

# **DISPUTE RESOLUTION SERVICE**

**D00017748**

## **Decision of Independent Expert**

**RUGBYSHOP**

and

**Mr Charles Adams**

### **1. The Parties:**

Lead Complainant: RUGBYSHOP  
21 avenue Léon Jouhaux  
Zone industrielle du Terroir  
SAINT-ALBAN  
31140  
France

Respondent: Mr Charles Adams  
18 Cedar Drive  
London  
N2 0PS  
United Kingdom

### **2. The Domain Name:**

rugbyshop.co.uk

### **3. Procedural History:**

I can 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 a such a nature as to call in to question my independence in the eyes of one or both of the parties.

19 July 2016 14:30 Dispute received  
19 July 2016 16:24 Complaint validated

27 July 2016 16:05 Complaint validated  
 28 July 2016 14:48 Notification of complaint sent to parties  
 16 August 2016 02:30 Response reminder sent  
 17 August 2016 09:52 Response received  
 17 August 2016 09:53 Notification of response sent to parties  
 22 August 2016 02:30 Reply reminder sent  
 25 August 2016 09:16 Reply received  
 25 August 2016 09:17 Notification of reply sent to parties  
 25 August 2016 09:18 Mediator appointed  
 31 August 2016 13:19 Mediation started  
 06 September 2016 12:23 Mediation failed  
 06 September 2016 12:23 Close of mediation documents sent  
 07 September 2016 10:15 Expert decision payment received

#### **4. Factual Background**

This is a dispute between the owner of a French business which trades on-line through a web site at <rugbyshop.com> (the Complainant) and the owner of an English business which trades from premises in Staffordshire (the Respondent). The Respondent registered the Domain Name, which consists of the combination of the descriptive words RUGBY and SHOP, on 26 November 1998. The Respondent has not used the Domain Name since acquiring it over 17 years ago.

#### **5. Parties' Contentions**

##### **5.1 The Complaint**

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

The Complainant, which trades as RUGBYSHOP, is a French limited liability company with a sole partner, Kevin Bean. It is in the business of selling rugby products, which it began on 8 August 1990.

##### **5.1.1 Rights**

###### Registered Rights

In the Complaint the Complainant claims the benefit of the following registered rights:

<b>Mark</b>	<b>Registry</b>	<b>Number</b>	<b>Date</b>	<b>Class</b>
Semi-figurative trade mark including the word combination RUGBY SHOP	French trade mark registered at INPI	1712964	8 October 1990	16, 18, 24, 25 and 28

Semi-figurative trade mark including the word combination RUGBY SHOP	UK trade mark registered at the Intellectual Property Office	UK00002185174	23 December 1998	16, 18, 24, 25 and 28
Semi-figurative trade mark including the word combination RUGBY SHOP	EU trade mark registered at OHMI	014065122	13 May 2015	18, 24, 25, 28 and 35

### Unregistered Rights

In the Complaint the Complainant also claims to have acquired unregistered rights in the mark RUGBYSHOP through use of that mark and relies upon the following factors:

- The domain name <rugbyshop.com> was registered on, and has been used since, 24 February 1997.
- Since 1999 the business has been conducted mainly on the Internet under the domain name <rugbyshop.com>.
- The related web site has been very successful with 100,000 unique visitors a month and around 150,000 loyal customers from both France and the United Kingdom for more than twenty years.

### **5.1.2 Abusive Registration**

#### Blocking registration

The Complainant contends that the Domain Name was primarily registered as a blocking registration to stop the Complainant, which has rights to the mark RUGBYSHOP, from registering it.

As at the date of registration of the Domain Name, the Complainant submits that its business RUGBYSHOP was well known in the United Kingdom. The Complainant relies upon the registration of its UK trade mark and the fact that it has a number of customers in the UK. The Complainant had produced long lists of both its customers and prospects in the UK in the form of Excel spreadsheets.

The Respondent registered the Domain Name after the Complainant had first acquired rights in the mark RUGBYSHOP. It is suggested that the Respondent could not have been unaware of the existence of RUGBYSHOP and its rights to that name when he registered the Domain Name. The Respondent has never exploited the Domain Name.

