

Nominet UK Dispute Resolution Service

DRS No. 04551

Newsquest Media Group Limited v. Brainfire Group

Decision of Independent Expert

1 Parties

Complainant: Newsquest Media Group Limited
Address: 58 Church Street
Weybridge
Surrey
Postcode: KT13 8DP
Country: GB

Respondent: Brainfire Group
Address: PO Box 68229
28 Crowfoot Terrace NW
Calgary
Alberta
Postcode: T3G 3N8
Country: CA

2 Domain Name

<banburycake.co.uk> (the "Domain Name")

3 Procedural Background

The Complaint entered Nominet's system on 14 March 2007. Hard copies of the Complaint were received by Nominet on 15 March 2007. The Complaint was validated and sent to the Respondent on 15 March 2007. No response was received within the deadline for response of 11 April 2007 and therefore no response was forwarded to the Complainant. Mediation not being possible and the Complainant having paid the relevant fee, the Complaint was referred to me. I confirmed that I was not aware of any reason why I could not act as an Independent Expert in this case and I was formally appointed as such on 1 May 2007.

4 Outstanding Formal/Procedural Issues (if any)

None

5 The Facts

- 5.1 The Complainant is a private limited company, incorporated under the laws of the United Kingdom on 9 November 1982 with company registration number 01676637. The Complainant is the publisher of the newspaper 'Banbury Cake', which was established in 1973.
- 5.2 The Respondent is based in Alberta, Canada. The exact legal status of the Respondent is unclear.
- 5.3 The Domain Name was registered on 1 February 2005 in the name of the Respondent (by whom it continues to be held). At the date of this decision, the Domain Name links to a web page that is similar to what one would expect to be generated by a "domain parking service". The web page shows the heading 'banburycake.co.uk - what you need, when you need it' and a number of links, mostly but not exclusively relating to

employment. Clicking on these links returns a web page consisting of internet search results provided by "information.com".

6 The Parties' Contentions

Complainant

- 6.1 The Complainant seeks transfer of the registration of the Domain Name into its name on the grounds that it is identical to a name in which it has rights enforceable under English law. The Complainant asserts that the registration of the Domain Name in the name of the Respondent is exploitative and abusive and a flagrant misuse of the 'Banbury Cake' name.
- 6.2 The Complainant maintains that the Banbury Cake is a well established and highly respected newspaper in the United Kingdom. The Banbury Cake is said to have a strong regional identity and valuable goodwill in the community it serves. The Respondent has taken unfair advantage of these rights by registering a domain name identical to the name of the Complainant's newspaper.
- 6.3 The abuse of the name 'Banbury Cake' by the Respondent is alleged to cause confusion to the general public. This abuse amounts to an actionable passing off under UK law and an infringement of the Complainant's "common law trade mark". It is claimed that the readers of the Banbury Cake are likely to believe that the Domain Name is operated by or in some way connected to the newspaper.
- 6.4 The Complaint also relies on the presumption of Abusive Registration (paragraph 3(c) of the Nominet UK Dispute Resolution Service Policy ("Policy")) given the Respondent's history of registering domain names that are identical or similar to registered and unregistered trade marks. It is said that in numerous Nominet DRS decisions in 2005 and 2006 there has been a finding of abusive registration by the Respondent. The references given by the Complainant for these decisions are "DRS 2908, DRS 3386, DRS 3817 and DRS 4001".

Respondent

- 6.5 The Respondent served no Response in these proceedings.

7 Discussion and Findings:

General

- 7.1 To succeed under the Policy, the Complainant must prove on the balance of probabilities, first, that it has Rights in respect of a "name or mark" that is identical or similar to the Domain Name (paragraphs 2(a)(i) of the Policy) and secondly, that the Domain Name is an Abusive Registration in the hands of the Respondent (paragraph 2(a)(ii) of the Policy).
- 7.2 Abusive Registration is defined in paragraph 1 of the Policy in the following terms:

Abusive Registration means 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.*

Complainant's Rights

- 7.3 I am satisfied on the evidence that the Complainant owns Rights in the name 'Banbury Cake'. Rights are defined in the Policy 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 the Complainant's business;"

- 7.4 'Banbury Cake' is the name of the Complainant's newspaper that on the uncontested evidence of the Complainant has been published since 1973. It is claimed that the Banbury Cake has "built up a strong regional identity and valuable goodwill in the community it serves" and again this is not contested. Whilst the Complainant does not expressly refer in the Complaint to the level of sales achieved, it annexes to its Complaint a copy of the front page of an edition of the Banbury Cake dated 8 March 2007. At the bottom of that front page is the declaration "32,976 Copies Distributed Every Week" and a reference in this respect to "VFD July to December 2006".

- 7.5 In the circumstances, I am satisfied that the Complainant has acquired sufficient goodwill in the name 'Banbury Cake' to enable it to bring a passing-off claim under English law. These are recognised as rights under the Policy and therefore the Claimant has satisfied the first limb of paragraph 2(a)(i) of the Policy.

- 7.6 The Domain Name is the same as the name of the newspaper owned by the Complainant save that there is no space between the words 'Banbury' and 'Cake' in the Domain Name. For these purposes I am satisfied that the two are identical and that the Complainant has satisfied the second limb of paragraph 2(a)(i) of the Policy.

Abusive Registration

- 7.7 Paragraph 3(a) of the Policy provides a non-exhaustive list of factors that may be evidence that a domain name registration is an Abusive Registration. It would appear from the Complaint that the Complainant is alleging that paragraphs 3(a)(ii) applies in this case.

- 7.8 Paragraph 3(a)(ii) refers to:

"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."

- 7.9 However, it is not necessary to consider the paragraph 3(a)(ii) claim in any detail. As the Complaint correctly states, paragraph 3(c) of the Policy is relevant here. It states that:

"There shall be a presumption of Abusive Registration if the Complainant proves that Respondent has been found to have made an Abusive Registration in three (3) or more Dispute Resolution Service cases in the two (2) years before the Complaint was filed. This presumption can be rebutted (see paragraph 4 (c))."

- 7.10 I am satisfied that the Respondent has been found to have made abusive registrations in at least four Dispute Resolution Service cases in the last two years. The cases relied upon by the Complainant in this respect are British Credit Trust Limited -v- Brainfire Group [2005] DRS 02908, Imperial Tobacco Limited -v- Brainfire Group [2006] DRS 03386, Welconstruct Group Limited -v- Brainfire Group [2006] DRS 03817 and General Dynamics UK Limited -v- Brainfire Group [2006] DRS 04001.

- 7.11 In each of these four decisions the address for the respondent is identical to the one recorded for the Respondent in Nominet's records and revealed by a WHOIS search in respect of the Domain Name; i.e:

PO Box 68229
28 Crowfoot Terrace NW
Calgary
Alberta
T3G 3N8
Canada

In the circumstances, I have little difficulty in concluding that the Respondent is the same entity as each of the respondents in these decisions.

- 7.12 Of course, paragraph 4(c) of the Policy merely provides a presumption of Abusive Registration and, therefore, that presumption can be rebutted. However, the Respondent has not sought by means of a Response to rebut that presumption in this case.
- 7.13 I, therefore, conclude that the Domain Name is an Abusive Registration within the meaning of the Policy.

8 Decision

- 8.1 I find that the Complainant has Rights in a name or mark that is identical or similar to the Domain Name and that the Domain Name, in the hands of the Respondent, is an Abusive Registration under paragraph 2(a) of the Policy.
- 8.2 I therefore determine that the Domain Name should be transferred to the Complainant.

Matthew Harris

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14 May 2007