt this account. The Panel accordingly declines to find that at the time it was registered the Domain Name was an Abusive Registration – there is insufficient evidence before the Panel to establish that at that time the Complainant had any relevant Rights, let alone that the Respondent was aware of such Rights. This is explained in the Experts’ Overview at paragraph 4.10 as follows: “Can use of a purely generic or descriptive term be abusive? Yes but, depending on the facts, the threshold level of evidence needed to establish that this is the case is likely to be much higher. It may well often depend upon the extent to which such a term has acquired a secondary meaning, which increases the likelihood that any registration was made with knowledge of the rights that existed in the term in question. In many such cases where there is little or no evidence of acquired secondary meaning the Respondent is likely to be able to show that the domain name in question has been arrived at independently and accordingly cannot have been as a result of an Abusive Registration”

It follows that the Respondent's use of the Domain Name up until at least February 2015 cannot be such as to have taken unfair advantage of or been unfairly detrimental to the Complainant's Rights. Again the Panel does not consider there is sufficient evidence before it to establish that during that period the Complainant had any relevant Rights.

As indicated above the Panel concludes that from February 2015 the Complainant has acquired Rights, by virtue of a licence in respect of the registered trade mark owned by Mr Griffith. On 12 March 2015 TLC wrote to the Respondent and with effect from that date he will have been aware of the existence of this trade mark. The question for the Panel is whether his continued use of the Domain Name thereafter took unfair advantage of or was unfairly detrimental to the

Complainant's Rights. The Panel concludes that it did not. On the evidence before the Panel the Respondent's use of the Domain Name predates the existence of the Complainant's Rights by many years. There is no evidence before the Panel that the Respondent's use seeks in any way to trade off or take advantage of any reputation any of the Felin Puleston Car Trade Businesses may have in relation to MOT testing or "Wrexham MOT Centre" – he simply uses the term in its normal descriptive manner referring to his business which is an MOT Centre in Wrexham.

In a "first come first served" system of Domain Name registration the Respondent was, on these facts, entitled to register the name "wrexhammotcentre" and use it to refer to his garage which was and is an MOT centre in Wrexham. The question which has to be determined is whether the Respondent is entitled to continue to use the Domain Name subsequent to becoming aware of the Complainant's interest in a registered trademark in respect of the same term, when the date of the trademark post-dated the registration of the Domain Name? It is not the function of this Panel to determine matters of trademark validity or infringement so the Panel does not need to determine the answer to the question whether the Complainant's trademark could as a matter of trade mark law prevent the Respondent's continued use of the Domain Name. So far as the Policy is concerned the Panel finds that the continued use of a domain name which was registered long before the Complainant had any Rights, and which is used in a manner which does not seek to trade off or take advantage of the Complainant's business, does not amount to an Abusive Registration. The fact that the Respondent has been put on notice of the Complainant's subsequently acquired Rights in a term identical to the Domain Name does not alter this analysis. The point is made in the following terms in paragraph 4.7.2 of the Experts Overview: "Ordinarily, provided that the Respondent has done nothing new following the coming into existence of the Complainant's rights to take advantage of those rights, the Respondent's use of the domain name is unlikely to lead to a finding of Abusive Registration." In the present case there is no suggestion that the Respondent has done anything new subsequent to becoming aware of the trademark registration relied upon by the Complainant, and hence the Panel concludes that there is no basis for finding that the Domain Name is an Abusive Registration.

8. Decision

The Appeal is dismissed. The Panel finds that the Complainant has Rights in respect of a name or mark which is identical to the Domain Name but that the Domain Name is not an Abusive Registration.

Signed: Nick Gardner

Ian Lowe

Phil Roberts

Dated: October 22, 2015