

**DISPUTE RESOLUTION SERVICE**

**D00013335**

**Decision of Independent Expert**

Oakfield P.M. Limited

and

Ms June Knight

**The Parties:**

Complainant: Oakfield P.M. Limited  
Haig House  
Station Road  
Hastings  
East Sussex  
TN34 1NH  
United Kingdom

Respondent: Ms June Knight  
84 St Helens Rd  
Hastings  
East Sussex  
TN34 2LJ  
United Kingdom

**The Domain Name:**

<oakfieldproperty.org.uk> (the "Domain Name")

**Procedural History:**

On 24 September 2013 the Dispute was received, the Complaint validated and notification sent to both parties. On 11 October a response reminder was sent and on 14 October a response was received and notification of the response was sent to the parties. On 17 October a reply reminder was sent and reply received on 18 October; notification of same was sent to the parties the same day and a mediator was appointed. On 24 October mediation started but failed on 04 November and close of mediation documents were sent to the parties. On 07 November 2013 the Expert decision payment was received and on 12 November the Expert was appointed.

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.

### **Factual Background**

The Complainant is a limited company (number 3301783) incorporated in the United Kingdom in January 1997. The Complainant is concerned with residential lettings, property sales and property management on behalf of its clients. The main role of the Complainant's business is the management of rental properties for its landlord clients.

The Complainant operates four offices in East Sussex and has a web site located at <oakfield-property.co.uk> through which it lists its clients' properties for sale or rent and promotes its own services.

The Respondent has, since 2007, been a tenant of a property managed by the Complainant. The Respondent registered the Domain Name in March 2013. At some point between the registration of the Domain Name and the commencement of this procedure, the Domain Name resolved to a "protest" web site targeting the Complainant. However since the start of these proceedings the Domain Name has resolved to a "404 Not Found" message.

It is clear that there is a long-standing and acrimonious dispute between the parties.

### **Parties' Contentions**

#### **Complainant**

The Complainant's contentions are as follows:

#### **Complainant's Rights**

The Complainant avers that it has traded since 1996 and was incorporated as a limited company - Oakfield PM Limited - in January 1997 and has exhibited a corresponding Certificate of Incorporation.

The Complainant does not have a registered trade mark but claims unregistered rights in the term OAKFIELD. The Complainant contends that it is a well known business in East Sussex with four offices in the region and that it has built up a good reputation and a large number of clients since it began trading. The Complainant avers that it uses the term OAKFIELD in all its publications and advertisements (though none are exhibited) and that it operates a web site at <oakfield-property.co.uk>, of which screenshots have been provided.

### **Abusive registration**

The Complainant contends that the Respondent has registered a very similar domain name to the Complainant's in order to increase the likelihood of the public seeing the Respondent's web site.

The Complainant avers that the information displayed on the web site associated with the Domain Name was false and caused damage to the Complainant's business and its principal officers.

The Complainant says the web site was set up specifically to damage its business by attempting to persuade third parties not to use it and to portray both the Complainant and its landlord client as "rogues".

The Complainant claims that the web site could potentially lose it business and cause problems to its principals

### **Respondent**

The Respondent's contentions are as follows:

#### **Complainant's Rights**

The Respondent contends that she acquired the Domain Name legally and fairly as it was available and free for purchase.

The Respondent says that as the Complainant is a for-profit business it has no rights to a domain name with the <.org.uk> extension.

The Respondent avers that the Complainant has no rights to the OAKFIELD term as it has not registered it as a trade mark. The Respondent has exhibited a number of extracts relating to trade mark registrations, copyright and the law relating to fair use to support her contentions.

The Respondent contends that terms "oak" "field" and "property" are generic and that these words cannot be owned by any one entity. The Respondent supports her contention by referencing a property company in Scotland which is also called "Oakfield Property".

### **Abusive registration**

The Respondent contends that the Domain Name is used as a not-for-profit social campaigning site to act as a community of tenants, landlords and customers to allow for the discussion of the Complainant and its activities.

The Respondent avers that the web site associated with the Domain Name is a legitimate criticism site and its use as a protest site is a fair use for the greater good. The Respondent says that it is clear that the Domain Name is used as a protest site and therefore does not confuse or clash with the Complainant's 'produce and literature'.

The Respondent says that the Complainant has misunderstood the DRS Policy in that it refers to registrations in "bad faith" - an element of the Uniform Domain-Name Dispute-Resolution Policy (UDRP).

### **Complainant's reply**

The Complainant's reply to the Response largely reiterates its initial submissions and is mainly concerned with addressing the Respondent's contentions relating to the ongoing dispute between the Parties.

