

Nominet UK Dispute Resolution Service

DRS 000446

R&G Advertising & Marketing Limited v Ray Gill Advertising

Decision of Independent Expert

1. *Parties:*

**Complainant:** R & G Advertising & Marketing Limited  
**Address:** 8 Bugle Street  
Southampton  
Hampshire  
**Postcode:** SO14 2AJ  
**Country:** UK

**Respondent:** Ray Gill Advertising  
**Address:** 51 Ranelagh Road  
Dublin 6  
**Country:** UK

2. *Domain Names:*

**rgadvertising.co.uk** ("the Domain Names")

3. *Procedural Background:*

The Complaint was lodged with Nominet on June 12, 2002. Nominet validated the Complaint and notified the Respondent of the Complaint on July 8, 2002 and informed the Respondent that he had 15 days within which to lodge a Response. The Respondent did not respond and is in default. On August 8, 2002 the Complainant paid Nominet the appropriate fee for a decision of an Expert pursuant to paragraph 6 of the Nominet UK Dispute Resolution Service Policy ("the Policy").

Dawn Osborne, the undersigned, ("the Expert") confirmed to Nominet that she knew of no reason why she could not properly accept the invitation to act as expert in this case and further confirmed 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.

4. Summary of Facts:

The Complainant is an advertising and marketing company set up in 1984.

On November 12, 1999 the Respondent registered the Domain Name. The Respondent contacted the Complainant in August 2001 about e mails it was receiving intended for the Complainant. The Domain Name was subsequently and is still being pointed to a site of a sexual nature for homosexual men [www.gaymen.com](http://www.gaymen.com).

5. The Parties' Contentions:

Complainant:

The substance of the Complaint is as follows:

1. The Domain Name is identical or similar to a name or mark in which the Complainant has rights.
2. The Domain Name is, in the hands of the Respondent an abusive registration.
3. The Complainant is a well known advertising and marketing company set up in 1984. It designs and places advertising for a range of UK based clients in print media, television and radio. It has an annual turnover of £4.5M. It is one of the largest national press travel advertisers outside London. It is recognised by the NPA (Newspaper Publishers Association), NS (Newspaper Society), PPA (Periodical Publishers Association and ITVA (Independent Television Association).
4. The Complainant's clients are mainly based in the South East of England, but it does have clients in other parts of the UK such as Birmingham, Knutsford and Cheltenham. Accordingly the Complainant's reputation extends across the whole of, or at least a substantial part of England. Although registered as R&G Advertising and Marketing Limited, the Complainant is known amongst clients and industry as "R&G Advertising". It has its own domain name registration "rg-advertising.co.uk."
5. The Domain Name was registered on 1 August 2001 by Fibranet. Apart from the omission of the ampersand, it is identical to the name for which the Complainant has unregistered rights.
6. On 23 August, the Complainant received an e mail from [raygilladvertising@ireland.com](mailto:raygilladvertising@ireland.com) explaining that they had been receiving e mail for the Complainant and offering to

forward the e mail. The e mail was signed off "Ray Gill". The Complainant responded asking "Ray Gill" to call them to discuss the situation and confusion but no reply was ever received. The Complainant believes this e mail was an attempt to elicit a payment out of the Complainant for transfer of the Domain Name.

7. In April 2002 the Complainant discovered that the Domain Name was being diverted to a web site for homosexual men [www.gaymen.com](http://www.gaymen.com). The Complainant's solicitors sent an e mail to [raygilladvertising@ireland.com](mailto:raygilladvertising@ireland.com) complaining about this situation but the e mail was returned as undelivered "user unknown". Nominet then provided the address of Ray Gill Advertising as 51 Ranelagh Road Dublin 6, Ireland. The e mail from the Complainant's firm was then sent by hard copy to that address but it was subsequently returned as "not called for". The Complainant made several attempts to contact the Respondent including e mails, calls to Directory Enquiries, calls to trade associations, and visits to the residential premises at 51 Ranelagh Road Dublin, all to no avail. There has been no explanation for the Respondent's activities. There does not appear to be any bona fides reason for the registration of the Domain Name by the Respondent.
8. There is a risk that Internet Users will make a connection between the Complainant and the [gaymen.com](http://gaymen.com) site. The Managing Director of the Complainant is Mr Nigel Gay and the pointing of the site to [gaymen.com](http://gaymen.com) may be a (not very subtle) joke or a deliberate attempt by the Registrant to damage the Complainant's goodwill. Even if there is no confusion, there must arguably be a negative effect upon the Complainant's goodwill and reputation simply by association.
9. The registration of the Domain Name is unfairly detrimental to the Complainant's rights (taking into account the risk of confusion admitted by the Respondent in the context of the misdirected e mails) and has been used in a manner which is unfairly detrimental to those Rights (in diverting browsers to a web site of interest to gay men).

Respondent:

The Respondent has not filed a Response and is in default.

6. 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**

The Complainant is the proprietor of goodwill in the name and unregistered trade mark R & G ADVERTISING. The Domain Name consists of the same name or mark without the ampersand (which cannot be reflected in a domain name) and the suffix <.co.uk>. In assessing whether or not a name or mark is identical or similar to a domain name, it is appropriate to discount the domain suffix, which is of no relevant significance and wholly generic.

The Expert finds that the Complainant has rights in respect of a name or mark, which is similar to the Domain Name.

### **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, ii and iv, which read as follows:

- i "Circumstances indicating that the Respondent has registered or otherwise acquired the Domain Name:
  - A. primarily 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. primarily 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."
  - Iv "It is independently verified that the Respondent has given false contact details to us".

The Expert is of the opinion that the Respondent's conduct and use of the Domain Names is indicative of relevant abusive conduct.

The Respondent has not Responded and is in default. On the facts as presented and unchallenged there is no obvious reason why the Respondent might be said to have been justified in registering the Domain Name and no evidence has been produced to prove use of the Domain Name to point to a legitimate advertising business. Indeed the Domain Name has been pointed by the Respondent to a site for gay men of a sexual nature which has no connection to the Complainant or no ostensible connection with the name "rgadvertising". The Respondent has clearly used the Domain Name to disrupt the Complainant's business and arguably to confuse Internet users into thinking that the gaymen.com site is connected to or authorised by the Complainant. It also appears to be being used as a blocking registration against a name in which the Complainant has rights. Furthermore, pointing a domain name to a site which may be considered undesirable by a Complainant, such as a site of a sexual nature like gaymen.com, is a common technique used by cybersquatters to elicit a prompt monetary offer to purchase the relevant domain name. It also appears that the business Ray Gill Advertising may not exist, it could not be found via directories and the only contact address for the Respondent appears to be residential.

In the view of the Expert, by its registration and use of the Domain Name the Respondent took unfair advantage of and acted in a way unfairly detrimental to the Complainant's rights.

Accordingly, the Expert finds that the Domain Name is an Abusive Registration within the definition of that term in paragraph 1 of the Policy.

7. *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, rgadvertising.co.uk be transferred to the Complainant.*

\_\_\_\_\_  
29 August 2002

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**Dawn Osborne**

**Date**