

DISPUTE RESOLUTION SERVICE

D00012934

Decision of Independent Expert

Fastline Group Ltd t/a Northampton Diesel

and

Mr Charlie Jackson

1. The Parties:

Lead Complainant: Fastline Group Ltd t/a Northampton Diesel
8 Riley Road
Kettering
Northants
NN16 8NN
United Kingdom

Respondent: Mr Charlie Jackson
1 Squirrel Close
Northampton
NN4 5DL
United Kingdom

2. The Domain Name(s):

northamptondiesel.co.uk

3. Procedural History:

I can confirm that I am independent of each of the parties. To the best of my knowledge and belief, there are no facts or circumstances, past or present, or that could arise in the foreseeable future, that need be disclosed as they might be of a such a nature as to call in to question my independence in the eyes of one or both of the parties.

20 June 2013 09:29 Dispute received

20 June 2013 11:02 Complaint validated
20 June 2013 11:54 Notification of complaint sent to parties
02 July 2013 15:01 Response received
02 July 2013 15:02 Notification of response sent to parties
05 July 2013 02:30 Reply reminder sent
09 July 2013 13:55 Reply received
09 July 2013 13:58 Notification of reply sent to parties
09 July 2013 13:58 Mediator appointed
12 July 2013 13:47 Mediation started
22 July 2013 16:09 Mediation failed
22 July 2013 16:10 Close of mediation documents sent
01 August 2013 02:30 Complainant full fee reminder sent
01 August 2013 09:00 Expert decision payment received

4. Factual Background

The Complainant acquired Northampton Diesel and Electrical Limited in December 2000. Whilst the two corporate entities have been retained, suppliers and the press at least have come to refer to the combined entities as 'Northampton Diesel'.

The Respondent registered the Domain Name in January 2013. He runs a competing business to that of the Complainant and the Domain Name is directed to the Respondent's website at jacksondieselcentre.com.

5. Parties' Contentions

Complaint

The Complainant asserts that as a result of the use by it of the name 'Northampton Diesel', and the recognition by suppliers and the press of it being known under that name, it has the exclusive right to use the name.

It also asserts that the registration of the Domain Name was abusive, because the Respondent knows of the Complainant, they being competitors, and that the Respondent's actions were intended to disrupt the Complainant's business by diverting internet traffic intended for the Complainant to the Respondent, and/or by blocking the Complainant's use of the Domain Name.

Response

The Respondent makes 4 points in response to the Complaint, in addition to an assertion that the Complainant has delayed in filing its complaint, as follows:

1. The Complainant has moved away from Northampton to Kettering
2. The world is a competitive place and it is a necessity to enhance one's business.
3. He is always looking to enhance his service to customers, something that has been lacking in Northampton for some time.

4. He should not have to give up a domain name that was legally purchased.

Reply

The Complainant asserts that it filed its complaint as soon as it became aware of the procedure for doing so and after receiving comments from customers who had difficulty contacting the Complainant online.

It has traded in the Northamptonshire area for nearly 50 years. Whilst it acknowledges that its business sector is competitive, it has not attempted to pass itself off as a competitor as the Respondent now is trying to do.

6. Discussions and Findings

General

To succeed in this Complaint, the Complainant must, in accordance with paragraph 2 of the Policy, prove to the Expert on the balance of probabilities that:

- (i) it has Rights (as defined in paragraph 1 of the Policy) in respect of a name or mark identical or similar to the Disputed Domain Name; and
- (ii) the Disputed Domain Name in the hands of the Respondent is an Abusive Registration (as defined in paragraph 1 of the Policy).

The Complainant must make out its case to the Expert on the balance of probabilities.

Complainant's Rights

The DRS Policy defines Rights as follows –

“Rights means rights enforceable by the Complainant, whether under English law or otherwise, and may include rights in descriptive terms which have acquired secondary meaning.”

In my view the historical use of the name ‘Northampton Diesel’ by the Complainant would be such as to give rise to goodwill, and qualify the Complainant as having ‘Rights’ under the Policy. In this respect I note that the Respondent has made no challenge in respect of the Complainant’s claim to such use or the existence of rights arising there from. Notwithstanding that the name relied upon is a descriptive term, I am satisfied that the use that has been made of it by the Complainant is such that it has acquired a secondary meaning and is associated with the Complainant.

The Policy requires such Rights to be in a name or mark identical or similar to the Domain Name. For the purpose of analysing whether the Domain Name is identical or similar to the name or mark in which rights are claimed, one may ignore the .co.uk suffix. The comparison is therefore between ‘Northampton Diesel’ on the one hand, and ‘northamptondiesel’ on the other. In my opinion the

Complainant has established that it has Rights in a name or mark identical to the Domain Name.

Abusive Registration

I now go on to consider the extent to which the Domain Name is an Abusive Registration.

The Complainant asserts that the registration of the Domain Name is an Abusive Registration for the reasons identified above. The Policy defines an 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"*

and goes on to set out a (non-exhaustive) list of factors which may be evidence that a domain name is an Abusive Registration.

In most circumstances where a Respondent has registered a domain name that is identical or similar to a name or mark in which the Complainant has rights, and the Complainant's name or mark was known to the Respondent, one would be unlikely to have a great deal of difficulty in concluding, as many Experts have previously, that the relevant domain name would be an abusive registration. In the current case whilst the Domain Name could be considered to be a descriptive term, as I have held above the use that the Complainant has made of the term 'Northampton Diesel', is such as to have acquired a secondary meaning.

The Complainant has asserted that the Respondent registered the Domain Name in full knowledge of the Complainant, its use of the name 'Northampton Diesel' and its Rights therein. The Respondent has not disputed the Complainant's assertion, but justifies the registration of the Domain Name primarily because of the competitive nature of business and the fact that the Domain Name was 'legally purchased'.

In my view, the evidence adduced by the Complainant, which has not been challenged or rebutted by the Respondent, is such as to enable me to conclude that (a) the Respondent was fully aware of the Complainant's use and reputation in the name 'Northampton Diesel' and (b) opportunistically registered the Domain Name in an attempt to take advantage of the Complainant's reputation with the intention of diverting internet traffic to it. I am not persuaded that any of the arguments or facts put forward by the Respondent are such as to enable me to hold that its registration or use of the Domain Name was legitimate use as provided for under the Policy.

7. Decision

For the reasons set out above, I find that the Complainant does have Rights in respect of a name or mark which is identical to the Domain Name <northamptondiesel.co.uk> and that the Domain Name in the hands of the Respondent is an Abusive Registration. The Complaint therefore succeeds.

The disputed Domain Name should be transferred to the Complainant.

Signed Simon Chapman

Dated 29 August 2013