

## **DISPUTE RESOLUTION SERVICE**

**DRS 16851**

**Decision of Independent Expert**

**Construction Industry Training Board**

and

**Ciprian Toma**

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

Complainant: Construction Industry Training Board  
Bircham Newton  
King's Lynn  
Norfolk  
PE31 6RH  
United Kingdom

Respondent: Ciprian Toma  
85A Headstone Road  
Harrow  
Middlesex  
HA1 1PG  
United Kingdom

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

<cpcs-theory-test-answers.co.uk>

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

The Complaint was filed with Nominet on 8 February 2016. The next day Nominet notified the Respondent by post and by email, stating that the Response had to be received on or before 1 March 2016. The Respondent did not file a Response by the deadline and so on 2 March 2016 Nominet informed the Complainant that it had until 16 March 2016 to pay the fee for the decision of an Expert pursuant to paragraph 7 of the Nominet Dispute Resolution Service Policy ("the Policy"). On 7 March 2016, the Complainant paid Nominet the required fee.

On 9 March 2016, the undersigned, David Taylor ("the Expert"), confirmed to Nominet that he was independent of each of the parties and that, to the best of his knowledge and belief, there were no facts or circumstances, past or present (or that could arise in the foreseeable future) that needed to be disclosed as they might be of such a nature as to call in to question his independence in the eyes of one or both of the parties.

### **4. Factual Background**

The Complainant is the industry training board for the construction industry in the United Kingdom. It is a statutory corporation and a registered charity. It is also the registrant of a number of trade mark registrations and certification marks in the term "CPCS" in, *inter alia*, class 45 for "certification services; certification services in the field of construction", including but not limited to:

- UK Trade mark Registration No. 2488306, for CPCS (word), registered on 10 October 2008;
- UK Trade mark Registration No. 2488574, for CPCS (logo), registered on 17 October 2008;
- UK Certification mark No. 2488307, for CPCS, registered on 19 February 2010; and
- UK Certification mark No. 2488571, for CPCS, registered on 19 February 2010.

The Respondent appears to be an individual based in the UK. No further details about the Respondent are known.

The Domain Name was registered on 19 September 2015. It resolves to an online shop where internet users can purchase and instantly download answers to the Complainant's "CPCS Theory Tests" (as explained in more detail below).

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

#### **The Complainant**

The Complainant asserts that it is a statutory corporation and registered charity (registered in England and Wales under Charity No. 264289 and in Scotland under Charity No. SC044875) and that it was set up pursuant to the Industrial Training Board Order 1964 and Section 1(1) of the Industrial Training Act 1982.

The Complainant submits that its mission is to promote and facilitate the efficient and proper training of people who work in the construction industry. It further asserts that it runs a number of competence card schemes for workers in the construction industry known as the Construction Plant Competence Scheme or "CPCS". The Complainant submits that under the CPCS card scheme, which the Complainant has been operating since 2003, cards denoting competence in the operation of particular plant and machinery are issued to individuals who have achieved specified qualifications.

The Complainant is the registrant of a number of trade marks and certification marks in the term "CPCS" (listed above). The Complainant has attached copies of the registration certificates with its Complaint.

The Complainant submits that its CPCS marks are recognised by the construction industry as indicating that the goods or services in question are official goods or services of the Complainant relating to the CPCS card scheme and that it has built up a substantial reputation in each of the marks.

The Complainant explains that the CPCS card scheme comprises a number of assessments, including a series of verbal theory tests, called the "CPCS Theory Tests" that are carried out in authorised test centres across the UK. These test centres are required to sign a "Test Centre Agreement" with the Complainant under which they are obliged to maintain the confidentiality of the CPCS Theory Test model answers.

The Complainant further explains that the CPCS Theory Tests are designed to ensure that individuals operating plant and machinery in the construction industry do so in a safe and proper manner. The CPCS Theory Tests are administered nationally at accredited test centres to ensure that these goals are implemented uniformly across the construction industry. Accordingly, the Complainant explains that model answers are kept confidential to ensure that participants do not know the answers in advance.

The Complainant further submits that the questions and model answers for all CPCS Theory Tests are original copyright works first created by Mr Peter Brown, an employee of the Complainant in or around 2007 or 2008. The Complainant therefore contends that copyright in the CPCS Theory Tests vests in the Complainant.

The Complainant further asserts that it publishes the questions for all CPCS Theory Tests on its website without model answers free of charge and that this allows candidates to research the answers or undertake appropriate training. The Complainant submits that the documents containing the questions as published on the Complainant's website are clearly marked with a copyright symbol and the name of the Complainant. The Complainant further submits that the answers to the CPCS Theory Tests are not published by the Complainant or by any third party on its behalf and that making them available to the public significantly undermines the integrity and purpose of the CPCS card scheme.

