

DISPUTE RESOLUTION SERVICE

DRS 07021

Decision of Independent Expert

In Line Duct Cleaning Ltd

and

Anderton Tiger LLP

1. The Parties:

Complainant: In Line Duct Cleaning Ltd
Address: The Barn, Paddocks Farm, High Street
Culworth
Northamptonshire
Postcode OX17 2BE
Country: GB

Respondent: Anderton Tiger
Address: The Bungalow
Chapel Lane
Brackley
Whitfield
Northamptonshire
Postcode: NN13 5TF
Country: GB

2. The Domain Name(s):

<inlineductcleaning.co.uk> (“the Domain Name”)

3. Procedural History:

This dispute was entered into the Nominet system on 18 March 2009 and Nominet validated the Complaint and took appropriate steps to notify the Respondent of the Complaint on the same date. On 9 April 2009 a Response was received from the Respondent. On 21 April 2009 a mediator was appointed. Informal mediation having failed to resolve the dispute, on

5 June 2009 the Respondent paid the fee to obtain the expert decision pursuant to paragraphs 8(b) and 21(a) and (d) of the procedure for the conduct of proceedings under the Nominet Dispute Resolution Service (“the Procedure”). On 5 June 2009, Christopher Gibson, the undersigned, was selected as the Expert. On 17 June 2009, I confirmed to Nominet that I knew of no reason why I could not properly accept the invitation to act as Expert in this case and further confirmed that I knew of no matters which ought to be drawn to the attention of the parties, which might appear to call into question my independence and/or impartiality.

4. Factual Background

Companies House records show that the Complainant was incorporated in the United Kingdom under the name IN LINE DUCT CLEANING LIMITED on 11 February 2003. The Complainant provides specialist cleaning of commercial kitchen extract systems.

As part of a previous business relationship between the parties to this dispute, the Domain Name was registered on behalf of the Complainant but in the name of Respondent on 31 January 2002. The Domain Name resolves to a web page which is blank, except for the following:

This domain is available for rent or sale or for use as an advertisement portal

Enquiries to webmaster@inlineductcleaning.com



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5. Parties' Contentions

Complainant

The Complainant has provided a short description of circumstances that are claimed to constitute an abusive registration by the Respondent because the Respondent is allegedly trying to profit from an “original deception back in 2002.”

The Complaint appears to have been prepared by Grant Marshall, who is the Managing Director and owner of the Complainant. He explains that his company was established by himself and Sarah Prue in 2002 as a limited liability partnership, In Line Duct Cleaning LLP. Sarah Prue was tasked with setting up a web site and email accounts for the company. She allegedly purchased the Domain Name, as well as the corresponding “.com” version, <inlineductcleaning.com>. However, she registered these domain names through her husband’s company, which is the Respondent, Anderton Tiger LLP. Marshall states that he was unaware of this. Approximately one year later, Sarah Prue decided that she no longer wanted to be a part of the Complainant’s business. Marshall bought her share of the Complainant’s business and changed the business from a limited liability partnership to a limited company, In Line Duct Cleaning Limited. At this point, Marshall claims he was still unaware that the Domain Names and its dot-com counterpart were not owned by the Complainant. He agreed to pay Respondent a yearly amount to maintain the Complainant’s web site.

In late 2005, Marshall discovered that the domain names were registered to the Respondent. When Marshall asked to have these domain names transferred to the Complainant, Sarah Prue’s husband, Russell Prue, demanded £10,000.00+VAT and costs for the two domain names. Marshall states that he could not afford this amount. He was forced to register <inlineductcleaning.net> and currently uses this domain name as the address for the Complainant’s web site. This change required Marshall to change all of his company’s letterhead and business cards, plus informing all of his existing customers.

The Complainant claims that registration of the Domain Name is abusive because the Respondent is trying to profit from the original deception back in 2002.

Respondent

The Respondent has provided a detailed response in support of its positions that:

1. the Complainant has not proven through its submission or attached evidence that it has enforceable exclusive rights in the name, In Line Duct Cleaning; and
2. the Complainant has not proven that the registration or subsequent retention of the Domain Name by the Respondent is abusive.

The Respondent confirms that on 31 January 2002, the Domain Name was registered (along with inlineductcleaning.com) by the Respondent. At the time, Respondent was in the business of hosting websites and dealing in

domain names as well as other business activities. The Domain Name was registered, having as its partners Grant Marshall and Sarah Prue. The Respondent agreed to register the Domain Name and host the website in return for an annual fee in accordance with the Respondent's standard terms and conditions. The Respondent has submitted a copy of those terms and conditions to show that clause 55 specifies that Respondent would retain ownership of the Domain Name:

"55. The Client agrees that the Domain Name(s) will remain the property of ANDERTON TIGER LLP at all times. ANDERTON TIGER LLP may at its discretion make the said Domain Name(s) available for sale, rental or renewal."

