

DISPUTE RESOLUTION SERVICE

D00019188

Decision of Independent Expert

Tattersall Tweed Limited

and

Matthew Butcher

1. The Parties:

Lead Complainant: Tattersall Tweed Limited
Prestige Court, Beza Road
Leeds
West Yorkshire
LS10 2BD
United Kingdom

Respondent: Matthew Butcher
655 Roundhay Road
Oakwood
Leeds
West Yorkshire
LS8 4BA
United Kingdom

2. The Domain Name(s):

bookster-tweed.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.

31 July 2017, the Dispute was received.

02 August 2017, the Complaint was validated.

02 August 2017, the Notification of the Complaint was sent to the Parties.

15 August 2017, the Response was received.

15 August 2017, the Notification of the Response was sent to the Parties.

18 August 2017, a Reply reminder was sent.

23 August 2017, no Reply was received.

23 August 2017, a Mediator was appointed.

30 August 2017, Mediation started.

15 September 2017, Mediation failed.

15 September 2017, the close of Mediation documents was sent.

27 September 2017, the Complainant full fee reminder was sent.

02 October 2017, the Expert decision payment was received.

4. Factual Background

4.1 The Respondent registered the Domain Name on **23 November 2013**.

4.2 The Complainant is the registered owner of a UK trade mark (No. 3060632) for the device mark (the 'logo') below, which has the capitalised words "*BOOKSTER TAILORING*" included under a shield with two horses with riders flanking either side.



4.3 The trade mark was registered on **24 October 2014** for among other things clothing, footwear, headgear, and tailored clothing for men and women (Class 25).

4.4 The Complainant trades as an online supplier of clothing, in particular tweed jackets, via its website located at www.bookster.co.uk. That website prominently displays the trade mark described above.

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 submitted that it had built up a considerable reputation and goodwill in the "*mark BOOKSTER*" in relation, in particular, to tailoring and the retail of tweed garments.
- The Complainant submitted that the "*BOOKSTER brand*" was established in Herefordshire in **2007**, and became "*renowned for specialising in Tweed garments.*"
- Further, the Complainant submitted that, on **16 April 2014**, the "*Bookster Tailoring brand and goodwill was acquired by*" it (a receipt submitted by the Complainant sets out that the receipt is for the "*trade name 'Bookster' and Goodwill therein*" and includes the registration of four domain names (*bookster.co.uk, bookster1uk.co.uk, tweed-jacket.co.uk and tweed-jacket.com*)).
- In light of the above, the Complainant stated that it was asserting its "*registered and unregistered trade mark rights (passing off).*" The Complainant submitted that it has used the "*name or mark in question for a not insignificant period and to a not insignificant degree*", particularly its website <http://www.bookster.co.uk>.
- The Complainant submitted that the "*BOOKSTER trade mark in question is recognised by the public as indicating the goods or services of the Complainant.*"

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.

- The Complainant submitted that the Domain Name *"is identical or very similar to the Complainant's registration"* and that, at the time of the Complaint, clicking on a weblink to the Domain Name redirects a web user to www.tweed-jackets-shops.co.uk/ from which the Respondent offers for sale clothing and in particular tweed jackets.
- The Complainant contended that the Domain Name is an Abusive Registration because the *"use of the Complainant's registered trade mark in its entirety in the domain name, and in particular in relation to clothing, will lead the relevant public to believe that the Domain Name is registered to, operated or authorised by, or otherwise connected with the Complainant, which it is not."*
- The Complainant further contended that such confusion *"in the mind of the relevant public between the domain proprietor and the registered trade mark holder amounts to an abusive registration."*
- Further, the Complainant explained that the Respondent had been contacted previously (**December 2014** and **May 2017**) *"highlighting the Complainant's rights"*, and that the forwarding from the Domain Name *"stopped on each occasion but has recently recommenced."*
- Given the above, the Complainant submitted that it *"appears the domain is primarily registered to unfairly disrupt the Complainant's business activities and threatens to unfairly disrupt the Complainant's business because there is confusion in the marketplace as to the trade origin of 'Bookster' clothing and in particular Bookster Tweed Jackets."*

The Respondent's Response

5.2 In summary, the Respondent submitted that the Domain Name should not be transferred to the Complainant for the reasons set out below.

