



DISPUTE RESOLUTION SERVICE

D00017379

Decision of Independent Expert

Portakabin Limited

and

Mr Sean Westwood

1. The Parties:

Complainant: Portakabin Limited
Huntington House
Jockey Lane Huntington
York North Yorkshire
YO32 9XW
United Kingdom

Respondent: Mr Sean Westwood
Stafford Lodge, Hists Hill
Codsall
Wolverhampton
WV8 2EW
United Kingdom

2. The Domain Name(s):

portalooservices.co.uk

3. Procedural History:

I confirm that 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.

22 April 2016, the Dispute was received.

25 April 2016, the Complaint was validated.

26 April 2016, the notification of the Complaint was sent to the Parties.

16 May 2016, the Response reminder was sent.

19 May 2016, no Response was received.

19 May 2016, the notification of no Response was sent to the Parties.

27 May 2016, the Expert decision payment was received.

4. Factual Background

4.1 The Respondent registered the Domain Name on 22 August 2013.

4.2 The Complainant is a UK company, incorporated on 3 March 1961, which provides, among other things, the sale or hire of toilet facilities.

4.3 The Complainant is the proprietor of a number of UK and Community trade mark registrations for PORTALOO (the 'Name') (e.g. UK trade mark number 890708, Community Trade Mark number 870667) (collectively the 'Marks'), such trade marks having been registered prior to the registration of the Domain Name.

5. Parties' Contentions:

The Complaint

For the purposes of this section of the Decision, the Expert has summarised the submissions of the Parties but only insofar as they are relevant to the matters that the Expert is required to determine under Nominet's Dispute Resolution Service ('DRS') Policy (the 'Policy').

5.1 In summary, the Complainant submitted that the Complaint should succeed for the reasons below.

The Complainant's Rights

- The Complainant submitted that it has Rights in respect of a name or mark which is identical or similar to the Domain Name.

- The Complainant stated that it has been designing and manufacturing portable toilet buildings under and by reference to the PORTALOO name since 1965.
- It contended that such use has involved considerable expenditure on the advertising and promotion of the Name/Marks through trade and consumer advertisements, leaflets, newspapers and magazine coverage, and online advertising (including through its website at www.portaloo.co.uk) which has resulted in significant turnover from sales (various examples in support were submitted in evidence).
- Further, the Complainant stated that it has received various trade awards and industry accreditations (various examples in support were submitted in evidence).
- The Complainant submitted that, as a result of its "*substantial promotion and large scale use of the*" Name/Marks, the Complainant enjoys significant reputation and goodwill in its brand which brings in custom for the Complainant "*to the exclusion of all others.*" Indeed, it submitted that its brand has led to it becoming "*a UK household name.*"
- The Complainant submitted that the Domain Name reproduces the Name/Marks exactly followed by the purely descriptive word "*services*", which does not distinguish the Domain Name from the Name/Marks.
- The Complainant submitted that the ".co.uk" suffix can also be ignored for comparison purposes as it is there for purely technical reasons and serves no distinguishing role.

Abusive Registration

- The Complainant submitted that the Domain Name, in the hands of the Respondent, is an Abusive Registration as the Domain Name has been used and/or was registered or otherwise acquired in a manner which took unfair advantage of or was unfairly detrimental to the Complainant's Rights.
- In this regard, the Complainant referenced paragraphs 3 a. i. B, 3 a. i. C, 3 a. ii., and 3 iv. of the Policy in support, for the reasons detailed below.
- The Complainant submitted that the Respondent registered the Domain Name as a blocking registration against a name or mark in which the Complainant has Rights (**paragraph 3 a. i. B. of the Policy**).
- The Complainant stated that the Respondent's registration of the Domain Name

“inevitably serves to block the proper registration and use of that name by” the Complainant and that the Complainant is denied the right to register the Domain Name for its own legitimate use in relation to its services.

- Further, the Complainant contended that the Respondent *“must have been aware of the Complainant's Trade Mark when he registered the Domain Name”*, given the substantial reputation and goodwill of the Name/Marks, and *“it is inconceivable that the Respondent could have registered a domain name reproducing that [N]ame exactly without having the Complainant firmly in mind when he did so.”*
- The Complainant submitted that it may be inferred from *“the foregoing that the Respondent has knowingly blocked the Complainant from making use of the Domain Name.”*
- The Complainant submitted that the Respondent registered the Domain Name for the purpose of unfairly disrupting the Complainant's business (**paragraph 3 a. i. C. of the Policy**).
- The Complainant stated that the Respondent registered the Domain Name for the purpose of *“unfairly disrupting the business of the Complainant by attracting users to the Respondent's site who were looking for the Complainant”* and, by doing so, potentially diverting users into placing business with the Respondent.
- The Complainant contended that the Respondent's *“unquestionable knowledge of the [...] Mark [...] is indicative of a knowing attempt by the Respondent to unfairly disrupt the business of the Complainant”* by unfairly taking advantage of the likely confusion of internet users to divert traffic to the Respondent's website and/or into using the services of the Respondent.
- The Complainant further submitted that the Respondent is using the Domain Name in a way that 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**).
- While the Complainant acknowledged that the Respondent had yet to use the Domain Name, it contended that the mere registration of the Domain Name constituted unfair use of the same [the Expert notes that, as of the date of the decision, the *“Error 403 – Forbidden - you tried to access a document for which you don't have privileges”* message pops up when trying to access a webpage connected to the Domain Name].
- In particular, the Complainant submitted that the intended effect of the Respondent's use of the Domain Name, to sell competing goods or even the

Complainant's goods using a website connected to the Domain Name, would imply falsely a commercial connection with the Complainant and such a website.

