

## DISPUTE RESOLUTION SERVICE

DRS 09156

### Decision of Independent Expert

John Rich Architects Limited

and

Dr Rami Bekhit

#### 1. The Parties:

Lead Complainant:	John Rich Architects Limited
Address:	9 Mortlake Terrace Kew Green Richmond Upon Thames Surrey
Postcode	TW93DT
Country:	GB
Respondent:	Dr Rami Bekhit
Address:	39 Popes Avenue Strawberry Hill Twickenham Middlesex
Postcode:	TW2 5TP
Country:	GB

#### 2. The Domain Name(s):

johnricharchitects.co.uk (the "Domain Name")

#### 3. Procedural History:

15 October 2010	Nominet validated the Complaint
15 October 2010	Nominet sent the Complaint to the Respondent
18 October 2010	Response received and notification sent to Complainant
25 October 2010	Reply received and notification sent to Respondent
8 November 2010	Mediation failed
17 November 2010	David King appointed as Expert Reviewer
17 November 2010	Steve Ormand appointed as Expert

Definitions used in this decision have the same meaning as set out in the Nominet UK Dispute Resolution Service Policy Version 3, July 2008 (the “Policy”) and/or the Nominet UK Dispute Resolution Service Procedure Version 3, July 2008 (the “Procedure”) unless the context or use indicates otherwise.

#### **4. Factual Background**

The Complainant is a practice of architects established by John Rich in the Richmond area in 1985. The practice traded originally as John Rich Architects.

The practice is regulated by the Royal Institute of British Architects (RIBA) and the Architects Registration Board (ARB).

The practice was incorporated on 16 September 2004 as John Rich Architects Limited. John Rich is the managing director.

The Complainant was appointed by the Respondent at the end of 2001 to provide architectural services in relation to an enlargement to the Respondent's property. The appointment was terminated following a rejection from the local authority planning department in relation to the proposed enlargement.

The Domain Name was registered to the Respondent on 27 November 2003.

#### **5. The Parties' Contentions**

The parties' contentions are extensive and are, in the main, set out verbatim (save for the correction of typographical errors and appropriate amendments to suit the formatting and context of the decision).

##### **The Complaint**

The Complainant contends that it has Rights in the name John Rich Architects because:

1. John Rich Architects is a practice of architects established by John Rich in the Richmond area in 1985 (VAT Advice of Registration provided). Since that date the practice has provided professional architectural services in the Richmond area uninterrupted for 25 years (letterhead from 1989 provided).
2. The practice was incorporated on 16 September 2004 as John Rich Architects Limited (registration documents provided).
3. The Complainant has owned the rights to the following domain names:
  - a. www.jrarch.force9.co.uk (1999-2002)
  - b. www.jrarch.co.uk (2002-2004)
  - c. www.johnricharchitects.com (2004- present)
4. John Rich was the principal of John Rich Architects and is now managing director of John Rich Architects Limited.
5. Accordingly the Complainant asserts that:
  - a. The Domain Name is identical to its company name;
  - b. The Domain Name is identical to its trading name;
  - c. The Domain Name is identical to John Rich's personal name.

The Complainant contends that the Respondent's registration and use of the Domain Name is an Abusive Registration because:

1. The Respondent offered to sell the Domain Name for more than the Respondent paid for it. This is advertised on the website to which the Domain Name resolves (copy provided).
2. The Respondent is an ex-client of the Complainant's who has complained unsuccessfully to John Rich's professional regulatory body ARB. The essence of that complaint was refuted in detail by the Complainant. Many of those complaints are now posted on the website to which the Domain Name resolves.
3. The Domain Name has been used to confuse internet users since it frequently appears on the front page of Google when "John Rich Architects" is entered as a search term.
4. The website to which the Domain Name resolves shows a photograph of a building which is completely unconnected to the Complainant's practice.
5. This website contains what is purported to be a copy of a letter sent to the Respondent by ARB concerning the Respondent's complaint to ARB. In fact, this letter has been doctored and does not present the letter as written by ARB. The letter has been changed by the Respondent in a manner which makes it appear that ARB considered the service provided by the Complainant to the Respondent to have been incompetent. (copies of the ARB letter provided). ARB has written to the Respondent twice (copy of one letter provided) demanding that the doctored letter be removed. The Respondent has complied with ARB's request but re-posts the doctored letter later.
6. The Respondent has also attempted to register the Complainant's practice through the email address connected to the Domain Name with websites advertising a range of services that have no connection to the Complainant's business as architects.
7. The Complainant provides a copy of an email from the johnricharchitects.co.uk email address forwarded by an advertising agency. The Complainant has instructed this agency not to accept instructions from this email address. This activity by the Respondent is clearly intended to be harmful to the Complainant's business.

