

DISPUTE RESOLUTION SERVICE

D00009048

Decision of Independent Expert

Donald Ross Estate Agents Limited

and

Mr Donald Ross

1. The Parties

Complainant: Donald Ross Estate Agents Limited
11 Beresford Terrace
AYR
Ayrshire
KA7 2ER
United Kingdom

Respondent: Mr Donald Ross
6 Chalmers Road
Ayr
Ayrshire
KA7 2RQ
United Kingdom

2. The Domain Name

donaldrossdonaldross.co.uk

3. Procedural History

The Complainant filed the Complaint on September 15, 2010.
The Respondent filed a Response on October 4, 2010. A Reply

from the Complainant was filed October 12, 2010. Mediation was commenced on October 20, 2010, but did not succeed. The Expert decision payment was received on 23 November 2010 and Dawn Osborne of Palmer Biggs Legal was appointed as Expert on 24 November, 2010 having provided a declaration of independence. A deadline for the Decision was set of December 20, 2010.

4. Factual Background

This Complaint about the registration of the Domain Name donaldrossdonaldross.co.uk is part of a wider dispute between the Complainant, Donald Ross Estate Agents Limited, and the Respondent, Mr Donald Ross. The Respondent is a chartered surveyor who in 2005 sold the Donald Ross Estate Agents business, including the domain name donaldross.co.uk, to the Complainant.

5. Parties' Contentions

The Complainant's submissions can be summarised as follows:

The Complainant is the limited company, Donald Ross Estate Agents Limited, the registrant of donaldross.co.uk. It acquired its estate agency business in Ayr from the former proprietor Mr Donald Ross, the Respondent. As part of an Asset Purchase Agreement dated October 28, 2005 ("the Agreement") it acquired the goodwill of the business of estate agency and chartered surveyor previously carried on by the Respondent and the IP rights of the business: trade marks; trade names and domain names whether registered or registrable including the business name Donald Ross Estate Agents and the trade mark which is an "R" design. The Complainant says that it paid a substantial amount of money to the Respondent for this business.

The Respondent was subject to a restrictive covenant included in the Agreement which precluded him from entering into business in competition with the Complainant for a period of 5 years after completion.

The Complainant continued to trade within Ayr and it has invested a substantial amount of time and money in its website at donaldross.co.uk which is an important and necessary part of the success of its business.

The Respondent has over the last 2 years been trading within Ayr under the trading name of Ross Professional as a chartered surveyor principally undertaking the production of home reports and using the domain name rossprofessional.com.

As the period of the restrictive covenant came to an end the Complainant became aware of Mr Ross' intention to re-enter the residential property market and noticed in a press article that the Respondent had registered the Domain Name, but no site has currently been established.

The Domain Name is an abusive registration. The Complainant is asserting its rights in the domain name donaldross.co.uk and its intellectual property rights in both the name and the goodwill of the business of the Complainant and wishes to guard against passing off.

There is no legitimate reason for the Respondent to register the Domain Name.

The Respondent has registered the Domain Name to disrupt the flow of business to the Complainant and to interfere with its enjoyment of the donaldross.co.uk domain name which he originally owned and sold to the Complainant. The motive is to disrupt the business of the Complainant and to unfairly divert business which should go to the Complainant's website.

The Respondent's Response can be summarised as follows:

The Respondent sold Donald Ross Estate Agents the residential sales business to the Complainant in October 2005 including its goodwill, intellectual property rights, the R brand and domain name donaldross.co.uk.

The surveying qualification is personally held by the Respondent and is not transferable. This was recognised in the Agreement. The Respondent was also bound to supply consultancy services to the Complainant and there was no purchase of Ross

Properties, a substantial property portfolio. It was also made clear that the Respondent would be continuing with other interests which were varied and geographically widespread. There was a long non compete clause, but the Agreement did not contain an absolute prohibition on residential business, only a 5 year restriction within Ayrshire, although no residential business was, in fact, undertaken. The presumption that the Domain Name will be used for estate agency is wrong. To trade as an estate agent requires registration with the Office of Fair Trading for money laundering purposes and no such registration has taken place. There is no intention to trade with the name Donald Ross in a style with green and gold, with the R logo or to imitate the style of the Complainant's business.

The Respondent's real name is Donald Ross. The Complainant is intent on preventing any form of reference to the name of Donald Ross, the natural person and his wife, which is ridiculous. To operate as an individual, surveyor, businessman, partner, director and husband it is essential that Donald Ross and his wife be able to be identified in their own names on websites, in directories and in newspapers and the media without interference.