The Complainant considers that the Domain Name is visually, phonetically and intellectually identical to the distinctive mark of RUGBYSHOP. The similarity could only result from a desire to block the Domain Name.

The Complainant is concerned that the Respondent's behaviour has obstructed any eventual registration by the Complainant of the domain name <rugbyshop.uk>.

For resale at greater than cost

The Complainant also contends that the Domain Name was primarily registered for the purposes of selling, renting or otherwise transferring it to the Complainant or its competitors at a price greater than it cost.

A few years ago, the Complainant got in touch with the registrant of the Domain Name, Mr Charles Adams, who offered to sell the Domain Name to the Complainant at a price greater than his costs.

The Complainant makes a final contention which is put in the following terms:

“Even if the absence of exploitation of the Domain Name is not abusive, it is not loyal to block the Domain Name for more than 18 years and to offer to resell it only at a steep price.”

The Complainant seeks a transfer of the Domain Name.

## **5.2 Respondent**

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

The Domain Name is owned by York Mill (Silk Knitters) Ltd (the Company). The Company is a textile manufacturing business and was incorporated on 13 January 1971. It operates from York Mill Building, Well Street, Leek, Staffordshire, ST13.

The Company makes textile products for volume retail trade customers putting their brands on items which they sell on. For example, the main customer in one subsidiary, making neckwear and various accessories, was Marks and Spencer but it also (via another company) made products like T shirts, polo shirts, dresses and skiwear for C&A, Tesco, Makro, Asda and Sainsburys.

The Complainant and the Company operate in different markets as they sell different products to different people. The Complainant and the Company are therefore not in competition. The Complainant has no physical shops and it does not sell to the same market as the Company.

The Company's sports kit products, for example football or rugby kits, are made to order and sold via local agents or local sports shops acting as agent or directly. The Company's customers are sports clubs, schools, universities and military/naval bodies, where any bespoke kit garments (not only rugby) are made for delivery in about 3 to 4 weeks.

The Complainant buys branded rugby kits and accessories from companies that own well known brands such as Adidas, Nike and Puma and re-sells those branded

products online through its web site at <rugbyshop.com>. The Company does not sell any of the brands sold by the Complainant.

The Domain Name was registered on 26 November 1998 which was before the Complainant applied to register its UK trade mark. There was no UK registered trade mark for RUGBYSHOP at the date of registration of the Domain Name and the Respondent did not notice use by anyone of that name at the time.

The Complainant must have known that the Domain Name had been registered prior to applying to register its UK trade mark.

The Respondent does not recollect any previous sales correspondence. The Complainant has failed to produce copies of any correspondence and the allegation made by the Complainant (that the Respondent offered to sell the Domain Name to the Complainant) is mischievous.

The Domain Name was registered to protect the Company's business which involves selling all types of kit to clubs, schools, universities, local clubs, military and naval bodies via its agents and local shops also acting as agents.

Because the Company sells to customers it knows who provide repeat business the Company has not felt the need to put up a web site yet and there is no need to do so "until there is some merging within the industry."

The Company does have plans to use the Domain Name but does not consider there is likely to be confusion as it does not sell any of the products that the Complainant sells through the <rugbyshop.com> web site nor does it sell to the same customers.

Finally, the Respondent submits that the Domain Name is generic.

### **5.3 Reply**

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

The fact that the Respondent's products are dissimilar from those sold by the Complainant through the <rugbyshop.com> web site does not justify registration of the Domain Name or its blocking for more than 18 years.

The Complainant acquired registered rights in the name RUGBYSHOP prior to the registration of the Domain Name. It refers back to the French trade mark registration in 1990 and the fact that it registered and starting using the <rugbyshop.com> domain name in February 1997. It says that the Respondent has tried to confuse matters by only referring to the UK trade mark registration, which was filed in December 1998.

The Complainant did not retain any proof of the sales correspondence with the Respondent as it took place a few years ago. The Complainant denies this proves it acted in bad faith.