- The Respondent stated that, in **July 2013**, the company *"Bookster Tailors fell into liquidation"* that the Respondent was *"inundated with calls / emails from customers who had lost their orders"* enquiring whether the Respondent *"could help."*
- The Respondent explained that, as *"a company already trading and offering the same tweeds"* it was *"able to assist and help complete some customers orders."*

- The Respondent stated that, on **23 November 2013**, he registered the Domain Name as the company, Bookster Tailors, *“had been closed for some time with no sign of a new owner.”*
- The Respondent stated that the Domain Name is used as an *“alias to tweed-jackets-shops.co.uk and will only display as the domain tweed-jackets-shops.co.uk.”* The Respondent also stated that the Domain Name is not registered in Google and *“the only way can be found is by typing into the browser which then forces domain tweed-jackets-shops.co.uk.”*
- The Respondent stated that, on **29 April 2014**, it being *“some time after”* his registration of the Domain Name, the Complainant company was first incorporated (the Respondent provided a link to Companies House).
- Further, the Respondent stated, providing a link to the Intellectual Property Office’s website, that the Complainant had filed its referenced trade mark on the **19 June 2014**, and registered it on **24 October 2014**.
- The Respondent submitted that, since **November 2014**, the Complainant has been attempting to *“pass off”* that it owns, and is the sole proprietor for, the word *“BOOKSTER”* when the Complainant *“only own[s] the trade mark BOOKSTER TAILORING”*, and that, while threatened, no legal action has been brought by the Complainant.
- The Respondent stated that he had *“spoken at length with Intellectual Property Office who has informed us that the word BOOKSTER is too generic in itself to register.”* The Respondent noted that the name *“BOOKSTER”* is, in fact, used by other companies, including accommodation booking software [but no supporting evidence of this was provided].
- The Respondent noted that he has, *“on previous occasions”*, offered to sell the Domain Name to the Complainant’s legal representatives, who have yet failed to come back with any offer of purchase and that he was *“open to offers for purchase”* of the Domain Name.
- The Respondent stated that, given the Domain Name does not breach the Complainant’s *“actual registered trade mark”*, and that the Respondent *“was in operation prior to [the Complainant] even being in existence”*, it has not done anything wrong, in particular *“when the domain itself cannot be found or advertising as Bookster Tailoring.”*

Complainant’s Reply

5.3 No Reply was submitted by the Complainant.

6. Discussions and Findings

General

6.1 To succeed in the Complaint, the Complainant has to prove that, pursuant to paragraph 2 of the Policy, 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.

6.2 Addressing each of these limbs in turn:

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

6.3 The Expert considers that, for the reasons set out below, the Complainant has shown it has Rights in a mark which is similar to the Domain Name.

6.4 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;

6.5 The Complainant submitted that, based on its UK trade mark, it has rights in the "BOOKSTER trade mark [...]" which "is recognised by the public as indicating the goods or services of the Complainant."

6.6 The Expert notes, and as has been addressed in a previous DRS Decision (D00012473), the fact that the registration of the Complainant's trade mark on **24 October 2014** post-dates the registration of the Domain Name (**23 November 2013**) is not relevant when considering whether or not the Complainant has Rights. This is because the Complainant only has to show it has the Rights in question at the time of the complaint (Nominet Appeal decision, *ghd.co.uk*, DRS No. 03078).

6.7 Further, the Expert notes that the Complainant is claiming Rights based on its trade marked logo. In this regard, it is stated in the Nominet Experts' Overview (version 3 – available on Nominet's website) that rights in a logo may not necessarily equate to trade mark rights in respect of any words featured in that logo, and much will depend on the nature of the words in the logo in question and their prominence.

