

YACHT SHIPPING LIMITED

-v-

PETERS AND MAY LTD

Nominet UK Dispute Resolution Service

DRS 02159

Yacht Shipping Limited and Peters & May Limited

Decision of Independent Expert

1. PARTIES:

Complainant: Yacht Shipping Limited
Address: Bowling Green House
1 Orchard Place
Southampton
Hants SO14 3PX
Country: Great Britain

Respondent: Peters & May Limited
Address: Parham Drive
Eastleigh
Hants SO50 4NU
Country: Great Britain

2. DOMAIN NAMES:

YACHTSHIPPING.CO.UK; YACHT-SHIPPING.CO.UK ("The Domain Names").

3. PROCEDURAL BACKGROUND:

- 3.1 The dispute was entered into the Nominet Dispute Resolution Service System (DRS) on 2 November 2004. A hardcopy of the Complaint was received in full by Nominet on 4 November 2004. Nominet validated the Complaint on 9 November 2004 and sent a copy to the Respondent on the same day.

- 3.2 The electronic response was entered into the DRS System on 18 November 2004. Hard copies were received the same day and sent to the Complainant.
- 3.3 On 26 November the Reply was received in electronic and hard copy and was entered into the DRS System.
- 3.4 Mediation failed to resolve the dispute and on 31 December 2004 the Complainant paid the fee to obtain an Expert Decision pursuant to paragraph 6 of the Nominet Dispute Resolution Policy ("the Policy").
- 3.5 On 10 January 2005, Veronica Bailey, the undersigned ("the Expert") having confirmed to Nominet that she knew of no reason why she could not properly accept the invitation to act as the Expert in this case and that she knew of no matters which ought to be drawn to the attention of the parties, which might appear to call into question her independence and/or impartiality, was appointed Expert.

4. OUTSTANDING FORMAL/PROCEDURAL ISSUES: (If Any)

- 4.1 None.

5. THE FACTS:

- 5.1 The Complainant, Yacht Shipping Company Limited was incorporated on 22 June 1989 under company registration number 2397660 and since its incorporation has been operating in the field of yacht shipping. Since November 2000 it has been using the domain name yachtshipping.com in connection with its website at www.yachtshipping.com for promoting its yacht shipping business.
- 5.2 The Respondent was incorporated on 29 November 1988 with the name Taskmarsh and changed its name to Peters & May Limited on 28 April 1989. The Respondent is an independent freight forwarder and operates

a yacht shipping service. The Respondent has been registered with the disputed Domain Names since 25 April 2002.

5.3 Both the Complainant and the Respondent are based in Southampton and are competitors in the field of yacht shipping.

6. THE PARTIES' CONTENTIONS:

Complainant

6.1 The Complainant's contentions can be summarised as follows:

- (i) The Domain Names in the hands of the Respondent are abusive as being a deliberate attempt to confuse the market and have an adverse effect on the Complainant's Internet address: www.yachtshipping.com.
- (ii) The Respondent has only been in business in the field of yacht shipping since 1989 and therefore for fifteen years not thirty years as alleged in the Respondent's response.
- (iii) To have the generic term yacht shipping as given words in order a company to be listed when potential customer are using a search engine is not under dispute but that the disputed Domain Names using the Complainant's company UK registered name can only be of benefit to the Respondent if a potential client is looking specifically for Yacht Shipping Limited. Therefore the Complainant views these registrations as abusive.
- (iv) "We Ship Boats" and "Boat Shipping International" are U.S. incorporated companies whose website addresses are www.weshipboats.com and www.boatshipping.com. The Complainant says that it is not clear why the Respondent should choose to register the weshipboats.co.uk and boatshipping.co.uk domain names.
- (v) It sees no other reason for the Respondent to hold the disputed Domain Names other than for the purpose of "Cyber squatting or registration in bad faith".

6.2 Respondent

The Respondent submits in its response that:

- (i) The words "yacht shipping" is a generic term used in the boat transport/yacht shipping industry which explains how to move boats. The term is often used by industry players on their website as a key word to improve search engine listing and so attract potential customers seeking yacht shipping services.
- (ii) The Domain Names were purchased as part of a marketing initiative to route potential customers towards the Respondent's website by pointing the disputed Domain Names to the Respondent's website at www.petersandmay.com.
- (iii) The Respondent denies that the registration of the Domain Names were an abuse or a deliberate attempt to confuse the market but were bought at the same time as a number of other domain names which refer to similar generic terms including "yacht transport", "boat shipping" and "boat delivery" as part of a marketing initiative.
- (iv) The Respondent contends that its registration of the Domain Names should not have an adverse effect on the Complainant's website at www.yachtshipping.com.
- (v) The Domain Names are being used in relation to a genuine offering of services, namely, yacht shipping and the Respondent's use of the Domain Names is a legitimate and fair means of obtaining yacht shipping business.
- (vi) The Respondent is not trying to pass off or infringe the rights of the Complainant in its purchase and use of the Domain Names now or in the future and the domains have never been advertised nor will be advertised.
- (vii) The use being made of the two Domain Names is a legitimate and fair means of obtaining yacht shipping business.

7. DISCUSSIONS AND FINDINGS

7.1 To succeed the Complainant must prove on the balance of probabilities that:

- (i) the Complainant has Rights (as defined in paragraph 1 of the Policy) in respect of the 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 (as defined in paragraph 1 of the Policy).

7.2 Paragraph 1 of the Policy defines Rights as follows:

Rights includes, but is not limited to, rights enforceable under English Law. However, a Complainant will be unable to rely on Rights in a name or term which is wholly descriptive of a Complainant's business.

7.3 In determining whether a party has Rights in a name or mark which is identical or similar the Domain Names the first and second suffixes (.co.uk) should be ignored. Similarly the use of hyphen in a domain name should also be ignored.