In response to the contention that the name RUGBYSHOP is generic, the Complainant points out that the Trade Mark Offices of France, the UK and the European Union have all accepted registration of that name as a trade mark.

## 6. Discussions and Findings

In order for the Complainant to succeed it must prove to the Expert, on the balance of probabilities, that:

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

the Domain Name, in the hands of the Respondent, is an Abusive Registration.”

The meaning of “Rights” is defined in the Policy in the following terms:

“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.”

An Abusive Registration is defined in the Policy as follows:

“Abusive Registration means a Domain Name which either:

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

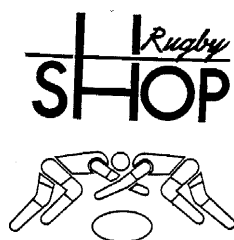
has been used in a manner which took unfair advantage of or was unfairly detrimental to the Complainant's Rights.“

### Complainant's Rights

The Complainant has produced copies of print-outs from the relevant trade mark registries which show that it has registered rights in the following figurative marks:

#### French trade mark

The Complainant is the owner of a French registered trade mark no. 1712964 for the figurative mark shown below.



The mark was registered on 8 October 1990.

UK trade mark

The Complainant is the owner of a UK registered trade mark no. 00002185174 for the figurative mark shown below.



The application was filed on 23 December 1998 and registered on 15 October 1999.

EU trade mark

The Complainant is the owner of an EU registered mark no. 014065122 for the figurative mark shown below.



The application was filed on 13 May 2015 and registered on 9 February 2016.

The Complainant also claims to have acquired unregistered rights in the mark RUGBYSHOP as it has been trading through a web site at <rugbyshop.com>. The evidence of trading consists of two databases, which are described in more detail in the section below dealing with Abusive Registration.

The Respondent does not deny that the Complainant has rights in the mark RUGBYSHOP. His case is that the mark is generic, that the rights were acquired after he registered the Domain Name and, in any event, that he had no knowledge of the Complainant when he registered the Domain Name.

The Complainant does not have registered rights in the word mark RUGBY SHOP. The registered rights are figurative trade marks which contain those descriptive words. The Experts' Overview notes that rights in a logo or device mark may not equate to trade mark rights in respect of any words featured in the logo/device and much will depend upon the nature of the words in question and their prominence.

The Complainant does have enforceable rights in relation to its registered figurative marks albeit that any attempt to enforce against a third party solely on the basis of use of the word combination RUGBY SHOP (i.e. absent a similar visual representation to the figurative aspects of the trade marks) could well be problematic. However, the Complainant does not need to prove that the Respondent has infringed its registered marks in order to satisfy the Rights test.

Whilst the evidence in relation to unregistered rights is limited, it does appear that the Complainant has been trading on-line using the domain name <rugbyshop.com> for an extended period of time and it has customers and prospects in the UK.

Taking the evidence as a whole, and bearing in mind that the Rights test is a low level hurdle, the Expert is satisfied that the Complainant has rights in a similar mark to the Domain Name. There is sufficient evidence to conclude that the Complainant has a legitimate interest in bringing the Complaint.

There is a sequencing question in this case which is whether the Complainant's rights pre-date registration of the Domain Name. It is not necessary to determine that issue for the Rights test as the only requirement is that the rights were acquired prior to the Complaint. That is clearly the case in this dispute.

The sequencing question is however relevant to determination of the second issue which is whether Domain Name, in the hands of the Respondent, is an Abusive Registration.

### **Abusive Registration**

Abuse can be shown both in terms of the Respondent's motivation when he registered the Domain Name and though subsequent use of the Domain Name. Dealing with those points in reverse order, the Expert considers first the case based on use and then the case based on the Respondent's motivation at the date of registration.

#### Use of the Domain Name

The Complainant states that the Respondent has never exploited the Domain Name. The Respondent says that he has not yet felt the need to put up a web site. The fact that the Domain Name has not been used is not in itself evidence that the Domain Name is an Abusive Registration – see clause 3(b) of the Policy. There is therefore no abuse in this case based solely on the use of the Domain Name.

#### Registration of the Domain Name

That leaves consideration of the Respondent's motivation at the date of registration. Clearly, the Respondent's conduct after that date may be relevant in that it may cast some light on his motivation at the time.