- The Complainant submitted that, citing Nominet's Expert Overview guidance document (http://www.nominet.uk/wp-content/uploads/2015/08/Expert_Overview.pdf, in particular page 9) in support, such "*confusion may arise as a result of the mere registration and existence of the Domain Name owing to the concept of initial interest confusion which is recognised and trade mark owners are protected against under the [Nominet domain registration policy].*" It further submitted that, as the Domain Name incorporates the Name/Marks "*and the Complainant's established website address,*" internet users searching for the Complainant are likely to believe that any webpage to which the Domain Name resolves is operated or authorised by, or otherwise connected with, the Complainant.
- Further, the Complainant submitted that, given the Domain Name's "*material identity or high similarity to the*" Name/Marks, "*there is bound to be a severe risk that an internet user guessing the URL for the Complainant's web site will use the Domain Name for that purpose [a]s such, the mere existence of and/or any use of the Domain Name is likely to confuse.*"
- Finally, the Complainant submitted that it is independently verified that the Respondent has given false contact details (**paragraph 3 i.v. of the Policy**), namely a false telephone number to Nominet.
- The Complainant noted that its representatives had made a data release request to Nominet to provide the contact details for the Respondent in order to contact the Respondent in relation to the registration of the Domain Name, and that Nominet provided the same to the Complainant.
- The Complainant explained that its representatives had attempted "*on several occasions to contact the Respondent using the*" given telephone number but was unable to do so as it "*is not a functioning telephone number.*" The Complainant also referenced the "*highly implausible combination of numerically ascending numbers in the given telephone number*" and submitted that it is thus reasonable to infer that it is a "*fabricated*" number.

The Response:

5.2 No response to the Complaint was provided by the Respondent.

6. Outstanding formal/procedural issues

- 6.1 Although Nominet sent the Complaint to the Respondent as mentioned in section 3 above, no response has been provided by the Respondent to the Complaint. As no exceptional circumstances have been raised by the Respondent as to why no response has been received, the Expert has proceeded to a Decision (as per paragraph 15 b. of the Nominet DRS Procedure (the 'Procedure')).
- 6.2 While noting paragraph 15 c. of the Procedure (which states that in such circumstances, the Expert will draw such inferences as he considers appropriate), the Expert has drawn no inferences from the Respondent's failure to respond in this case, and has based his Decision on the facts and evidence before him.
- 6.3 It is important to note that the Complainant does not automatically receive the remedy it has requested merely because the Respondent has not responded to the Complaint (see, for example, Nominet DRS *equazen.co.uk* (DRS 02735) decision).

7. Discussions and Findings

General

- 7.1 To succeed in the Complaint, the Complainant has to prove pursuant to paragraph 2 of the Policy that, on the balance of probabilities:

i. [it] 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.

- 7.2 Addressing each of these limbs in turn:

Rights in respect of a name or mark which is identical or similar to the Domain Name

- 7.3 The Expert considers that, for the reasons set out below, the Complainant has Rights in a name or mark which is identical to the Domain Name.

- 7.4 Paragraph 1 of the Policy defines 'Rights' as:

[...] rights enforceable by the Complainant, whether under English law or otherwise, and may include rights in descriptive terms which have acquired a secondary meaning;

The Complainant must have the Rights in question at the time of the complaint (Nominet Appeal decision, *ghd.co.uk*, DRS No. 03078).

- 7.5 The Expert notes that, as referred to by the Complainant and summarised at paragraphs 4.3 and 5.1 above, the Complainant is the proprietor of a number of trade mark registrations in respect of the Name. The Expert also notes the Complainant's statement that "*it has been designing and manufacturing portable toilet buildings under and by reference to the PORTALOO name and Marks since 1965.*" As a consequence, the Expert considers that, through longevity in the market place and its reputation (noting, for example, the brand awareness references provided by the Complainant), the Complainant has developed considerable goodwill and reputation in the Name/Marks.
- 7.6 While the Expert notes that the Domain Name also includes the word "*services*" after the Name, in agreement with the Complainant, such a word is merely descriptive and does not sufficiently distinguish the Domain Name from the Name/Marks. In addition, that the Domain Name includes the ".co.uk" suffix does not sufficiently distinguish the Domain Name from the Name/Marks.
- 7.7 Given those factors, the Expert considers that, at the time of the Complaint, the Complainant had Rights in the Name/Marks which is/are similar to the Domain Name.

