

## **DISPUTE RESOLUTION SERVICE**

**DRS 007325/007328**

### **Decision of Independent Expert**

Ideal Tanks & Pumps Limited

and

Timothy Bannister

## **1 PARTIES**

Complainant: Ideal Tanks & Pumps Limited

Address: The Gas Station, Rugby Road,  
Harlestone  
Northampton  
Northamptonshire

Postcode: NN7 4ER

Country: UK

Represented by: Katherine Page  
123 Colwyn Road  
Northampton  
Northamptonshire  
NN1 3PU

Respondent: Timothy Bannister

Address: 2 Lodore Gardens  
Northampton

Postcode: NN3 2AS

Country: UK

## **2 DOMAIN NAMES**

2.1 idealtanksandpumps.co.uk and idealtanks.co.uk - the subject of DRS 007325 ("7325 Domain Names").

2.2 idealtanksandpumpslimited.co.uk and idealtanksandpumpsltd.co.uk – the subject of DRS 007328 ("7328 Domain Names")

2.3 The 7325 Domain Names and 7328 Domain Names are referred to collectively in this Decision as "the Domain Names".

### 3 PROCEDURAL BACKGROUND

- 3.1 The procedural background is the same for both DRS 007325 and DRS 007328. On 4 June 2009 Nominet received the complaints. On 5 June 2009 the complaints were validated and on the same day the electronic responses were received. On 11 June 2009 the electronic replies were received. On 8 July 2009 Nominet received the complaint fees from the Complainant.
- 3.2 On 9 July 2009 Patricia Jones ("the Expert") confirmed to Nominet that she knew of no reason why she could not properly accept the invitation to act as expert in DRS 007325 and DRS 007328 and further confirmed that she knew of no matters which ought to be drawn to the attention of the parties which might call into question her independence and/or impartiality.
- 3.3 The Expert was appointed on 10 July 2009 for DRS 007325 and DRS 007328.
- 3.4 This decision is for both DRS 007325 and DRS 007328.

### 4 THE FACTS

- 4.1 The 7325 Domain Names were registered on 1 October 2007. The 7328 Domain Names were registered on 20 October 2007.
- 4.2 The Complainant was incorporated on 16 June 1967 and has been providing services under the name Ideal Tanks & Pumps since 1958. These include the supply, installation, maintenance and decommissioning of tanks and pumps.
- 4.3 As well as the Domain Names, a number of other domain names have been registered, details of which are set out in the Table below.

	Domain Name	Date of Registration	Registrant
1	idealtanksandpumps.co.uk	01/10/2007	esolutionsonline
2	idealtanks.co.uk	01/10/2007	esolutionsonline
3	idealtanksandpumpsLtd.co.uk	20/10/2007	Timothy
4	idealtanksandpumpslimited.co.uk	20/10/2007	Timothy
5	idealtanksandpumps.com	01/10/2007	Timothy Bannister esolutionsonline
6	idealtanks.com	01/10/2007	Timothy Bannister esolutionsonline
7	idealtanksandpumpsLtd.com	19/10/2007	Timothy Bannister

8	idealtanksandpumpslimited.com	19/10/2007	Timothy Bannister
9	tanksandpumps.co.uk	21/04/2008	Timothy Bannister
10	idealtanksandpumps.net	19/12/2008	Timothy Bannister
11	idealtanksandpumps.biz	19/12/2008	Timothy Bannister
12	idealtanksandpumpsLtd.net	19/12/2008	Timothy Bannister
13	idealtanksandpumpsLtd.biz	19/12/2008	Timothy Bannister
14	idealtanksandpumpslimited.net	19/12/2008	Timothy Bannister
15	idealtanksandpumpslimited.biz	19/12/2008	Timothy Bannister