The Respondent contends that at no time was there any intent that these standard terms and conditions should be varied.

Rights

The Respondent argues that Complainant's name, In Line Duct Cleaning, is directly descriptive of the particular nature of cleaning service provided by the Complainant and, as such, there are very limited, if any, exclusive rights in the name enforceable under English Law.

During 2002-03, the limited liability partnership, In Line Duct Cleaning LLP, between Grant Marshall and Sarah Prue broke up. Subsequently, Marshall incorporated the Complainant on 11 February 2003. According to the Respondent, at this time there was a written agreement as to the disposal of assets and liabilities of the partnership, and this agreement was silent as to the Domain Name because it was registered to the Respondent in accordance with the Respondent's terms and conditions. There is no clear evidence that following the break up of the former partnership that any rights that did exist were transferred solely to the Complainant. Following these events, the Respondent continued to host the Domain Name for the Complainant under the same standard terms and conditions. According to the Respondent, the Complainant was happy to maintain the existing arrangement.

No Abuse

The Respondent maintains that the Domain Name was registered in good faith and in the full knowledge and agreement with the former limited liability partnership, In Line Duct Cleaning LLP. There was no intention by the parties at the time of registration that the Domain Name be registered to the former partnership. Accordingly, there was no abuse in the registration of the Domain Name by the Respondent.

The Respondent has provided evidence to show that on 9th November 2006, Grant Marshall inquired as to the potential sale of the Domain Name (and the corresponding .com domain name). At around this time, the Respondent was allegedly considering a change in business direction. As such, it would no longer be primarily engaged in hosting websites.

Accordingly, the Respondent states that it had the Domain Name valued by Accurate Domains Inc., an independent domain valuation agent. On 14 November 2006, Russell Prue of the Respondent emailed Grant Marshall to indicate that a value of £10,000 + VAT had been placed on the domain names following the valuation. An email is provided to show that on 15 November 2006, Marshall declined the opportunity to purchase the domain names for this price. Following this, Russell Prue indicated to Marshall that due to Prue's change in business direction, the Respondent would no longer be able to offer email and support services and thus was preparing to offer the domain names for sale on the open market, providing Marshall was not inclined to purchase them. On 30 November 2006, Marshall responded that once the current hosting arrangement ended on 23 January 2007, he would no longer need the domain names. To date, the Domain Name remains available for rent, sale or use as an advertisement portal. Accordingly, the Respondent contends that there has been no abuse in the ongoing retention of the Domain Name by the Respondent after November 2006.

At present, the Domain Name resolves to a simple homepage indicating that it is available for rent, sale or use as advertisement portal. Respondent asserts that there has been no attempt by the Respondent to divert customers away from the Complainant. In particular, there is no misrepresentation or deception in connection with the provision of in line duct cleaning services. Accordingly, there has been no abuse by the Respondent in retaining the Domain Name.

The Respondent also highlights that in December 2006, the Complainant registered the domains names <andertontiger.me.uk>, <andertontiger.org.uk>, <andertontiger.net>, <andertontiger.info>, <andertontiger.uk.com> and <andertontiger.org> in his own name. This was discovered in November 2007 by the Respondent. A DRS Complaint was filed by the Respondent on 26 August 2008 in view of the existing rights of the Respondent under their UK registered trade mark (No 2381474) and the alleged abusive registration of these domains names. Subsequent to the filing of the DRS Complaint, the Complainant transferred the domain names to the Respondent.

6. Discussions and Findings

GENERAL

Under paragraph 2 of the Dispute Resolution Service Policy ("the Policy") the Complainant is required to show, on the balance of probabilities, that;

(1) it has rights in respect of a name or mark which is identical or similar to the Domain Name; and

(2) the Domain Name in the hands of the Respondent is an Abusive Registration.

Complainant's Rights

In this case, the Domain Name, with the omission of spaces between relevant words of which it is comprised, is virtually identical to the Complainant's company name. However, the Respondent has argued that the Complainant's name is merely descriptive of the nature of cleaning service provided by the Complainant and, as such, attracts only minimal, if any, rights. In evidence there is a copy of the Companies House Certificate of Incorporation for the Complainant, along with a copy of the Complainant's letterhead and a certificate of registration for VAT purposes. Beyond these copies, however, the Complainant has made no effort to explain or show that it has acquired rights in its name, or the strength of any such rights. The Complaint is simply silent on this point.