6.8 In its submission, the Complainant has not acknowledged the fact that the word it is claiming Rights for is set out in its logo, nor has it addressed why the logo and the

Domain Name should be treated as similar, which the Expert would have expected on these facts.

- 6.9 That said, on the balance of probabilities, the Expert considers that the word “BOOKSTER” is not a commonly used word in ordinary parlance, and is sufficiently prominent in the logo being in larger and bolder type than “TAILORING” such that it equates to trade mark rights in respect of the word “BOOKSTER.” Further, the Expert considers that the addition of the word “Tweed” hyphenated at the end of the word “Bookster” in the Domain Name is insufficient to distinguish the Domain Name from the Complainant’s trade mark; tweed being a descriptive term for a type of cloth.
- 6.10 It would also be possible (as the Respondent appears to suggest), to analyse the Complainant’s Rights as being in the words “BOOKSTER TAILORING”. On that alternative analysis, the Expert again considers that the Complainant has Rights in a mark similar to the Domain Name given the appearance of the word “BOOKSTER” in each, and the fact that tweed, as a type of cloth, bears an obvious association with the activity of tailoring.
- 6.11 The Expert has considered the Respondent’s argument that the word “BOOKSTER” is generic and incapable of supporting a claim to Rights. No proper evidence has been provided to substantiate this argument (whether of the conversations said to have taken place with the Intellectual Property Office or otherwise). The Expert does not accept this argument. The word “BOOKSTER” is not one commonly used in ordinary parlance, and does not have any meaning at all in relation to tailoring, and as such seems to the Expert to be distinctive rather than generic or descriptive.
- 6.12 Therefore, the Expert considers that, at the time of the Complaint, the Complainant did have Rights in a mark which is similar to the Domain Name.

Abusive Registration

- 6.13 For the reasons set out below, the Expert considers that the Domain Name is an Abusive Registration as understood by the Policy.
- 6.14 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. is being or has been used in a manner which has taken unfair advantage of or has been unfairly detrimental to the Complainant’s Rights;*
- 6.15 The Expert considers it appropriate at this stage to provide a brief summary of the timeline of this matter as submitted above:

- 6.15.1 As reported by the Complainant, a third-party company called “*Bookster Tailors*” established the “*BOOKSTER brand*” in Herefordshire in **2007** which, in the Complainant’s words, was “*renowned for specialising in Tweed garments.*”
- 6.15.2 That third-party company, as reported by the Respondent, “*fell into liquidation*” after which the Respondent was “*inundated with calls / emails from customers who had lost their orders*” enquiring whether the Respondent “*could help.*”
- 6.15.3 The Respondent, noting that the third party, “*had been closed for some time with no sign of a new owner*”, subsequently registered the Domain Name on **23 November 2013**.
- 6.15.4 The Complainant (or to be more precise, those responsible for the Complainant’s formation as the Complainant did not at this date exist) purchased the “*trade name ‘Bookster’ and Goodwill therein*” through an Auction House on **16 April 2014** (being shortly after the registration of the Domain Name).
- 6.15.5 The Complainant was incorporated on **29 April 2014**. The Expert infers that the rights in the trade name “*Bookster*” and associated goodwill, as referred to in the previous paragraph, were then transferred to the Complainant’s ownership on its formation.
- 6.15.6 The Complainant filed its trade mark application for the logo on **19 June 2014**, which was registered on **24 October 2014**.
- 6.16 So far as the definition of Abusive Registration sub paragraph (i) is concerned, the evidence in this case is rather sketchy and in some respects unsatisfactory. It is really not clear to the Expert what reputation and business the original “*BOOKSTER*” brand had as no proper evidence (as opposed to mere assertion) has been provided in this respect. The Respondent stated that, when that business ceased operating, he was “*inundated with calls/emails from customers who had lost their orders.*” It is not clear to the Expert why, in those circumstances, the Respondent thought it necessary to register the Domain Name, nor has any evidence been provided as to how the Respondent set about using the Domain Name in a manner which was directed to the situation he describes.
- 6.17 The Expert considers the Respondent’s explanation with some skepticism, it seeming more likely that it was an opportunistic registration by the Respondent of a domain name likely to be associated with a competitor at a time when that competitor had ceased trading. That said, given the Expert’s findings (below) as to how the Domain Name has subsequently been used, the Expert does not need to reach a conclusion on whether or not the registration of the Domain Name was abusive.