### **Further supplemental submissions**

Further to the Complainant's Reply, the Respondent asked to file a "non-standard submission". The rules concerning non-standard submissions are set out within Paragraph 13b of the Procedure, which says "*Any non-standard submission must contain as a separate, first paragraph, a brief explanation of why there is an exceptional need for the non-standard submission. We will pass this explanation to the Expert, and the remainder will only be passed to the Expert at his or her sole discretion.*"

I have reviewed the Respondent's explanatory paragraph and note that it consists of further details of the dispute between the Respondent and the Complainant which do not relate to the Domain Name. The Respondent's contentions are clearly set out at length in the initial Response and I take the view there is no exceptional need for me to accept any further submissions on these points. I therefore reject the Respondent's request to file a non-standard submission under 13b of the Procedure.

### **Discussions and Findings**

#### **Preliminary discussion**

From the submissions before me, it is clear that the Respondent has been engaged in a lengthy, acrimonious and emotive dispute with the Complainant. As a result, the parties' submissions are chiefly concerned with the minutiae of their disagreement.

The DRS is designed to be a simple, efficient and low cost system for resolving domain name disputes. It is not a forum for weighing up the merits, or otherwise, of non-domain name conflicts between parties. There are other forums better suited to resolving such issues.

Paragraph 2(a) of the Policy defines what a complainant needs to demonstrate, on the balance of probabilities, for an expert to order a transfer of a domain name to it:

- (i) The Complainant [must show it] has Rights in respect of a name or mark which is identical or similar to the Domain Name; and
- (ii) The Domain Name, in the hands of the Respondent, is an Abusive Registration.

What constitutes an Abusive Registration is in turn defined by Paragraph 1 of the Policy:

Abusive Registration means 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;

It is clear that, despite the emotive circumstances of this matter, I must make my decision based on the objective elements set down in the Policy and Procedures as they relate to the Domain Name. Despite the evident difficulties of the parties' dispute, I do not propose to make any judgement on the merits, or otherwise, of the parties' non-domain name issues.

## **Rights**

In its submissions the Complainant has noted that it does not have a registered trade mark. The Respondent contends that this means the Complainant cannot claim Rights as envisioned by the Policy. This is not correct.

Paragraph 1 of the Policy defines Rights 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".

Complainants do not need a registered mark to demonstrate rights, they can show they have unregistered or common law rights in a term which is identical or similar to the domain name.

Can the Complainant show it has unregistered rights?

In its submissions, the Complainant refers to itself as "Oakfield" and notes that it is a well known business in East Sussex. The Complainant says that it uses its name on advertisements and various publications and claims that it has built up a large client base and has a good reputation and has submitted its web site at <oakfield-property.co.uk> as evidence of this. I have examined the Complainant's web site and take the view that it is clear on the balance of probabilities that the Complainant has traded as "Oakfield" for some years. The web site shows pictures of shop fronts and signage branded as "Oakfield" which I believe to be genuine and it refers to itself throughout and consistently as "Oakfield".

Furthermore I also note that the Complainant uses the domain name <oakfield-property.co.uk> in association with its web site and that this domain name is featured prominently on its signage.

The Rights test under the Policy traditionally has a low threshold and I therefore conclude that the Complainant has established that it has unregistered rights in the term "Oakfield".

Having established rights in the terms "Oakfield", I must consider whether this term is similar to the Domain Name as per Paragraph 2(a)(i). I take the view that the additional generic word "property" is entirely referable to the Complainant and the services it offers and does not render the Domain Name distinctive. Therefore the Domain Name is similar to the Complainant's Rights. That the

Complainant itself uses the term "Oakfield Property" (with an additional hyphen) in its own domain name is strongly indicative that this is indeed the case.

The Respondent has further averred that terms "oak", "field" and "property" are generic and that these words cannot be owned by any one entity. The Respondent supports her contention by referencing a property company in Scotland which is also called "Oakfield Property".

While the Respondent is correct that the words "oak", "field" and "property" are generic, when they are combined they are not. That a third party may also have chosen to trade under the same name does not detract from the rights the Complainant has established.

As is customary in DRS proceedings the <.org.uk> suffix is only required for technical reasons and, along with any whitespace and hyphens, can be ignored for the purposes of comparison between a mark and the Domain Name.

Therefore I find that the Complainant has Rights in respect of a name or mark which is similar to the Domain Name.