### **The Response**

The Respondent contends that its registration and use of the Domain Name is not an Abusive Registration because:

1. The Complaint is frivolous because the fees to be paid by the Complainant in relation to the Complaint are £3,750 plus VAT whereas the Domain Name is available to purchase for much less at £3,500 inclusive of VAT.
2. The purchase price of the Domain Name represents the Respondent's documented out-of-pocket costs directly associated with acquiring or using the Domain Name.
3. The purpose of the Respondent's use the Domain Name is:
  - a. For the purposes of public enlightenment, to present fair, truthful, legal comment on the incompetent business practices carried out by John Rich Architects related to outsourcing of work to cheaper northern firms, students & family. This type of outsourcing is unlikely to achieve the client's aims which typically require local and experienced knowledge. Therefore, the web site content is not used for the purpose of unfairly disrupting the business of the Complainant;
  - b. To encourage the Complainant to refund a fee of £2,937 inclusive of VAT in relation to work which the Complainant wilfully failed to carry out nor met any contractually agreed milestones.
4. It appears that the Complainant is frivolously using the Complaint as an underhand means of illegal censorship.

5. It is probably fair to say that the standard of proof required by Nominet experts of these unregistered rights is significantly lower than that required by the English courts in a passing off action. Although in passing off cases the evidence is usually being used to prove a different point. Therefore, the Respondent chooses to have this Complaint decided in a court of law rather by ADR or mediation.
6. The Complainant's claims in the Complaint are not truthfully reported. The ARB is NOT a regulatory body but simply a registry used to find work for architects. The decision from the ARB clearly states that the level of incompetence shown by John Rich was not serious enough for any action to be taken. Only 0.02 % of complaints are deemed by ARB to be serious and 100 % of these relate to architects practising without appropriate qualifications (Source: ARB Annual report 2002/3). In reality, the Complainant's out sourcing to students & family staff could be treated by the ARB as 'serious incompetence'.
7. The Complainant has not offered any evidence of having completed any milestones (in relation to the work carried out for the Respondent as a client).
8. The web site content (as provided by the Complainant) demonstrates that no commercial activity has taken place but that the web site content is factual material of public interest.
9. With direct reference to various case law, Nominet's guidelines & U.K. tribunal law:
  - a. Company names adjudicators cannot deal with cases where someone feels that another company name registration is too similar to, or 'too like', their own company name, but where there is no suspected opportunism behind the registration.
  - b. For the record, opportunism or passing-off, of any nature, has not arisen neither with the Respondent's ownership nor usage of the Domain Name. Quoting from the Court Of Appeal One in a Million (1997) case: "The mere creation of an 'instrument of deception', without either using it for deception or putting it into the hands of someone else to do so, is not passing off." Additionally, there is no web site content that relates to the business carried out by the Complainant.
10. The Complainant made a choice, whether through further incompetence or not, to register johnricharchitects.com but not to register the Domain Name. The Complainant has never made any intention or effort to register the Domain Name nor to apply to the Respondent for its purchase. It must be concluded, therefore, that the Complainant had and has no business interest or business requirement to have the Domain Name. It appears that the Complainant is frivolously using this Complaint as an underhand means of illegal censorship.
11. Therefore, despite the fact that the Complainant has already been operating under the name (John Rich Architects), the main purpose of the Respondent's registration of the Domain Name was not to obtain money (or some other consideration) from the Complainant or to prevent the Complainant from registering the Domain Name.
12. The main purpose of the Respondent's website is to provide, truthful, substantiated, factual evidence about the nature of business carried out by the Complainant. Additionally, RIBA did recognise that incompetent business practice had taken place at the Complainant's practice. The sole purpose of this website is to provide the public with this useful, truthful, substantiated, facts which can be independently substantiated.
13. There is no web site content or operation that creates 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.
14. The Respondent is not the registrant of domain names (under .uk or otherwise) which correspond to well known names or trade marks in which the Respondent has no apparent rights.
15. The Respondent has not given false contact details to Nominet.