"Rights" are defined in the Policy as "rights enforceable by the Complainant, whether under English law or otherwise, and may include rights in descriptive terms which have acquired a secondary meaning". The problem in this case is that the Complainant's name consists of descriptive terms and the Complainant has failed to make any showing that its name has acquired secondary meaning. I share the consensus view of recent Expert decisions that mere registration of a company name at the Companies House does not of itself give rise to any enforceable rights to prevent others from using a name. See Machine Building Systems Ltd and Thomas Murphy, DRS 07195. However, use of a name in the course of business, which is what the Complainant appears to have done, may be sufficient to establish such rights. Here, even Respondent acknowledges through the explanations in its submission that the Complainant has traded under its name since the date of incorporation in February 2003.

Given the descriptive nature of the Complainant's name, and without any sufficient explanation or showing from the Complainant, the Expert is reluctant to make any finding concerning the Complainant's rights in its name, or the strength of such rights. While it is likely that the Complainant, who has traded for a number of years, would have been able to establish the minimum showing of enforceable rights in its name if it had done a better job of preparing its Complaint and supporting evidence, I do not need ultimately to reach this question, because even assuming that the Complainant has established the requisite rights in its name, I find below that the Complainant has failed to prove, on the balance of probabilities, that the Domain Name is an Abusive Registration.

Abusive Registration

In order to show that the Domain Name is an Abusive Registration, the Complainant must prove that the Domain Name either:-

- i. 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.

In this case, the Complainant appears to argue that its owner, Grant Marshall, was deceived in 2002 about the registration and ownership of the Domain Name to the Respondent, and remained unaware that the Domain Name was actually registered to the Respondent until late 2005. Although it is less than completely clear, the Complainant appears to blame not only the Respondent for this alleged deception, but also Sarah Prue, who was previously the Complainant's partner and is also the spouse of the Respondent's owner.

The Respondent has submitted a credible explanation and unrebutted evidence to show that it registered the Domain Name (i) at the request of the Complainant's predecessor in interest, the former limited liability partnership In Line Duct Cleaning LLP, and (ii) in accordance with the standard terms and conditions of the service agreement between the Respondent and the Complainant's predecessor. The terms and conditions, as noted above, provide that any "Domain Name(s) will remain the property of ANDERTON TIGER LLP at all times" and that "ANDERTON TIGER LLP may at its discretion make the said Domain Name(s) available for sale, rental or renewal." While these terms may appear surprising, according to them the Respondent was within its contractual rights to retain the Domain Name and was free to offer it for sale to the Complainant, even at what appears to be a high price. In addition, the email correspondence between the Respondent and the Complainant during the relevant period in 2006 reveals that the Complainant raised no objections about the Respondent's ownership of the Domain Name (and corresponding .com domain name) or offers to sell them. Instead, Grant Marshall merely wrote that he could not afford to buy the domain names and that

"I understand that I have paid for the hosting of the domains up until the 23rd Jan 07 as per your invoice... Once this has expired I will no longer need these domains."

The Expert can appreciate that the Complainant may have been unaware, for a lengthy period, of the essential contractual terms by which the Respondent registered the Domain Name in connection with the web site hosting and related services provided to the Complainant and its predecessor. The Complainant may even have been surprised and unhappy when confronted with a request for payment of £10,000 to buy a Domain Name registration that it previously thought it had already owned. However, the Respondent's actions in this regard, both at the time of registration and thereafter, do not appear to have been abusive. The Respondent was acting in accordance with the terms of a contract under which services and payment had been exchanged between the parties for more than four years. And importantly, the Complainant has provided no explanation or evidence to show the Sarah Prue, acting as Grant Marshall's partner at the time when (according to Complainant) she was "tasked with setting up a web site and email accounts for the company", did so

improperly or without authority to bind the Complainant's predecessor when dealing with the Respondent. If there are allegations of unfair treatment due to the fact that Sarah Prue was not only Grant Marshall's former partner, but also married to the owner of the Respondent, the Complainant has not provided explanation or evidence to support them.

Conclusion

In view of all of the above, the Expert finds that the Complainant has failed to prove, on the balance of probabilities, that the Domain Name, in the hands of the Respondent, is an Abusive Registration.

7. Decision

For the reasons set out in detail above, having decided that the Domain Name in the hands of the Respondent is not an Abusive Registration, the Expert directs that no action is required.

Signed: Christopher Gibson

Dated: 7th July 2009