- 4.4 On 15 December 2008 the Complainant's representative, Katherine Page, wrote to the Respondent in relation to the domain names listed at numbers 1 to 8 of the Table above stating that the Complainant will be launching their website soon and given the suitability of these domain names asked if the Respondent would be willing to transfer ownership of them to the Complainant.
- 4.5 On 15 December 2008 the Respondent replied stating that he was currently holding these domains on behalf of a client. However, he was willing to facilitate negotiations on the release of these domains. If Ms Page can contact her client for details of acceptable terms the Respondent was happy to pass them on to his client for review.
- 4.6 On 18 December 2008 Ms Page replied proposing a payment of £200 (ex VAT) comprising £20 per domain and a transfer fee for each .co.uk domain.
- 4.7 On 18 December 2008 the Respondent stated that he would pass this on to his client "*however my client had instructed me not to release these domain names under any circumstances*". On 22 December 2008 Ms Page asked to be notified of the client's response but nothing further was heard.

## 5 THE PARTIES' CONTENTIONS

- 5.1 The complaint, response and reply in DRS 007325 and DRS 007328 are substantially the same so I will deal with them together.

## The Complaint

- 5.2 The Complainant believes that "Timothy", the registrant of the 7328 Domain Names and esolutionsonline, the registrant of the 7325 Domain Names are the same entity because:
- (a) They both used the same registrar to register the Domain Names in the same month.
  - (b) Ms Page received a reply from an esolutionsonline.biz address (tim@) during her e-mail correspondence with the Respondent.
- 5.3 The Complainant contends that the Respondent's client is Mr David Turner, a former employee of the Complainant and states the following:
- (a) During his employment Mr Turner made it known that he was formerly known as Andrew McGlynn. The birth certificate of an Andrew James McGlynn who has the same date of birth as that of Mr Turner in the Complainant's records, gives his mothers maiden name as Turner.
  - (b) Records show that an Andrew James McGlynn had a daughter Carli McGlynn who married a Timothy James Bannister. The Complainant contends that Mr David Turner is the Respondent's father in law.
  - (c) Mr David Turner left the Complainant's employment on 23 May 2008. On 28 April 2008, Turner Tanks Limited, a competitor company to the Complainant was incorporated. The Complainant contends that Mr David Turner is a director of Turner Tanks Limited. The address given for Mr David Turner in the company records for Turner Tanks Limited is the same as that for Mr David Turner in the Complainant's pay roll records.
  - (d) The domain name turnertanks.co.uk was registered on 24 June 2007. The registrar is Nathan Barnes t/a Webmania, the same registrar as for the Domain Names. The Complainant believes that photographs on the website resolved to from turnertanks.co.uk are of works carried out by the Complainant during Mr Turner's employment.
  - (e) The Domain Names were purchased before Mr Turner left the Complainant's employment.
- 5.4 The Complainant contends that the Domain Names together with the other domains listed at numbers 5 to 8 of the Table were registered by the Respondent at Mr Turner's request to prevent the Complainant from creating a web presence for its business. The Complainant contends that this is the case for the following reasons:
- (a) No website has been created for the Domain Names.
  - (b) The Respondent stated to Ms Page that his client "*had instructed me not to release these domain names under any circumstances*".
  - (c) All the most likely variations of the domain name have been purchased suggesting an effort to achieve blanket coverage registration.

- (d) To the Complainant's knowledge, neither the Respondent nor Mr Turner has any connection with the name Ideal Tanks & Pumps such as to warrant their ownership of the Domain Names for any legitimate reason.
- 5.5 The Complainant contends that whilst the Domain Names remain in the hands of the Respondent:
- (a) There is a potential for a website to be created for a competitor business which could capitalise on the Ideal Tanks & Pumps name, which would be misleading and confusing for existing and potential customers.
  - (b) Should the Complainant use a similar domain name (such as idealtankspumps.co.uk which has recently been registered on the Complainant's behalf) there would be a real possibility of a potential client mis-spelling the Complainant's e-mail address and directing business to the competitor company.
  - (c) The images of the Complainant's installations on the website at turnertanks.co.uk
    - (i) is evidence of the abusive nature of the Domain Names registrations;
    - (ii) furthers the potential confusion between the Complainant and Turner Tanks Limited especially if:
      - (A) the Complainant is unable to create a useful web presence under its own trading name; and
      - (B) potential enquiries sent in error to one of the domains owned by Turner Tanks Limited are responded to by Mr Turner.
- 5.6 The Complainant contends that it is very possible that the Complainant could lose business to Turner Tanks Limited in this way. This places a restriction on the Complainant in creating a web presence under a meaningful domain name.
- 5.7 The Complainant contends that the Domain Names registrations are abusive under DRS Policy Paragraph 3(a)(i) B as a blocking registration against the Complainant's trading name and under Paragraph 3(a)(i) C for the purpose of unfairly disrupting the Complainant's business. The Complainant also contends that the Domain Names are incorrectly registered according to DRS Policy Paragraph 3(a)(iv) since there is neither an individual's full name registered nor a company registration number given.