- 6.18 So far as the definition of Abusive Registration sub paragraph (ii) is concerned, the Expert considers that the Domain Name was and is an Abusive Registration as a result of its manner of use by the Respondent, for the reasons explained below
- 6.19 The Expert notes that the Respondent is in the same line of business as the Complainant, the selling of tailored garments, and advertises the same on its website at <http://www.tweed-jackets-shops.co.uk>. The Respondent has linked the Domain Name to that URL, whereby someone clicking on the URL linked to the Domain Name will be taken to the Respondent's website.
- 6.20 The Respondent, in support of why his registration of the Domain Name was, and is, not an Abusive Registration, submitted that the website attached to the Domain Name (the '**Website**') does not appear in any Google searches. The Expert is not able to ascertain whether that is correct, but even if it is, does not consider that provides a satisfactory answer. Internet users can and do access websites via other methods, including the guessing of URLs for companies they are looking for. In this matter, an Internet user will be visiting the Website considering it is somehow linked to the Complainant, which it is not.
- 6.21 Further, the question remains as to why the Respondent needs the Domain Name at all, and why he is using it for redirection in the manner he describes. If he has arranged matters so the Domain Name (or its associated URL) does not feature in any Google searches for relevant terms, why does he need it at all? No satisfactory explanation has been provided by the Respondent as to why he uses the Domain Name in this manner. The Domain Name's only meaning in relation to tailoring, on the evidence before the Expert, is in relation to the Complainant and its business.
- 6.22 Indeed, and as indicated above, it seems likely to the Expert that the Respondent registered the Domain Name opportunistically at a time when he believed the original *Bookster Tailoring* business had ceased trading. Once it transpired that that business had, in fact, continued, albeit under the Complainant's ownership, it would seem that the Respondent has simply retained the Domain Name and redirected it to his own website even though it clearly and naturally relates to the continuing Bookster tailoring business.
- 6.23 Therefore, the Expert considers that the Respondent's conduct above falls within paragraph 5.1.2 of the Policy, 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;

- 6.24 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 use of the Domain Name, for the reasons referenced above, has taken unfair advantage of the

Complainant's Rights by seeking to rely on the Complainant's goodwill and reputation in the trade mark "*BOOKSTER*" to generate web traffic to the Website that was meant for the Complainant.

- 6.25 Also, the Expert is not persuaded by an argument that a person accessing the Website on the assumption it was the Complainant's website would soon realise his or her mistake, as the damage to the Complainant's business would already have been done. Indeed, paragraph 3.3 of the DRS Experts' Overview supports the view that a registration is abusive in circumstances where the Respondent is providing competing goods and services which do not originate from the Complainant (which is the case here).
- 6.26 However, even if paragraph 5.1.2 of the Policy is not directly applicable, the list of factors set out in paragraph 5.1 of the Policy is, in any event, non-exhaustive and the Expert considers that the Respondent, in holding onto the Domain Name and soliciting offers from the Complainant for its purchase, whilst redirecting the associated URL to his own competing website, amounts to an Abusive Registration; given the fact the word "*BOOKSTER*" in connection with tailoring relates entirely to the Complainant's business and has no meaning in relation to the Respondent's business.
- 6.27 The Expert has considered whether there is any other evidence before him to demonstrate that the Domain Name is not an Abusive Registration but does not consider there is.
- 6.28 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.

7. Decision

- 7.1 The Expert finds that, on the balance of probabilities, the Complainant has Rights in respect of a mark which is 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: 5 November 2017