The Complainant asserts that the Domain Name in the hands of the Respondent is abusive. In this regard, the Complainant argues that the Domain Name has been primarily registered for the purpose of selling answers to the CPCS Theory Tests, which undermines the integrity of the CPCS card scheme and safety in the construction

industry (as candidates' own knowledge is not adequately tested if the answers are available in the public domain) and unfairly disrupting the business of the Complainant.

The Complainant submits that the Domain Name has been used in a way which confuses people into thinking that it is controlled by the Complainant, by using the Complainant's trade mark and certification marks in the Domain Name, and by using those marks on the website and stating that it provides "the Official CPCS Answers". The Complainant submits that it has received complaints from CPCS testers and training providers confirming that candidates have obtained answers to the CPCS Theory Tests from the website connected with the Domain Name and has submitted copies of the same.

The Complainant further submits that it carried out a test purchase of the products from the Domain Name on 16 November 2015 for the purpose of ascertaining the nature of the materials being advertised for sale. As evidence, the Complainant has attached to its Complaint a copy of the email confirmation of purchase and a copy of the question and Answers supplied.

The Complainant asserts that the documents sold by the Respondent through the website associated with the Domain Name are set out in a format which is substantially similar to the format of the questions as published on the Complainant's website. The Complainant therefore considers that it has grounds for action in both copyright infringement and passing off in relation to these documents, in addition to the infringement of trade marks and certification marks, and therefore that the confusion created by the Domain Name is further compounded.

The Complainant submits that the Respondent has no connection with the Complainant and is not authorised to use its trade marks or certification marks, to distribute the answers to the CPCS Theory Tests or to hold himself or herself out in any way as connected with the Complainant.

The Complainant underlines that its mission is to ensure the safety both of persons working on construction sites and the public in general and that the use of the Domain Name to sell answers to the Complainant's CPCS Theory Tests seriously undermines the integrity of the CPCS card scheme and, therefore poses significant risks to the health and safety of construction workers and the general public.

### **The Respondent**

The Respondent did not reply to the Complainant's Complaint.

## **6. Discussions and Findings**

### **General**

Under paragraph 2(a) of the Policy, for the Expert to order a transfer of the Domain Name the Complainant is required to demonstrate, on the balance of probabilities, both of the following elements:

"(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."*

### **Complainant's Rights**

The Policy defines Rights as "*rights enforceable by the Complainant, whether under English law or otherwise*".

The Complainant asserts Rights in the Domain Name based on the Complainant's trade marks as well as certification marks in the United Kingdom. The Complainant has submitted evidence of its trade marks and certification marks in the term CPCS and so the Examiner is satisfied that the Complainant has Rights in the term CPCS.

Paragraph 2(a)(i) of the Policy also requires the Expert to examine whether the name or mark in which the Complainant has Rights is identical or similar to the Domain Name. The Domain Name incorporates the Complainant's CPCS mark at the start followed by the addition of the generic terms "theory", "test" and "answers", separated by hyphens. The Expert finds that the dominant component of the Domain Name is the Complainant's CPCS mark and that neither the addition of the generic terms "theory", "test" and "answers" that follow nor the hyphens diminishes the similarity with the Complainant's mark. Rather, the Expert is of the view that the similarity with the Complainant's mark is reinforced by the addition of the terms "theory", "test" and "answers" as they are terms that are strongly related to the services provided by the Complainant.

It is well-established that the ".co.uk" suffix may be disregarded for the purpose of assessing identity or similarity between a trade mark and a domain name, as it is a functional element, and so the Expert finds that the Complainant's trade mark and the Domain Name are similar.

The Expert therefore finds that the Complainant has Rights in respect of a mark which is similar to the Domain Name, in accordance with paragraph 2(a)(i) of the Policy.

### **Abusive Registration**

Moving on to paragraph 2(a)(ii) of the Policy, "Abusive Registration" is defined in paragraph 1 of the Policy to mean a domain name which:

"(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."*

A complainant must prove one or both of these on the balance of probabilities. In the present case, based on the evidence put forward by the Complainant, the Expert finds that the Domain Name was both registered and used in a manner which takes unfair advantage of, and is unfairly detrimental to, the Complainant's Rights.