### **The Response**

- 5.8 The Respondent contends that he purchased domains in 2007 and 2008 for a company he is setting up called Ideal Tank Sand Pumps. The Respondent states that he is developing sand pumps for possible military applications, due to the current climate he is hesitant to start trading but is laying the foundations by buying all available domain names and continuing product development. The Respondent contends that to give away these domains would cause him significant hardship and could possibly prevent him from going into business. He states that he has commissioned a website, purchased stationary and sign writers for his vehicles, all this would need to change and be paid for.

### **The Reply**

- 5.9 The Respondent states *"I purchased domains between 2007 and 2008"*.
- (a) The 7325 Domain Names were registered on 1 October 2007 with the intention of blocking the Complainant and the 7328 Domain Names were registered on 20 October 2007 as an additional idea of how to fully prevent the Complainant setting up a website with a meaningful domain name.
  - (b) From the Response, the Complainant has become aware of the domain names listed at items 9 to 15 of the Table. Tanksandpumps.co.uk was registered on 21 April 2008 one month before Mr Turner left the Complainant's employment and the remainder of these domains were purchased on 19 December 2008, the day after the e-mail from the Respondent to Ms Page (see paragraph 4.7). It is the Complainant's belief that the Respondent registered these domains purely with the intention of blocking the Complainant.
  - (c) In his e-mail exchange with Ms Page the Respondent claims to be holding the Domain Names on behalf of a client. There is no mention of the company he now claims to be setting up.
- 5.10 The Respondent states, *"these are for a company I am setting up called Ideal Tank Sand Pumps"*.
- (a) The Complainant considers that it would have a right in passing off to prevent the Respondent trading under this name, thereby rendering the Domain Names irrelevant to the Respondent and his proposed new business.
- 5.11 The Respondent states *"I am laying the foundations by buying all available domain names"*.
- (a) The Complainant considers it unusual that the Respondent would purchase idealtanks.co.uk, not directly related to his proposed new business, but not buy domains such as idealsandpumps.co.uk, which has direct relevance. The Complainant also considers it surprising that the Respondent would go to the trouble of buying up all possible variations to achieve blanket coverage before he has registered his business name and this is especially true for the 7328 Domain Names.
  - (b) The Complainant considers that its name means that Ideal Tank Sand Pumps Limited would not be available for registration and there would then be little point in the Respondent owning the Domain Names except for the purposes of blocking.
- 5.12 The Respondent states *"To give away these domain names would cause me significant hardship and could possibly prevent me from going into business."*
- (a) The Complainant states that as the Respondent has not started trading under his proposed business name he will not yet have built up any goodwill of his own and it cannot therefore understand how giving away the Domain Names could prevent the Respondent from going into business. The Complainant also questions the significant hardship referred to.
- 5.13 The Respondent states *"We have commissioned a web site, purchased stationary and sign writers for our vehicles all this would need to change and be paid for."*

- (a) The Complainant considers this could indicate the Respondent's intent to extract money from the Complainant should it decide to negotiate the domain transfers during mediation.
- (b) There is no evidence supplied to back up the Respondent's claims. It is unclear whether he has paid any money for the website said to have been commissioned or whether the vehicles have been sign written.
- (c) The Complainant believes that the Respondent's business is within IT. Mr Turner offered the services of his son in law to another employee of the Complainant as a web designer whilst in the Complainant's employment. The Complainant considers it is surprising that the Respondent has had such a radical career change, to the development of a sand pump for such an exacting sector as the military.
- (d) It is a remarkable coincidence that the Respondent chose to set up a company with an identical spelling to Ideal Tanks & Pumps Limited, a company for whom his father in law was employed for eight years and who now runs a rival company.