Abusive Registration

- 7.8 For the reasons set out below, the Expert considers that the Domain Name is an Abusive Registration as understood by the Policy.
- 7.9 Paragraph 1 of the Policy defines "*Abusive Registration*" as a domain name which either:
- i. was registered or otherwise acquired in a manner which, at the time 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 has taken unfair advantage of or has been unfairly detrimental to the Complainant's Rights;*
- 7.10 *In relation to i. above*, the Expert considers that the Domain Name was an Abusive Registration at the time the Domain Name was registered.
- 7.11 The Policy, at paragraph 3, sets out a non-exhaustive list of factors which may be evidence that the Domain Name is an Abusive Registration. Specifically, the Expert considers that the factors set out at paragraphs 3 a. i. B. and 3 a. i. C. are relevant.
- 7.12 In relation to the above factors, the generally held view amongst DRS Experts is that the Respondent should have had knowledge of the Complainant and/or its Rights when registering the Domain Name for there to be a finding of an Abusive Registration. As referenced above, given the Complainant's Marks and goodwill and reputation in the Name/Marks, the Expert considers that the Respondent is likely to have been well

aware of the Complainant and its Name/Marks at the time of the Domain Name registration on 22 August 2013.

- 7.13 While it may be helpful to consider the Respondent's intentions at the time the Domain Name was registered (or indeed in relation to his subsequent use of the Domain Name), as the Respondent has not replied to the Complaint, the evidence available to the Expert is that provided by the Complainant.
- 7.14 Indeed, on the balance of probabilities, the Expert considers that the Respondent specifically chose to register the Domain Name with the intention of benefitting from the Complainant's reputation and goodwill to attract to the website linked to the Domain Name users who would be looking for the Complainant and its services (the purpose of which would be to disrupt unfairly the business of the Complainant).
- 7.15 Further, the Expert considers that by registering the Domain Name, the Respondent has prevented the Complainant from so registering its Name/Marks.
- 7.16 Therefore, for the reasons set out above, the Expert considers that the registration of the Domain Name took unfair advantage of, and was unfairly detrimental to, the Complainant's Rights.
- 7.17 *In relation to (ii) above*, the Expert also considers that the Domain Name was an Abusive Registration as a result of its manner of use by the Respondent.
- 7.18 The Expert considers that paragraph 3 a. ii. of the Policy is relevant, whereby a factor which may be evidence that the Domain Name is an Abusive Registration is:

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;

- 7.19 The confusion referred to above is confusion as to the identity of the person or entity behind the Domain Name. The Expert considers that the Domain Name is near identical to the Complainant's Name/Marks (save for the "services" suffix), and "cannot sensibly refer to anyone else." Thus, the Expert considers that there is a real and tangible risk that the URL for a website connected to the Domain Name will likely appear high up on the search engine list of a user trying to locate the Complainant's website.
- 7.20 In this regard, the Expert is not persuaded by an argument that a person then accessing that website connected to the Domain Name would soon realise such a mistake (because, in this case, the Respondent had yet to link an active website to the Domain Name and instead an error message appears) as the damage to the Complainant's business would already have been done.

- 7.21 The Expert considers that the use of the Domain Name, for the reasons referenced above at paragraphs 7.19 and 7.20, has taken unfair advantage of the Complainant's Rights by seeking to rely on the Complainant's goodwill and reputation in the Name/Marks. The registration of the particular wording of the Domain Name is also unfairly detrimental to the Complainant as users are likely to conclude that the Complainant has registered a Domain Name suitable for the provision of services in relation to its PORTALOO products, but has failed to create a relevant website.
- 7.22 In regard to the factor at paragraph 3 a. iv. of the Policy, the Expert notes the Complainant's reference to the Respondent's telephone number as not being "*a functioning telephone number*" and the "*highly implausible combination of numerically ascending numbers in the given telephone number.*" However, the Complainant did not provide the required "*independently verified*" evidence that the number was false (it only being the Complainant's assertion). As such, the Expert has not relied on this factor when making his decision.
- 7.23 The Expert has considered whether there is evidence before him to demonstrate that the Domain Name is not an Abusive Registration but does not consider there is. Indeed, the Expert considers that there is no obvious justification for the Respondent having registered the Domain Name.
- 7.24 Therefore, for the reasons set out above, the Expert considers that the use of the Domain Name took unfair advantage of, and was unfairly detrimental to, the Complainant's Rights.

8. Decision

- 8.1 The Expert finds that, on the balance of probabilities, the Complainant has Rights in respect of the Name/Marks which is/are similar to the Domain Name and that the Domain Name in the hands of the Respondent is an Abusive Registration. Therefore, the Expert directs that the Domain Name be transferred to the Complainant.

Signed: Dr. Russell Richardson

Dated: 30 June 2016