There has been a finding of the Scottish Court in the Respondent's favour in a dispute with the Complainant and the Ayrshire Post rejected the attempts of the Complainant to prevent references to Donald Ross after the newspaper took advice from its lawyers.

There is considerable scope in the Agreement to resolve disputes which should be exhausted first before the Domain Name is cancelled.

The Complainant has also tried to promote itself as having chartered qualifications which it does not have and has been involved in the distribution of anonymous letters to business contacts for Ross Professional including outside Ayrshire.

The Respondent is a Fellow of the RICS, a member of the Royal Agricultural College and a prominent local figure. The Complainant is trying to disrupt a new business in a new field which did not exist at the time it purchased the Donald Ross Estate Agents business.

The Respondent has not breached the Agreement with the Complainant. In any event the Agreement does not preclude own name use or like name use and was revised specifically to allow own name use. The Respondent would like to challenge the Complaint in Court and seek costs.

The Complainant replied as follows:

Whilst the Complainant does not know the intended use of the Domain Name it is the Respondent's intention to re-enter the estate agency market as evidenced by an advertorial in the Ayrshire Post. The registration is abusive even if the Respondent intends to use it for something else as it seeks to divert traffic from the Complainant's website.

The Complainant does not dispute that the Respondent can operate in the estate agency field, but his reference to using the Ross Professional domain name for that business illustrates that the registration of the Domain Name is abusive.

The Complainant has no problem with the Respondent operating as a chartered surveyor or using the domain name he has registered, donaldrosssurveyor.co.uk, for that purpose.

The Court proceedings which the Respondent started for a declaration that he was entitled to carry out services in the field of commercial estate agency and produce home reports is irrelevant to these proceedings. The Complainant did not dispute this.

The Ayrshire post did not rerun the use of the Domain Name after the first advert complained of by the Complainant. The second and third adverts used donaldrosssurveyor.co.uk instead.

This is a dispute to be determined by Nominet not the Asset agreement.

The Respondent's allegations of bad faith by the Complainant are outrageous and defamatory and, are in any event, irrelevant. The Complainant has no knowledge of any circular letter which it did not send.

The advertising to which the Respondent refers is two years old and irrelevant.

The position of the Respondent in the community and his qualifications are irrelevant to this dispute. He intends to run a residential estate agency business and has no legitimate basis for the registration of the Domain Name.

6. Discussions 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 the business Donald Ross Estate Agents Limited and the reputation and goodwill in its trading name, the distinctive part of which is "Donald Ross". The Domain Name, apart from the suffix .co.uk which may be ignored for the purposes of the Policy, consists of a double version of the Respondent's real name, which is also Donald Ross. Given the common distinctive words "Donald Ross" in both, the Expert finds that the Complainant has Rights in respect of a name or mark which is 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, given false contact details, registered the Domain Name on behalf of the Complainant or has tried to sell the Domain Name, the only potentially relevant 'factors' in paragraph 3 are to be found in subparagraph i and ii which read as follows:

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 purpose of unfairly disrupting the business of the Complainant;"

ii "Circumstances indicating that the Respondent is using or threatening to use the Domain Name in a way which has confused or is likely to confuse people or businesses into believing that the Domain Name is registered to, operated or authorised by, or otherwise connected with the Complainant".

The Complainant alleges that the Respondent intends to use the Domain Name to disrupt the flow of business to the Complainant's site and to divert business to the Respondent's site which ought to go to the Complainant's site.

The Respondent remains able to use his own name under the terms of the Agreement and maintains that the name is not to be used to breach this contract. Specifically he says it is not to be used for estate agency or with the name Donald Ross Estate Agents or with livery similar to that of the Complainant. The Respondent maintains that he should be allowed to use his own name for purposes which do not breach the Agreement, points out that the Scottish Court has already made a determination on the meaning of that contract and says that such matters

should be determined by a Court. He says he has not breached the Agreement.

There is no evidence relating to the purpose for which the Domain Name will be used other than the Respondent's statement that it will not be used for estate agency business. The Expert agrees with the Respondent that this is not a clear cybersquatting case appropriate to be determined under the Policy. It appears rather this is a case of competing trade mark rights with a complex history where the hearing of evidence may be necessary to determine if there has been a breach of contract or any intellectual property rights. There is no evidence at present that the Domain Name is an Abusive Registration under the Policy. Accordingly, the Expert declines to find 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 which is similar to the Domain Name but that in the hands of the Respondent it has not been shown that the registration is an Abusive Registration, the Expert directs that the Domain Name, donaldrossdonaldross.co.uk, remain with the Respondent.

Signed : Dawn Osbone

Dated: 17 December 2010