16. The Domain Name was not registered as a result of a relationship between the Complainant and the Respondent, and the Complainant: has not been using the Domain Name registration exclusively or at all; and the Complainant has never been involved in the management or ownership nor paid for the registration and/or renewal of the Domain Name registration.
17. The Respondent has made legitimate non-commercial or fair use of the Domain Name.
18. It is a fact that the Complainant took a fee of £2,937 from the Respondent and neither delivered nor attempted to deliver any agreed contractual milestones whatsoever. It is a fact that the Complainant then sought to extort £14,000 in loss of profit fees through the threat of legal action in the courts but failed.
19. Evidence has been compiled for court both by the Respondent and the Complainant & which clearly demonstrates the Complainant's incompetence through, on this occasion, the use of family student staff who had no relevant abilities. The evidence compiled by the Complainant was of such a large scale that it was too long to be read properly for court purposes or by RIBA.
20. The Respondent has owned the Domain Name for 7 years. Only now has the Complainant made an application against title. Ownership of this Domain Name, therefore, [shows] that the interests of the applicant are not adversely affected to any significant extent.
21. It has been a common and legally accepted practice to trade domain names.
22. If the Complainant now wishes to own the Domain Name then I am willing to sell it for £3,500. This is an extremely reasonable offer, since it represents only a small premium over & above what the Complainant fraudulently extracted from the Respondent as fees in advance and is an equal amount to the Complainant's minimal fee. In making this charitable offer, the Respondent would restate: An application which is made because the applicant is aggrieved that someone has a company name which is too similar is unlikely to succeed, even if the name is not yet in use, unless it can be shown that the purpose of registering the company name was to extract money from the applicant or to prevent the applicant from registering the name. The Respondent has never asked for anything more than its financial loss to the Complainant. The Complainant chose to take the fee and then chose to fail to deliver any service leaving the Respondent to deal with an uneconomically costly court claim.

The Respondent further alleges that the Complainant has filed a court claim for loss of profits of £14,000 to which the Complainant subsequently repeatedly failed to attend causing repeated adjournments.

### **The Reply**

The Complainant replied to the Response as follows:

1. Response (para 1 & 2): The Complaint is frivolous

Reply: The Nominet fees for the DRS process are £200 or £750. This should be compared with £7,500 (not £3,750 as stated in the Response) for which the Domain Name is offered for sale by the Respondent. The Complainant did not request the Respondent to acquire the Domain Name so his out-of-pocket expenses are of no concern to the Complainant.

Also, the whole point of the Complaint is that the Complainant considers the Domain Name to be an abusive registration and as such it is not appropriate to make a payment to the Respondent to acquire the Domain Name.

2. Response (para 3): The purpose of the Respondent's use of the Domain Name.

Reply: The comments made on the web site are unsubstantiated untruths. The Complainant understands that it is not the purpose of Nominet to determine if the website is libellous but the Respondent has not and cannot produce any evidence to show that the Complainant's practice outsources work to cheaper northern firms and family. The Complainant does employ students who are RIBA Part 1 trained (with a degree in architecture) for their "Year Out" work experience. This is standard practice within the profession and the work of the students is supervised by qualified architects.

Concerning the refund of a fee of £2,937, the Complainant provides copies of the terms of its engagement with the Respondent and also the correspondence between the parties concerning when the second payment would be due. The sum due for the services provided to the Respondent was £4,000 plus VAT. The services were invoiced in accordance with the Schedule of Payments (copies provided) on 7 March 2002 and 30 May 2002 in the sums described above. The milestones were met, although planning consent was not granted. The Complainant does not understand the Respondent's mathematics which, unfortunately, is again not backed up by any supporting evidence. Only the fees requested in the first invoice (£2,445.00) were paid by the Respondent

3. Response (para 4): The Complainant is frivolously using the Complaint as an underhand means of illegal censorship.

Reply: The Complainant refers to the replies above and the Complaint. The website is causing real harm and loss of livelihood to the Complainant's practice in lost commissions. This is not a frivolous application.

4. Response (para 5): The Respondent has chosen to have the Complaint to be decided in a Court of Law, rather than by ADR or mediation.

Reply: The Complainant does not understand this point and is not aware of any legal action initiated by the Respondent.

5. Response (para 6): Relating to ARB

Reply: The Home page of the ARB website ([www.arb.org.uk](http://www.arb.org.uk)) states "ARB is the UK's Standard regulator of architects." This is the function of ARB, not to "find work for architects".