7.4 The words, "yacht shipping" used in the disputed Domain Names "yachtshipping.co.uk" and "yacht-shipping.co.uk" is also used in the Complainant's corporate name "Yacht Shipping Limited". The Complainant has no registered trade mark for the combination of words "yacht shipping" and relies on its rights in its corporate name. Whilst registering a trade mark will grant exclusive rights in the mark, registration of a company name will only prevent others from registering the exact corporate name at Companies House. Nevertheless, registration and use of a corporate name over a period of time may create rights protected by the common law action of passing off to protect the goodwill of a business attaching to that name. However, the Nominet Dispute Resolution Service is not the proper forum to determine a passing off action.

7.5 The requirement for the Complaint to demonstrate Rights under the Policy in respect of the name or mark which is similar to the Domain Name is not a particularly high threshold test (Appeal Panel in DRS 00248 Seiko UK Limited v Designer Time/Wanderweb). The registration of the corporate name Yacht Shipping Limited and its use since 1989 in connection with the Complainant's yacht shipping business would be sufficient to establish Rights but for the second sentence of the definition of Rights which states

that “a Complainant will be unable to rely on Rights in a name or term which is wholly descriptive of a Complainant's business.”

- 7.6 The words, "yacht shipping", which are used in the disputed Domain Names yachtshipping.co.uk and yacht-shipping.co.uk, are generic words which are descriptive of the Complainant's business. The words "yacht shipping" if used in a search engine would result in listings for many businesses in the yacht shipping business including that of both the Complainant's and the Respondent's. If a party chooses a wholly descriptive name for its business then it runs the risk that a certain amount of confusion is inevitable (see Office Cleaning Services –v- Westminster Office Cleaning Association [1946] 63 RPC 39).
- 7.7 Paragraph 3 c v of the Procedure requires that the Complainant must describe in accordance with the Policy the grounds on which the complaint is made including in particular: what Rights the Complainant asserts in the name or mark: why the Domain Name should be considered should be considered to be and Abusive Registration in the hands of the Respondent; and discuss any applicable aspects of paragraph 3 of the Policy, as well as any the grounds which support the Complainant's assertion.
- 7.8 The Complainant makes no attempt in its complaint or reply to refer to any particular aspects of the Policy on which it seeks to rely to support its claim for cancellation of the Domain Names. Little attempt has been made by the Complainant address the second sentence of the definition of Rights which precludes a Complainant from relying on a name or mark which is wholly descriptive of the Complainant's business.
- 7.9 The Expert is obliged to decide the Complaint on the basis of the Parties submissions, the Policy and the Procedure (DRS Policy16 a). It is not for the Expert to construct the Complainant's case. The Nominet DRS Policy and Procedure provides that a Complainant will be unable to rely on Rights in a name or term which is wholly descriptive of the Complainant's business. The Complainant has not addressed this aspect of the Policy. The name, "Yacht Shipping" which is used in the Complainant's company

name, is wholly descriptive of the Complainant's business, and the Complainant has failed to prove on the balance of probabilities that he has Rights in the name or mark similar to the Domain Names for the purposes of paragraph 2 of the DRS Policy.

Abusive Registration

- 7.10 As the Complainant has failed to prove that it has Rights for the purposes of the first element of paragraph 2 of the Policy, it is not necessary to consider the second element of paragraph 2: whether the Domain Names are an Abusive Registration, However, for completeness the Complainant's submissions in relation to Abusive Registration are dealt with below.
- 7.11 A non-exhaustive list of factors which may be evidence that a Domain Name is an Abusive Registration, is set out in paragraph 3 of the Policy. The relevant provisions of which include registering or otherwise acquiring the Domain Name for the purpose of unfairly disrupting the business of the Complainant (3aiC of the Policy) and using the Domain Name in a way which has confused people or businesses into believing that the Domain Name is registered to, operated or authorised by, or otherwise connected with the Complainant (3aii of the Policy).
- 7.12 The complaint focuses on confusion and unfair disruption to the Complainant's business. Whilst the Complainant asserts that the registration is abusive and a "deliberate attempt to confuse the market and have an adverse effect on our Internet address www.yachtshipping.com", it does not expand on this statement and provides no evidence whatsoever that the public has been confused or that its business has been disrupted. Nominet has provided the Expert with a printout of the website connected to the disputed Domain Names but the Complaint has made no attempt to explain their significance.
- 7.13 The Complainant refers to the Respondents registration of the domain names weshipboats.co.uk and boatshipping.co.uk and says that "We Ship Boats" and "Boat Shipping International" are U.S. incorporated

companies, whose website addresses are www.weshipboats.com and www.boatshipping.com. Beyond saying that it is not clear why the Respondent should choose to register the domain names weshipboats.co.uk and boatshipping.co.uk, the Complainant does not explain how these registrations might be relevant to its complaint nor why they may be relevant to show that the disputed Domain Names are an Abusive Registration.

7.14 Accordingly the Complainant has failed to show on the balance of probabilities that the website connected to the Domain Names has confused people or business into believing that the Domain Names is registered to, operated or authorised by, or other wise connected with the Claimant in accordance with paragraph 3a ii of the Policy. Nor has the Complainant shown that the Respondent registered or otherwise acquiring the Domain Name for the purpose of unfairly disrupting the business of the Complainant as required by paragraph 3aiC of the Policy.

8. DECISION

The Expert does not find that the Complainant has, on the balance of probabilities, satisfied the requirements of paragraph 2 of the Policy. Accordingly, for the reasons set out above the Complainant's request for cancellation of the Domain Name is refused.

Veronica M Bailey

Date: 24 January 2005