

NOMINET DISPUTE RESOLUTION SERVICE

DRS 05722

Cumberland Estate Agents Limited v Brainfire Group

Decision of Independent Expert

1. Parties

Complainant: Cumberland Estate Agents Limited
Address: Cumberland House
Castle Street
Carlisle
Cumbria
Postcode: CA3 8RX
Country: GB

Respondent: Brainfire Group
Address: PO Box 68229
1
Calgary
Alberta
Postcode: T3G 4N4
Country: CA

2. Domain Name

cumberlandestateagents.co.uk (“the Domain Name”)

3. Procedural Background

The Complaint was filed with Nominet on 14 May 2008. Nominet validated the Complaint on 14 May 2008 and notified the Respondent by post and by email, informing it at the same time that it had until 6 June 2008 to file a Response.

The Respondent did not submit a Response. On 19 June 2008, the Complainant paid the requisite fee to obtain an Expert Decision pursuant to paragraph 6 of the Nominet Dispute Resolution Service Policy (“the Policy”).

On 25 June 2008, David Taylor, the undersigned (“the Expert”), confirmed to Nominet that he knew of no reason why he could not properly accept Nominet’s invitation to him to act as an Expert in this case and further confirmed that he knew of no matters which ought to be drawn to the attention of the parties which might appear

to call into question his independence and/or impartiality. A formal appointment of the Expert was made on 30 June 2008.

4. Outstanding Formal/Procedural Issues

There are, so far as the Expert is aware, no live procedural issues raised by either party which have a bearing upon this decision.

5. The Facts

The Complainant is a limited company trading under the name “Cumberland Estate Agents Limited”. It was registered at Companies House under the name Cumberland Estate Agents Limited in 1989. It is a wholly-owned subsidiary of Cumberland Building Society, which has been established since 1850.

The Complainant is an estate agency established in Cumbria in 1992 and trading in the Cumbria area as an estate agency since that date. It provides estate agency services to personal and commercial customers under the name Cumberland Estate Agents.

The Complainant has a registered UK device trade mark CUMBERLAND ESTATE AGENTS, number 2337806, which was filed on 15 July 2003 and registered on 7 January 2005.

The Domain Name was registered on 25 February 2006.

On 14 May 2008, based on the screenshots provided by Nominet, the Domain Name was pointed at a parking site with sponsored links to third parties’ websites.

6. The Parties Contentions

The Complainant

The Complainant argues that the Domain Name incorporates its CUMBERLAND ESTATE AGENTS trade mark. The Complainant also states that its rights in the Domain Name significantly predate the date of the registration of the Domain Name in 2006. According to the Complainant the parties are not in any way affiliated with each other. The Complainant has not licensed or otherwise permitted the Respondent to use its trade mark or to apply for a domain name incorporating its mark.

The Complainant argues that, in addition to its registered rights, the name Cumberland Estate Agents is recognised and respected by the general public in the Cumbria area. The Complainant uses the name on its website at www.cumberland.co.uk where it provides details of houses and flats offered for sale. The Complainant has submitted an extract of the minutes of the meeting of the board of Cumberland Building Society and copies of marketing leaflets from 1992 to date. It alleges to have advertised the name Cumberland Estate Agents since 1992 with a current annual marketing spend on such advertisements of £395,708, and general marketing spend of £62,614. The Complainant has provided

examples of recent advertising, promotional leaflets and press cuttings as annexes to the Complaint.

The Complainant submits that the Domain Name is used by the Respondent to link to a website offering links to websites of the competitors of the Complainant. The Complainant has evidenced this statement by submitting printouts of the website www.cumberlandstateagents.co.uk on 17 August 2007, 3 September 2007, 26 February 2008 and 7 May 2008. The Complainant argues that the way in which the Domain Name has been used is unfairly detrimental to its rights. By providing links to the websites of the Complainant's competitors on the website linked to the Domain Name the Respondent has provided and could in the future provide these competitors with business opportunities that they would not otherwise have had, at the expense of the Complainant.

The Complainant further submits that the Domain Name in the hands of the Respondent is abusive because:

- It is used by the Respondent in a way which is likely to confuse people into thinking that it is controlled by the Complainant;
- The Domain Name has been put to use in a manner which is for the sole purpose of generating advertising income as it directs people to a site with 'click-through' links to a number of other sites;
- The registration and use of the Domain Name are likely to cause confusion and to deceive consumers into mistakenly believing that the Domain Name and website are offered, authorised, or sponsored by the Complainant, or are otherwise affiliated with the Complainant;
- As a consequence of the Respondent's registration and use of the Domain Name, the Complainant's business is unfairly disrupted by the redirection of internet users which will deprive the Complainant of internet traffic rightly intended for its website;
- By registering and using the Domain Name the Respondent is misappropriating the Complainant's goodwill;
- By registering and using the Domain Name the Respondent is blocking the Complainant from registering a name in which it has rights;
- By registering and using the domain name the Respondent's actions are unfairly detrimental to the Complainant's rights in its CUMBERLAND ESTATE AGENCY mark.

The Complainant further argues that the registration of the Domain Name is automatically abusive because the Respondent has had three or more DRS cases against it in the last two years in which experts have found the registrations to be abusive. The references given by the Complainant for these decisions are "DRS case numbers 02908, 03386, 03817, 04001, 04551, 04575".