## **6 DISCUSSION AND FINDINGS**

- 6.1 There are a number of domains referred to in the complaint. This decision is concerned only with the Domain Names.
- 6.2 Paragraph 2 of the Nominet Dispute Resolution Policy ("the Policy") sets out that for the Complainant's complaint to succeed it must prove to the Expert that:
  - (i) The Complainant has Rights in respect of a name or mark which is identical or similar to the Domain Names; and
  - (ii) The Domain Names, in the hands of the Respondent, are an Abusive Registration.
- 6.3 The Complainant is required to prove to the Expert that both elements are present on the balance of probabilities.

### **Complainants Rights**

- 6.4 Paragraph 1 of the Policy states that "Rights means rights enforceable by the Complainant whether under English law or otherwise and may include rights in descriptive terms which have acquired a secondary meaning."
- 6.5 It is well accepted that the question of Rights falls to be considered at the time that the Complainant makes its complaint.
- 6.6 The Complainant has been trading as Ideal Tanks & Pumps for about 50 years and during that time I am satisfied that it has built up trading goodwill in that name. Whilst this name could arguably be considered descriptive of a characteristic of the goods supplied, i.e. that the tanks and pumps are "ideal", I consider that having regard to the length of use of the name, if it is a descriptive term then it has acquired a secondary meaning.

- 6.7 I am therefore satisfied that the Complainant has Rights in a name or mark which is identical or similar to the Domain Names.

### **Abusive Registration**

- 6.8 The question is therefore whether the Domain Names, in the hands of the Respondent, are 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 has taken unfair advantage of or has been unfairly detrimental to the Complainant's Rights.

- 6.9 I consider that as the Domain Names have not been used the issue to focus on is whether the Domain Names in the hands of the Respondent are an Abusive Registration under Paragraph 1(i) of the Policy.

- 6.10 There are a non-exhaustive list of factors under the Policy which may be evidence that the Domain Names are an Abusive Registration which include those cited by the Complainant:

- (a) Paragraph 3(a)(i): Circumstances indicating that the Respondent has registered or otherwise acquired the Domain Name primarily:

B: as a blocking registration against a name or mark in which the Complainant has Rights; or

C: for the purposes of unfairly disrupting the business of the Complainant.

- (b) Paragraph 3(a)(iv): It is independently verified that the Respondent has given false contact details to us.

- 6.11 Paragraph 3b of the Policy makes it clear that failure on the Respondent's part to use the Domain Name for the purposes of e-mail or a web-site is not in itself evidence that the Domain Name is an Abusive Registration.

- 6.12 There are also a non-exhaustive list of factors under the Policy which may be evidence that the Domain Name is not an Abusive Registration including:

- (a) Paragraph 4(a)(i) Before being aware of the Complainant's cause for complaint (not necessarily the complaint under the DRS) the Respondent has:

A: used or made demonstrable preparations to use the Domain Name or a domain name which is similar to the Domain Name in connection with a genuine offering of goods or services.

- 6.13 For there to be an Abusive Registration under Paragraph 1(i) of the Policy it must be established that the Respondent had knowledge of the Complainant and/or its rights at the time of registration of the Domain Names.