### **Abusive registration**

Paragraph 1 of the Policy defines an Abusive Registration as a domain name which:

- 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;*

The Policy lays out a non-exhaustive list of factors which may be viewed as evidence that a domain name is an Abusive Registration.

The Complainant submits that the Domain Name and associated web site was set up specifically to damage its business by attempting to persuade third parties not to use it and to portray both the Complainant and its landlord client as "rogues". This appears to be a submission under Paragraph 3(a)(i)(C) of the Policy which says that a Domain Name is Abusive if it was registered "for the purpose of unfairly disrupting the business of the Complainant".

The Respondent has said that the web site associated with the Domain Name is a legitimate criticism site and its use as a protest site is a fair use for the greater good. The Respondent says that it is clear that the Domain Name is used as a protest site and therefore does not confuse or clash with the Complainant's produce and literature. This appears to be a submission under Policy 4(b), which notes that a Respondent may demonstrate that the domain name may not be an Abusive if it "operated solely in tribute or in criticism of a person or business".

At its essence I must therefore decide whether the Domain Name is disrupting the Complainant's business (and is therefore an Abusive Registration), or whether it is a fair use criticism site (and therefore not an Abusive Registration).

There have been many similar cases decided under the DRS and the consensus view of the Expert panel on how they should be considered is summarised in Paragraph 4.8 of the Expert's Overview (this is a document put together by Nominet's panel of Experts which deals with a range of issues that come up in DRS disputes. It is published on Nominet's web site at: [http://www.nominet.org.uk/sites/default/files/drs\\_expert\\_overview.pdf](http://www.nominet.org.uk/sites/default/files/drs_expert_overview.pdf))

*4.8 Do tribute and criticism sites necessarily constitute fair use unless proved otherwise?*

*No. Paragraph 4(b) of the Policy provides that "Fair use may include sites operated solely in tribute to or in criticism of a person or business". Note the use of the words "may" and "solely"- it will depend on the facts. If, for example, commercial activity beyond that normally associated with a bona fide fan site takes place, the registration may be abusive. See the Appeal decision in DRS 00389 (scoobydoo.co.uk). 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. Some decisions in the past have concentrated solely upon whether the site fairly pays tribute to or criticises the Complainant (often a very difficult thing for an expert to assess in a proceeding of this kind).*

*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. A modified name that made it clear that this was a protest site would presumably have been less successful in drawing the protest to the attention of customers of the Complainant. 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.*

Having considered the Overview and the Appeal decision in DRS 06284 (rayden-engineering.co.uk) I take the view that the Domain Name is an Abusive Registration in terms of the Policy.

As I have noted above, the Domain Name is similar to the Complainant's Rights and is, save for a hyphen, identical to the Complainant's own domain name. It is likely, on the balance of probabilities, that Internet users who type the Domain Name into their browsers or find it through a search engine will think - on the basis of the Domain Name alone - that any associated web site would be

operated by the Complainant and not a protest site operated by the Respondent. This species of confusion is known as "initial interest confusion" and while it may be clear to users that the web site is a protest site once they arrive and read it, the damage has already been done. The user will have been attracted to the site by the similarity of the Domain Name to the Complainant's domain name and trading style.

The Respondent has said that as the Domain Name is within the <.org.uk> it cannot cause confusion. I note that Nominet does not have any formal restrictions regarding the use of the second level <.org.uk> and <.co.uk> spaces. Domain names with <.org.uk> endings can be, and are, used for commercial purposes and therefore I do not believe the use of the <.org.uk> suffix detracts from this potential for confusion.

Based on the submissions and evidence before me I take the view that the Domain Name was registered "for the purpose of unfairly disrupting the business of the Complainant" as per Paragraph 3(a)(i)(C) of the Policy and is therefore Abusive.

I note that my decision in this matter is not a reflection of the merits, or otherwise, of the non-domain name elements of the dispute between the parties. Nor is the transfer of the Domain Name a curtailment of the Respondent's freedom to protest. Such freedoms must be balanced against the rights affected by them - in this case the right of the Complainant to enjoy the rights and property in its trading style.

I observe that it is still open for the Respondent to use a domain name which does not impinge on the Complainant's rights - perhaps by using a different domain name altogether or one which incorporates a modifier which makes it quite apparent the domain name is not associated with the Complainant.

### **Decision**

Having concluded that the Complainant has Rights in respect of a name or mark which is similar to the Domain Name and that the Domain Name, in the hands of the Respondent, is an Abusive Registration, I determine that the Domain Name should be transferred to the Complainant.

**Signed** Tim Brown **Dated 04-Dec-2013**