

# Nominet UK Dispute Resolution Service

## DRS Number 3747

The Fine Cheese Company Ltd

v

Lawson's Cheeses

## Decision of Independent Expert

### 1. Parties

Complainants: The Fine Cheese Company Limited  
Address: 29 & 31 Walcot Street  
Bath  
Somerset  
Postcode: BA1 5BN  
Country: United Kingdom

Respondent: Lawson's Cheeses  
Address: Gate 4 Unit 1  
The Sidings Business Park  
Engine Shed Lane  
Skipton, Yorkshire  
Postcode: BD23 1TB  
Country: United Kingdom

### 2. Domain Name

[finecheeses.co.uk](http://finecheeses.co.uk) - registered on 30 January 2003.

### 3. Procedural Background

The Complaint was lodged with Nominet on 19 June 2006. Nominet validated the Complaint and notified the Respondent of the relevant Complaint on 3 July 2006 and informed the Respondent that it had 15 days within which to lodge a Response.

A non-standard response was received from the Respondent on 7 July 2006 and sent to the Complainant. On 14 July 2006 a non-standard reply was received from the Complainant.

No mediation having been possible, on 28 July 2006 the dispute was referred for a decision by an Independent Expert following payment by the Complainant of the required fee for a

decision of an Expert pursuant to paragraph 6 of the Nominet UK Dispute Resolution Service Policy ("the Policy").

David Flint, the undersigned, ("the Expert") confirmed to Nominet that he knew of no reason why he could not properly accept the invitation to act as 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.

#### **4. Outstanding Formal/Procedural Issues (if any)**

The Expert has decided that it is in the interests of the Policy for the non-standard response and reply referred to in paragraph 3 to be admitted.

#### **5. The Facts**

The Complainant (The Fine Cheese Co) has traded under this name since 1987 and on the web since 1999 ([www.finecheese.co.uk](http://www.finecheese.co.uk)). They have had an online ordering service since 2000 The Fine Cheese Co are artisan cheese selectors and maturers. They represent over 100 British Cheesemakers, and wholesale their cheeses and cheese accompaniments to shops and restaurant throughout the UK. They export cheese to USA, Japan and Germany and export their crackers for cheese to 15 markets. Chronologically, they were established in Corsham, Wiltshire in 1987 and opened their Bath retail shop in 1991. In 1999 in response to customer demand to be able to buy our cheeses in their own town, they decided to launch a website and in 2000 opened an internet shop.

#### **6. The Parties' Contentions**

##### Complainants

- I. The Complainant (The Fine Cheese Co) has rights in the Domain Name because we have traded under this name since 1987 and on the web since 1999 ([www.finecheese.co.uk](http://www.finecheese.co.uk)).
- II. We have had an online ordering service since 2000 Background: The Fine Cheese Co are artisan cheese selectors and maturers. We represent over 100 British Cheesemakers, and wholesale our cheeses and cheese accompaniments to shops and restaurant throughout the UK. We export cheese to USA, Japan and Germany and export our crackers for cheese to 15 markets. Chronologically, we were established in Corsham, Wiltshire in 1987 and opened our Bath retail shop in 1991.
- III. In 1999 in response to customer demand to be able to buy our cheeses in their own town, we decided to launch our website and 2000 open an internet shop. The website aim was to mirror the Bath shop, selling specialist cheese, cheese accompaniments (our own brand of crackers for cheese, chutneys etc), and gourmet foods.
- IV. The company name The Fine Cheese Co was abbreviated to be our domain name: [www.finecheese.co.uk](http://www.finecheese.co.uk). We have traded on the internet for the last 6 years under this name and ONLY this name. In 2002 the business became a limited company: The Fine Cheese Co (Bath) Ltd, our trading name since 1987 has been The Fine Cheese Co.
- V. The Domain Name in the hands of the Respondent is abusive because it was primarily used by the Respondent in a way which has already confused people into thinking that it was controlled by me.
- VI. In November 2005 after a customer complaint about a missing order, we discovered that we were not the company that the customer had ordered from and that the Respondent had somehow intercepted an order intended for us. On further investigation we discovered that if a customer responded, as in this case, to publicity about our cheese, wished to place an order and accidentally added the letter 's' to our domain name in order to access our site,

then they would be directed via a link to the site of : Lawson's Cheeses Direct (an internet cheese retailer like ourselves)/

- VII. Knowing how much publicity we generate through public relations for our cheese selections, our cheese wedding cakes and cheese gifts, we realised that customers who were not familiar with The Fine Cheese Co might logically assume they had reached the right company, if they inadvertently made this error.
- VIII. We immediately wrote to Lawson's Cheeses Direct and asked them to remove the 'finecheeses' domain from the register and the link back to their true site. They wrote back denying that they had registered the site to cause confusion, but admitted that the site was only registered 2 years ago.
- IX. We believe this registration, which has no obvious name connection to their own company other than 'cheese', is a deliberate attempt to pirate potential customers and to exploit the amount of publicity that we generate for our website name [www.finecheese.co.uk](http://www.finecheese.co.uk) by redirecting the customer to their site. In typing the words finecheese adding an extra 's' is an easy error to make.
- X. The Complainant seeks transfer of the Domain Name.