- 6.14 The registrant of the Domain Names is "Timothy" and "esolutionsonline". I am, however, satisfied that the Respondent registered the Domain Names. The Respondent admits to purchasing the Domain Names in his Response and it is also clear from the registrant details for the .com equivalents to the Domain Names, registered at the same time as the Domain Names (see Table), that "esolutionsonline" is a name that the Respondent uses.
- 6.15 In his e-mail exchange with Ms Page (see paragraphs 4.4 to 4.7), the Respondent states that he is holding the Domain Names on behalf of a client. However his response is inconsistent with this. In his response the Respondent states that the Domain Names were purchased for his own purposes, namely for a company he is setting up called Ideal Tank Sand Pumps.
- 6.16 I should say at the outset that I am wholly unconvinced by the Respondent's explanation for registering the Domain Names. He states *"to give away these domains would cause me significant hardship and could possibly prevent me from going into business. I have commissioned a web site, purchased stationery and sign writers for our vehicles all this would need to change and be paid for."* At the same time the Respondent states that he is *"hesitant to start trading"* and is *"laying the foundations by buying all available domain names and continuing product development"*. So whilst the Respondent states he is hesitant to start trading, he also states that he has done exactly the type of things necessary to trade (e.g. website, stationary, signage on vehicles). It is significant that the Respondent has provided no evidence whatsoever to support that he is setting up a company, on product development or in relation to the purported website, stationary or signage.
- 6.17 I am satisfied on the basis of the birth and marriage records, payroll and company records adduced by the Complainant that the Respondent is the father in law of Mr David Turner who was a former employee of the Complainant and is now a director of a competing business. The Domain Names were registered during Mr Turner's employment. I also note that the marriage certificate adduced by the Complainant for the Respondent records his occupation in 2006 as a systems analyst. This is indicative that the Respondent's response lacks credibility without supporting evidence, given that the development of sand pumps for tanks with possible military applications is an activity quite different from systems analysis.
- 6.18 On the basis of the relationship between the Respondent and Mr Turner and the Respondent's statement that the Domain Names were purchased on behalf of a "client", who I consider was Mr Turner, an employee of the Complainant at the time of registration of the Domain Names, I am satisfied that at the time of registration of the Domain Names the Respondent had knowledge of the Complainant and/or its Rights.
- 6.19 I am also satisfied that the Domain Names were registered primarily as blocking registrations against a name or mark, Ideal Tanks & Pumps, in which the Complainant has Rights or for the purpose of unfairly disrupting the business of the Complainant. The Respondent registered the Domain Names when his father-in-law, Mr David Turner, was employed by the Complainant and when as an employee Mr Turner had no legitimate interest in the Domain Names. Mr Turner would have known that as an employee, owing duties of honesty and fidelity to his employer, he should not register or procure the registration of the Domain Names. I consider that the registration of the Domain Names was connected with the competing business which Mr Turner subsequently set up during his employment with the Complainant (Turner Tanks Limited was incorporated during his employment), and they were made primarily to prevent the Complainant from registering the Domain Names and to disrupt any internet presence that the Complainant decided to

establish. That is why the Respondent had been instructed by Mr Turner "*not to release these domain names under any* circumstances". The registration of the .com equivalents to the Domain Names at about the same time as the Domain Names is further evidence that the Domain Names were registered as blocking registrations or for the purposes of unfairly disrupting the business of the Complainant.

- 6.20 I therefore find that the Domain Names were registered in a manner, which, at the time when the registration took place, took unfair advantage of, or was unfairly detrimental to the Complainant's Rights.
- 6.21 Finally for completeness I deal with the Complainant's allegations under Paragraph 3(a)(iv) of the Policy namely that it is independently verified that the Respondent has given false contact details. The Complainant states that neither an individual's full name or a company registration number is given for the Domain Names. I do not consider this is in itself sufficient to satisfy Paragraph 3(a)(iv). The Complainant has not established that false contact details have been given, for example by providing independent evidence to explain how the contact details are known to be false. I therefore have not relied on this Paragraph of the Policy when coming to my Decision.

## **7 DECISION**

- 7.1 I find that the Complainant has Rights in a name or mark which is identical or similar to the Domain Names.
- 7.2 I find that the Domain Names in the hands of the Respondent are an Abusive Registration.
- 7.3 I direct that the Domain Names be transferred to the Complainant.

**Signed:** Dr Patricia Jones

**Dated:** 3 August 2009