The Complainant is unable to think of any good reason why the Respondent could reasonably be said to have any legitimate rights or interest in the Domain Name. The Respondent is not using the Domain Name in connection with a genuine offering of estate agency services, and has not been commonly known by the name Cumberland Estate Agents, nor has it made a legitimate non-commercial or fair use of the Domain Name.

The Complainant requests that the Domain Name be transferred.

The Respondent

The Respondent has not submitted a Response.

7. Discussion and Findings

Although the Respondent has failed to submit a Response, the Procedure does not provide for a default decision in favour of the Complainant. The Complainant must still prove its case to the requisite standard, see §15(b) of the DRS Procedure. However, an expert may draw such inferences from a party's default as appropriate.

Under paragraph 2(a) of the Policy, the Complainant is required to demonstrate, on the balance of probabilities, 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.

Complainant's Rights

Rights under the Policy include rights to registered marks and unregistered trade marks, protected by the law of passing-off.

The Complainant owns a registered UK device trade mark number 2337806 CUMBERLAND ESTATE AGENTS filed on 15 July 2003 and registered on 7 January 2005. The trade mark is made up of two lines resembling a roof above the name 'Cumberland Estate Agents'. The name 'Cumberland Estate Agents' is the dominant element of this trade mark and the Expert therefore finds that the Domain Name is similar to said trade mark.

The Complainant has further submitted that the name Cumberland Estate Agents is recognised and respected by the general public in the Cumbria area. The Complainant alleges having advertised the name Cumberland Estate Agents since 1992 with a current annual marketing spend on such advertisements of £395,708, and general marketing spend of £62,614. While no evidence of these expenses has been submitted, the Complainant has provided copies of advertisements, sales materials and press cuttings as annexes to the Complaint. The Expert notes that actual use of a name in trade can create common law rights enforceable in passing-off and based on the evidence submitted the Expert is satisfied that the Complainant has established such rights.

Accordingly, the Expert finds that the Complainant has Rights in respect of a name or mark, which is identical or confusingly similar to the Domain Name.

Abusive Registration

Paragraph 3 of the Policy defines "Abusive Registration" as a domain name which either:

- (i) was registered or otherwise acquired in the 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 Policy at paragraph 3 sets out a non-exhaustive list of factors which may be evidence that the Domain Name is an Abusive Registration.

Because the Respondent has not explained its intention at the time of the registration of the Domain Name, the evidence available to the Expert is the website itself (see Nominet appeal decision, *Guidestar v Wilmington Business Information Ltd*, DRS Number 02193, 21 February 2005). The Expert accessed the website linked to the Domain Name, which is currently in operation as at the date of this Decision. The website directs internet users to a parking site featuring links to competitors of the Complainant. Based on the circumstances of this case the Expert considers that the Respondent's aim in registering and using the Domain Name was to generate advertising income from click through traffic.

Furthermore the Expert notes that the Respondent has been a party to previous DRS disputes which predated the registration of the Domain Name, see for example *British Credit Trust Limited v Brainfire Group*, DRS Number 02908, 12 October 2005. The Respondent must thus be taken to have been familiar with the DRS Policy when it registered the Domain Name. As a consequence it is inconceivable that the Respondent was not aware of the potential damage of its actions to the Complainant when it registered the Domain Name in 2006. The Expert therefore considers that the purpose of the registration of the Domain Name was to disrupt unfairly the business of the Complainant.

Accordingly, the Complainant has established that the Respondent's registration of the Domain Name constitutes an Abusive Registration.

With regard to paragraph 3(a)(i)(B) of the Policy the Expert is satisfied that by registering and using the Domain Name the Respondent is blocking the Complainant from registering a name in which it has rights.

The Expert also finds that the circumstances of paragraph 3(a)(ii)(C) of the Policy are present. While no evidence of actual confusion has been submitted, the Domain Name has been pointing to a website which provides links to competitors of the Complainant. The Expert thus finds that the Respondent is using the Domain Name in a way which is likely to have confused people or businesses into believing that the Domain Name is registered to, operated or authorised by or otherwise connected with the Complainant.

The Complainant argues that the Respondent has been found to have made abusive registrations in at least three Dispute Resolution Service cases in the last two years. The referenced cases are *Imperial Tobacco Limited v Brainfire Group*, DRS Number 03386, 27 March 2006, *Welconstruct Group Limited v Brainfire Group*, DRS Number 03817, 24 August 2006, *General Dynamics UK Limited v Brainfire Group*, DRS Number 04001, 3 November 2006 and *Newsquest Media Group Limited v Brainfire Group*, DRS Number

04551, 14 May 2007. The allegation that the Respondent has been found to have made an Abusive Registration in at least three DRS cases in the last two years has been made out, thereby giving rise to a rebuttable presumption of Abusive Registration in the sense of paragraph 3(v)(c) of the Policy. By not filing a Response, the Respondent has failed to rebut this presumption. In the Expert's view, this behaviour also evidences a "pattern of registrations" of domain names which correspond to well-known names or trade marks in which the Respondent has no apparent rights within the meaning of paragraph 3(a)(iii) of the Policy.

For all the foregoing reasons, the Expert finds that there was an Abusive Registration at the time the Domain Name was registered, and that it has been used in a manner, which took unfair advantage of or was unfairly detrimental to the Complainant's Rights.

8. Decision

The Complainant has proved, on the balance of probabilities, that it has rights in a name which is similar to the Domain Name and that the Domain Name is an Abusive Registration in the hands of the Respondent. The Expert therefore directs that the Domain Name be transferred to the Complainant.

David Taylor
11 July 2008