6. Response (para 7): The Complainant has not completed any milestones for the Respondent

Reply: The milestones completed were the submission of a first town planning application, followed by the decision of the town planning sub-committee, and the submission of a second town planning application. Both applications were submitted with the approval of the Respondent.

7. Response (para 8): Company name Registration

Reply: The website has been used as an instrument of deception. The clearest instance, to reiterate the Complaint, is the doctoring of the letter to the Respondent from ARB notifying him of their decision has been doctored to introduce the word "incompetent" and to generally greatly change the emphasis and distort the meaning of the letter. ARB has twice written to the Respondent (first letter provided with the Reply, second letter provided with the Complaint) demanding that he removes the doctored version of the letter, which is temporarily taken down and then reinstated.

The other instance of deception on the website is set out in the Complaint or in the Reply.

There is clearly evidence of opportunism and abusive registration

8. Response (para 10): Decision by the Complainant not to register the Domain Name shows incompetence.

Reply: The Complainant has registered the domain name John Rich Architects.com. Why should it be necessary to register every possible similar domain name and why should this be considered incompetent?

9. Response (para 11): Purpose of the website was not to obtain money from the [Complainant] but to provide “truthful, substantiated, factual evidence about business carried out by [the Complainant]”. The website is not used to confuse people.

Reply: See the Complaint and the Reply. It is stated on the website that the Domain Name is for sale for £7,500. The Complainant believes that this is an attempt to obtain money.

10. Response (para 12): RIBA recognised that incompetent business practice has taken place at John Rich Architects.

Reply: This is completely untrue and again lacking in supporting evidence. The Complainant has no documentation from RIBA and has had no contact with or from the RIBA in connection with this matter.

11. Response (para 14): Relating to trade marks

Reply: It is not alleged that the Respondent has registered a trade mark associated with the Complainant's practice but that the company and trading name of the practice has been misappropriated.

12. Response (para 15): The Respondent has given false contact details to Nominet

Reply: This is not alleged in the Complaint.

13. Response (para 16): Domain Name registration

Reply: See above and the Complaint.

14. Response (para 17): The Respondent has made legitimate non-commercial or fair use of the Domain Name.

Reply: See above and the Complaint.

15. Response (para 18) The Complainant took a fee of £2,937 and didn't deliver on contractual milestones.

Reply: See above.

16. Response (para 19): The Complainant failed in a legal action through the courts in attempt to extort £14,000.

Reply: A letter was sent to the Respondent in March 2010 by a firm of solicitors appointed by the Complainant (copy provided). The letter requested the

Respondent to take down the website and for the payment of compensation. The Respondent did not reply and no further legal action has been taken by the Complainant to date. Again, unfortunately, the Respondent has not provided supporting documentation.

17. Response (para 20): Length of ownership of Domain name.

Reply: the Complainant questions the relevance of this statement.

18. Response (para 22): Fresh offer to sell the Domain Name.

Reply: See above.

In reply to the Respondents allegation that the Complainant has issued a court claim for loss of profits of £14,000 the Complainant states that it has not taken any legal action in connection with this matter and notes that, again, the Respondent has not provided supporting documentation.

The Complainant appreciates that not all of the issues above are relevant to the DRS process but felt obliged to respond to the points raised by the Respondent. Furthermore, many of the points raised by the Respondent are relevant to or touch on whether the Domain Name is abusive or misleading to the public.

## **6. Discussions and Findings**

### **General**

To succeed in this Complaint, the Complainant has to prove to the Expert on the balance of probabilities, pursuant to §2 of the Policy, both limbs of the test that:

- 1. The Complainant 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**

Rights is defined in §1 of 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 wholly generic suffix “.co.uk” is discounted for the purposes of establishing whether a complainant has Rights in a name or mark which is identical or similar to a domain name.

The Complainant has evidenced rights in respect of the name John Rich Architects which pre-date the Respondent's registration of the Domain Name. Moreover, the Respondent registered the Domain Name some time after he had appointed the Complainant to provide architectural services trading as John Rich Architects.

Accordingly, the Complainant has satisfied the first limb of the test by demonstrating that it has Rights in the name John Rich Architects, a name which is identical to the Domain Name save for the addition of the generic suffix.