#### Respondent

- I. The Respondent contends that the Domain Name was registered "some years ago when it was available and not registered by any other company".
- II. It reflects the goods we have sold for over 20 yrs and this is the and only (sic) reason this domain was registered by our company.
- III. We have also registered other domains which reflect the products we sell which are all listed on our shopping website [...] These include [yorkshirecheese.co.uk](http://yorkshirecheese.co.uk); [yorkshirebiscuits.co.uk](http://yorkshirebiscuits.co.uk); [cheese4all.co.uk](http://cheese4all.co.uk) and [lawsonscheeses.co.uk](http://lawsonscheeses.co.uk) as well as [finecheeses.co.uk](http://finecheeses.co.uk).
- IV. All these domains link straight to our shopping site [www.cheesesdirect.co.uk](http://www.cheesesdirect.co.uk) which is in no way misleading to any persons.

#### Reply by Complainant

- I. Firstly, the respondent refers to registering FINECHEESES.CO.UK "some years ago"<sup>1</sup>. This was in fact registered in 2004.
- II. The Fine Cheese Co registered the domain name FINECHEESE.CO.UK in 1999.
- III. Secondly, the respondent argues that the domain name reflects the goods that he has sold for over 20 years and that this is the only reason for registering the name. He may well sell "fine cheeses", but he also sells "good cheeses", "best cheeses", "gourmet cheeses", "artisanal cheeses", "farmhouse cheeses", etc - yet he has not chosen to register any of these names, nor create links back to his site for them.
- IV. We maintain that he only chose "finecheeses" to exploit our name and reputation.

### **7. Discussion and Findings:**

#### General

To succeed in this Complaint the Complainant has to prove to the Expert pursuant to paragraph 2 of the Policy on the balance of probabilities, first, that it has rights (as defined in paragraph 1 of the Policy) in respect of a name or mark identical or similar to the Domain Name and, secondly, that the Domain Name, in the hands of the Respondent, is an Abusive

Registration (as defined in paragraph 1 of the Policy).

### Complainant's Rights

In this case the first limb of that task is straightforward. The Complainant has been trading since 1987 under the name Fine Cheese Co and has produced substantial evidence of its so doing. In those circumstances the Expert is satisfied that the Complainant does have Rights in respect of a name or mark which is identical or similar to the Domain Name.

### Abusive Registration

This leaves the second limb. Is the Domain Name, in the hands of the Respondent, an Abusive Registration? 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. has been used in a manner, which took unfair advantage of or was unfairly detrimental to the Complainant's Rights."

A non-exhaustive list of factors, which may be evidence that the Domain Name is an Abusive Registration is set out in paragraph 3a of the Policy. There being no suggestion that the Respondent has engaged in a pattern of making Abusive Registrations, the only potentially relevant 'factors' in paragraph 3 are to be found in subparagraphs i and ii, which read as follows:

- i "Circumstances indicating that the Respondent has registered or otherwise acquired the Domain Name primarily:
  - A. 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;
  - B. as a blocking registration against a name or mark in which the Complainant has Rights; or
  - C. for the purpose of unfairly disrupting the business of the Complainant;"
- ii "Circumstances indicating that the Respondent is 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;"

The Expert interprets "as" in sub-paragraph i. B as being synonymous with "for the purpose of". Were it to be interpreted otherwise all domain name registrations would inevitably constitute "blocking registrations" for any later arrival wishing to use the name in question.

The domain name according to the complainant, and at the time the complaint was made resolves to a site owned by a competitor of the complainant which offers very similar goods and services to those of the complainant. The Expert considers that such behaviour satisfies the test of paragraph 3.i.B.

The Expert has considered the question of the possible generic nature of the Domain Name; whilst it is true that the Domain Name is descriptive of the products sold by both the

Complainant and the Respondent, the Expert considers that the Domain Name has acquired secondary meaning due to the activities of the Complainant. Indeed a Google Search for "Fine Cheese" discloses only the Complainant (and not the Respondent) and includes recommendations from such culinary worthies as Delia Smith. A search for "fine cheeses" provides a similar result.

Accordingly, the Expert finds that the Domain Name is an Abusive Registration within the definition of that term in paragraph 1 of the Policy on the basis that it was registered in a manner which, at the time when the registration took place, took unfair advantage of the Complainant's rights.

## **8. Decision**

**In light of the foregoing findings, namely that the Complainant has rights in respect of a name or mark which is identical to the Domain Name and that the Domain Name, in the hands of the Respondent, is an Abusive Registration, the Expert directs that the Domain Name finecheeses.co.uk be transferred to the Complainant.**

David Flint

15 August 2006