One of the issues on the submissions is whether the Complainant's rights were acquired before registration of the Domain Name. The Respondent rightly points out that the Domain Name was registered before the Complainant applied to register a trade mark in the UK but he overlooks the existence of the Complainant's registered rights acquired in France in the figurative mark. Those rights were acquired over 6 years before he registered the Domain Name. The evidence shows that the Complainant did have the benefit of registered overseas rights in the figurative mark before the Domain Name was registered.



However, that of itself is not determinative and the much more salient issue in dispute is whether the Respondent had the Complainant in mind when he registered the Domain Name. This issue is relevant to both paragraphs 3(a)(i)A and 3(a)(i)B of the Policy.

Paragraph 3(a)(i)A of the Policy reads as follows:

“Circumstances indicating that the Respondent has registered or otherwise acquired the Domain Name primarily for the purposes of selling, renting or otherwise transferring the Domain Name to the Complainant or to a competitor of the Complainant, for valuable consideration in excess of the Respondent’s documented out-of-pocket costs directly associated with acquiring or using the Domain Name.”

Paragraph 3(a)(i)B of the Policy reads as follows:

“Circumstances indicating that the Respondent has registered or otherwise acquired the Domain Name primarily as a blocking registration against a name or mark in which the Complainant has Rights.”

If the Respondent did not have the Complainant in mind when he registered the Domain Name it is difficult to see on what basis the Domain Name could have been registered primarily as a blocking registration or with the intention of selling it to the Complainant (or a competitor) for gain.

The Appeal Panel in DRS 04331 <verbatim.co.uk> stated as follows:

“knowledge” and “intention” are pre-requisites for a successful complaint under all heads of paragraph 3(a)(i) of the Policy. The wording of that paragraph expressly calls for the relevant intent, which cannot exist without the relevant knowledge.”

The Respondent expressly denies that he had any prior knowledge of the Complainant. He states that he was not aware of the use of the mark RUGBYSHOP by any party when he registered the Domain Name. He also says that there was no UK registered trade mark at that date, although it is not clear whether he checked the position at the time or did so subsequently for the purposes of compiling his Response.

The Complainant’s case is that the Respondent was aware of the Complainant’s business when he registered the Domain Name. It says that its business was well known at that time in the UK.

The Complainant then seeks to rely upon the fact that it had acquired registered rights in the UK. However, the evidence of registered rights in the UK does not assist in resolving this issue as the application for the UK trade mark was not made until 23 December 1998, over a year after the Domain Name was registered. The application was granted on 15 October 1999.

The Complainant also seeks to support its case in relation to knowledge by pointing out that it was well known in the UK and it had a number of UK customers. It contends that the phrase RUGBYSHOP had become distinctive of the Complainant. The Complainant puts its case in the following terms:

“Since 1999, this business has been conducted mainly on the Internet under the domain name “rugbyshop.com”. The related website proved to be very successful with 100.000 unique visitors a month and around 150.000 loyal customers from both France and United Kingdom for more than twenty years.”

The Complainant has provided PDF copies of two spreadsheets which are named “UK Customers.xlsx” and “UK Prospects.xlsx”. The spreadsheets contain the names and addresses of a substantial number of people and run to 121 pages and 87 pages respectively. However, there is no way of telling from the documents themselves when the people who are listed became customers or prospects. As evidence, it casts no light at all on the state of the Complainant’s business in November 1998 when the Domain Name was registered.

The Complainant has lodged a print-out that shows it registered the domain name <rugbyshop.com> on 24 February 1997. The Complainant says, in its submission, that it used this domain name from that point onwards although that is somewhat at odds with the verbatim passage set out above, which suggests it traded on-line from 1999.

The Complainant has not adduced any evidence to which the Expert attributes any weight of its trading activities in the UK prior to registration of the Domain Name. It has certainly not adduced any evidence to support its claim that the word combination RUGBY SHOP had become distinctive of the Complainant, other than the circumstantial evidence of the registration of its figurative trade mark in France and the registration of the domain name <rugbyshop.com>.