As far as (i) above is concerned, in order to assess whether the Domain Name was registered or otherwise acquired in a manner which, at the time of registration, took unfair advantage of or was unfairly detrimental to the Complainant's Rights, it is necessary to determine whether the Respondent was aware of the existence of the Complainant and its Rights at that time (see DRS 4331 (<verbatim.co.uk>)(*"the Complainant must satisfy the Panel, as an opener, that the Respondent was aware of the existence of the Complainant or its brand at the date of registration of the Domain Name or at commencement of an objectionable use of the Domain Name"*). The nature of the Domain Name itself which contains the Complainant's CPCS trade mark in conjunction with generic terms such as "theory", "test" and "answers", which are descriptive of the services provided by the Complainant, very strongly suggests that the Respondent was targeting the Complainant at the time of registration of the Domain Name. Furthermore, the Respondent's subsequent use of the Domain Name to resolve to a website displaying the Complainant's CPCS logo and offering the answers to the Complainant's test questions leaves no doubt as to the Respondent's awareness of the Complainant and its Rights at the time of registration. The Expert therefore finds that the Respondent registered the Domain Name fully aware of the Complainant and its Rights and without the Complainant's authorisation.

As far as the Respondent's motivation for registering the Domain Name is concerned, paragraph 3(a) of the Policy sets out a non-exhaustive list of factors which may be evidence of Abusive Registration. The Complainant does not expressly rely on any of those factors but states that *"The Domain Name has been primarily registered for the purpose of selling answers to the CPCS Theory Tests, thereby undermining the integrity of the Scheme and safety in the construction industry and unfairly disrupting the business of the Complainant"*. The Expert agrees with the Complainant's contention that given the Respondent's use of the Domain Name to resolve to a website offering the answers to the Complainant's test questions for sale, it seems likely that the Respondent's primary motivation for acquiring the Domain Name was to take unfair advantage of the Complainant's Rights, which results in an unfair disruption of the Complainant's activities, in accordance with (i) set out above. See Nominet DRS 12940 (<cashconverters.org.uk>)(*"Whilst the Respondent's actions could indeed have resulted in such disruption, in the Expert's opinion this was not the main reason why the Respondent registered the Disputed Domain Name. It seems more likely that the Respondent's primary motivation upon registration of the Disputed Domain Name was simply his own financial gain"*).

The Expert is therefore satisfied that the Domain Name was *registered* in a manner which, at the time when the registration took place, took unfair advantage of and was unfairly detrimental to the Complainant's Rights.

As far as (ii) above is concerned, the Expert is of the view that the Respondent's use of the Domain Name constitutes use in a manner which has taken unfair advantage of and has been unfairly detrimental to the Complainant's Rights. In this regard, paragraph 3(a)(ii) of the Policy provides that the following may be evidence of Abusive Registration:

*ii. Circumstances indicating that the Respondent is using or 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;*

The Expert finds that this circumstance adequately describes the Respondent's conduct. As described above, the Respondent is using the Domain Name to resolve to a website prominently displaying the Complainant's CPCS trade mark and logo and offering the answers to the Complainant's test questions for sale. Given this, the Expert is of the view that the Respondent is clearly using the Domain Name which incorporates the Complainant's trade mark in a way which is likely to confuse internet users as to the source of the website, with the aim of obtaining financial gain derived from the Complainant's reputation and goodwill. The Expert is also of the view that the Respondent's use of the Domain Name is abusive not only because the Respondent is unduly profiting from the Complainant's goodwill for his own financial gain, but also because the Respondent's use is disrupting the Complainant's activity and is therefore causing unfair detriment to the Complainant and its Rights.

The Expert therefore finds that the Domain Name is being *used* in a manner which is taking unfair advantage of and is also unfairly detrimental to the Complainant's Rights, in accordance with (ii) above.

Finally, paragraph 4 of the Policy provides a non-exhaustive list of circumstances which may be evidence that the Domain Name is not an Abusive Registration. The Respondent has failed to submit a Response to the Complainant's contentions. However, the Expert has examined the circumstances set out in paragraph 4 of the Policy and finds that, given the nature of the Domain Name and the use to which it has been put by the Respondent (as described above), none of those circumstances would seem to assist the Respondent.

In summary, the Expert has considered the admissibility, relevance, materiality and weight of the evidence as a whole and is satisfied that the Complainant has succeeded in proving, on balance of probabilities, that the Domain Name is an Abusive Registration in accordance with paragraph 2(a)(ii) of the Policy.

## **7. Decision**

The Expert finds that the Complainant has Rights in a name which is similar to the Domain Name, and that the Domain Name, in the hands of the Respondent, is an Abusive Registration.

The Domain Name should therefore be transferred to the Complainant.

**Signed:** David Taylor

**Dated:** 6 April 2016