## Abusive Registration

Abusive Registration is defined in §1 of the Policy as a Domain Name which either:

1. *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*
2. *has been used in a manner which has taken unfair advantage of or has been unfairly detrimental to the Complainant's Rights.*

The Complainant contends that the Respondent presents several “untruths” on the website to which the Domain Name resolves and has attempted to use the Domain Name to instruct an advertising agency to link it to services that have no connection to the Complainant's business. The Complainant further contends that the Respondent's use of the Domain Name is or is intended to be harmful to the Complainant's business.

The Respondent clearly knew of the Complainant and its rights in the name John Rich Architects before he registered the Domain Name.

It is also clear that the Respondent's purpose in registering the Domain Name arose from his dissatisfaction with the architectural services that the Complainant provided to him and his dissatisfaction with the outcome of his complaint to ARB in relation to those services.

It is not a matter for the DRS to resolve or provide an opinion on a contractual dispute between the parties nor the Respondent's dissatisfaction with the Complainant's services. Accordingly, much of the Respondent's contentions are not dealt with by this decision. The issue for the DRS is whether the Respondent's purpose for registration of and/or his use of the Domain Name was/is abusive.

It is clear from the papers before me that the Respondent's registration and use of the Domain Name is as a criticism site. The Respondent uses the website as a means of publicising his dissatisfaction with the services provided by the Complainant.

The Respondent may demonstrate that the Domain Name is not an Abusive Registration by a non exhaustive list of factors set out in §4 of the Policy. In particular, §4(b) provides that:

*“Fair use may include sites operated solely in tribute to or in criticism of a person or business.”*

The DRS Experts' Overview comments on §4(b) of the Policy at §4.8 of the Overview as follows:

*“Note the use of the words “may” and “solely”– it will depend on the facts. .... Note also that the use of the word “may” means that even if a site is operated solely as a tribute or criticism site it is still open to the Expert to find that it is abusive. In assessing the fairness or otherwise of the use, the Expert needs to have regard to both the nature of the domain name in dispute and its use.*

*The appeal decision in DRS 06284 (rayden-engineering.co.uk) confirmed the consensus view among experts today that the nature of the domain name is crucial to the exercise. A criticism site linked to a domain name such as <IhateComplainant.co.uk> has a much better chance of being regarded as fair use of the domain name than one connected to <Complainant.co.uk>. The former flags up clearly what the visitor is likely*

*to find at the site, whereas the latter is likely to be believed to be a domain name of or authorised by the Complainant.*

*In DRS 06284 the domain name was identical to the name in which the Complainant had rights. ... The Panel concluded there was a balance to be drawn between the right to protest (which could be effected via a modified name) and the Complainant's rights in its own name, and that in this case at least the latter outweighed the former. Note that the Panel did not rule that use of an identical name would always and automatically be unfair, but did conclude that it was only in exceptional circumstances that such use could be fair. The Panel declined to find that such exceptional circumstances existed in the case in question."*

In this case, the Respondent goes beyond what might be acceptable as a criticism site:

1. The Domain Name is identical to the name John Rich Architects, a name in which the Complainant has Rights and which the Respondent knew that the Complainant had Rights when he registered the Domain Name.
2. The Respondent has failed to provide any evidence to substantiate statements made on the website in relation to his version of events. On the papers before me, the Complainant's version of events is to be preferred.
3. I am also satisfied from the papers before me that the Respondent has edited the ARB letter dated 24 April 2003 (confirming its decision in relation to the Respondent's complaint) and published the edited version on its website to present the Complainant in a significantly worse light and to better serve the Respondent's use of the website as a criticism site.
4. The website to which the Domain Name resolves appears at first sight to be operated by the Complainant. The website presents information that suggests that relatively significant internet traffic is accessing the website. It is likely that many such visitors are initially confused that the website is operated by the Complainant and, upon realising that it is a criticism site, would be dissuaded from employing the Complainant to provide architectural services.
5. The Respondent has used the email address incorporating the Domain Name to confuse others that they are dealing with the Complainant or a person authorised by the Complainant.

I am satisfied, therefore, on the evidence before me that the Respondent's registration and use of the Domain Name is an Abusive Registration pursuant to §3a i C and §3 a ii of the Policy.

## **7. Decision**

In light of the foregoing findings, namely that the Complainant has Rights in a name which is identical to the Domain Name, and the Domain Name, in the hands of the Respondent, is an Abusive Registration, I direct that the Domain Name, johnricharchitects.co.uk, be transferred to the Complainant.

**Signed: Steve Ormand**

**Dated: 10<sup>th</sup> December 2010**