On the one hand, the Respondent submits that the term RUGBYSHOP is generic in relation to a shop selling rugby-related goods. On the other hand, the Complainant points out that the trade mark registries have all accepted registrations of that name as a trade mark. On the facts of this dispute, the Expert does not consider that the trade mark registrations per se are a sufficient basis to conclude that the mark has become distinctive through use - the marks are all figurative and not word marks. It is entirely possible, indeed likely, that the trade mark registries accepted the registrations because the added figurative element tipped the applications over the line of being registrable.

Accordingly, the only evidence about the state of the Complainant’s business, prior to registration of the Domain Name, is the registered rights acquired in October 1990 in France in the figurative mark and the fact it registered the domain name <rugbyshop.com>, in February 1997.

The Respondent has put forward an explanation for registration of the Domain Name. He says that the Domain Name was acquired to protect the business but, as it has repeat customers, it has not yet felt the need to use the Domain Name for on-line trading. It trades solely from physical premises and intends at some point to use the

Domain Name. The Respondent says that its business includes selling rugby kits to various customers. It is plausible that a business which sells various goods, including rugby kits, would seek to register a domain name that includes the descriptive word combination of RUGBY and SHOP.

The Complainant seeks to rely upon an offer made by the Respondent, in response to an enquiry from the Complainant, to sell the Domain Name “a few years ago” at a price greater than his cost. There is no evidence to support this contention. When challenged about the lack of evidence, the Complainant made the following statement:

“Because it happened a few years ago, RUGBYSHOP did not retain any proof of such correspondence. But, the fact that the respondent denies it proves its bad faith.”

In the absence of any evidence, the Expert does not place any reliance upon the alleged offer for sale by the Respondent.

The Complainant seeks to argue that the Respondent registered the Domain Name primarily as a blocking registration or with a view to offering it for sale to the Complainant (or one of its competitors) at a profit. However, the Expert is not satisfied on the evidence that the Respondent had any knowledge of the Complainant or its business at the date of registration of the Domain Name. It follows that activity directed at the Complainant cannot have been the primary motivation.

There is no particular reason why a trader in the UK would have been aware of registered rights acquired in France in a figurative mark that includes the word combination RUGBY SHOP or that there was a domain name <rugbyshop.com>. The Complainant’s case, in terms of when it started using that domain name for on-line trading, is rather confused. At one point, it states that it has used the domain name since it acquired it in February 1997 but, at another point, the words it has used can be interpreted as suggesting that the on-line trading began in earnest in 1999. There is no evidence available to support either position. It follows that the Complainant’s case on abuse, based on the Respondent’s motivation as at the date of registration of the Domain Name, fails.

Perhaps one of the most telling sections of the Complaint is the following one:

“The entire business of RUGBYSHOP is built on its domain name, its corporate name and its trademarks.

RUGBYSHOP now wants to open a new website dedicated to the British market, using mainly an Internet website accessible under the domain name “rugbyshop.uk”.

Within this framework, RUGBYSHOP was surprised to find out that the registrant of the domain name “rugbyshop.co.uk”, which has never been exploited, had priority on the registration of eventual domain name with “rugbyshop” as second level for the new extension “.uk” created in 2014.”

The picture that emerges in this case, one has to say mainly from the way in which the Complainant has put its case, is that the Complainant decided fairly recently to target the British market and it wanted to use the domain name <rugbyshop.uk> for that purpose. The fact that the Respondent had registered the Domain Name some 17 years earlier thus become an inconvenience. The Policy is not designed to meet such a circumstance; it is designed to resolve relatively straight forward cases in which there is evidence that a registrant has taken unfair advantage of, or caused unfair detriment to, the Complainant's rights.

## **7. Decision**

The Expert is satisfied that the Complainant has rights in a mark which is similar to the Domain Name. However, the Complainant has not satisfied the Expert, on the balance of probabilities, that the Domain Name is, in the hands of the Respondent, an Abusive Registration. The Expert therefore directs that no action be taken.

**Signed .....**  
**Andrew Clinton**

**Dated 7 October 2016**