

**DISPUTE RESOLUTION SERVICE**

**D00014303**

**Decision of Independent Expert**

Alexander Wallace and Christopher Lightwing  
trading as  
Silver Screen Cinemas

and

Pelican Consultants LLP

**1. The Parties:**

Lead Complainant: Alexander Wallace and Christopher Lightwing  
trading as  
Silver Screen Cinemas  
The Town Hall  
Guildhall Street  
Folkestone  
Kent  
CT20 1DJ  
United Kingdom

Respondent: Pelican Consultants LLP  
Cardinal Point  
Park Road  
Rickmansworth  
Hertfordshire  
WD3 1RE  
United Kingdom

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

silverscreencinemas.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 such a nature as to call in to question my independence in the eyes of one or both of the parties.

03 June 2014 23:56 Dispute received  
05 June 2014 11:43 Complaint validated  
05 June 2014 11:52 Notification of complaint sent to parties  
24 June 2014 02:30 Response reminder sent  
24 June 2014 12:21 Response received  
24 June 2014 12:21 Notification of response sent to parties  
25 June 2014 12:07 Reply received  
25 June 2014 12:09 Notification of reply sent to parties  
25 June 2014 12:09 Mediator appointed  
30 June 2014 15:01 Mediation started  
25 July 2014 12:55 Mediation failed  
25 July 2014 12:56 Close of mediation documents sent  
29 July 2014 08:15 Expert decision payment received

### **4. Factual Background**

Silver Screen Cinemas is the trading name of the Complainants who operate two independent cinemas in the towns of Folkestone and Dover in Kent.

The name was initially used by the first named Complainant, Alexander Wallace, who registered the United Kingdom trademark SILVER SCREEN CINEMAS, registration number UK00001515359 on 10 October 1992, and more recently since 3 January 2014 by Mr Wallace in partnership with the second named Complainant Christopher Lightwing.

The Respondent is a provider of web site services.

The disputed domain name was registered on 31 January 2000 and most recently renewed on 31 January 2014

The undisputed facts are that in the month of January 2000 the first named Complainant, Alexander Wallace entered into an agreement with a company WWW.CO.UK Limited trading as CINEMAS ONLINE, For ease of reference the agreement is hereinafter referred to as "the Agreement of 2000". Pursuant to the agreement said WWW.CO.UK Limited provided a website for the first named Complainant on which the programming information about the Complainants' cinemas was published and updated each week.

The service was provided by WWW.CO.UK Limited at its own expense but the Agreement of 2000 provided that the company was entitled to be remunerated by the advertising revenue from the web site.

The disputed domain name was used as the address for the website and this arrangement continued satisfactorily for a period of time.

In or about November 2010 the Respondent acquired the business of said WWW.CO.UK Limited and continued to provide the website service.

There is some dispute as to whether the Respondent sought to impose a charge of £100 per month on the Complainants for the provision of the service but it would appear that no invoice was ever issued by the Respondent.

There is a conflict between the Parties as to whether the Complainants validly terminated the Agreement of 2000. The Complainants' position is that the agreement was validly terminated in December 2010. The Respondent's position is that it was never terminated and is continuing.

It is not disputed that the website at the <www.silverscreencinemas.co.uk> address remained active even after December 2010 and continues to be maintained by the Respondent.

For several years the website continued to display up-to-date information about the Complainants' cinemas. During this time the first named Complainant arranged for a member of his staff to manually update the content of the web site.

On 22 December 2012 the Complainants subsequently registered the similar generic top level domain name <silverscreencinemas.com> and established a website at that address from December 2013.

A copy of the agreement of January 2000 has been furnished to this Expert by the Parties. It expressly provides that it would continue from commencement unless terminated by either party giving 36 months' notice in writing sent by recorded delivery to the registered office of the other party.

It further expressly provides that the agreement is personal to the Complainants and may not be assigned by the Complainants without the express permission of the other party. There is no express prohibition or restriction on assignment by WWW.CO.UK Limited or its successors in title.

The Agreement expressly grants to WWW.CO.UK Limited "the exclusive rights to publish every week at (WWW.CO.UK Limited's) own expense advertising backed Internet programmes... for provision to internet users of cinema programming Schedules for all cinemas owned by (the Complainants) during this Agreement on a specified site on the Internet ('the Site')."

Further on the Agreement expressly states that WWW.CO.UK "may change the Site address and shall inform (the Complainants) as soon as practical of any such change."

There is no mention of the disputed domain name in the Agreement.

On 30 December 2013, the second named Complainant contacted the Respondent via email to request the purchase and transfer of the <www.silverscreencinemas.co.uk> website. In an email reply the Respondent refused to discuss any possible transfer of the disputed domain name, instead alleged that the Complainant was in breach of contract.

On 31 January 2014 the Respondent renewed the registration of the disputed domain name for a further two years.

## **5. Parties' Contentions**

The Complainants submit that the disputed domain name is identical to their business name and registered trademark and that the disputed domain name is an Abusive Registration in the hands of the Respondent.

The Complainants submit that the Agreement of 2000 was terminated on or shortly after 31 November 2010 and have submitted an undated copy of a letter from the first named Complainant addressed to the Respondent purporting to terminate the agreement.

The Complainants further allege that the Respondent has recently renewed the registration of the disputed domain name purely to continue exploiting the name and mark of the Complainants and diverting web traffic from the Complainants' official website at <www.silverscreencinemas.com> in order to continue collecting advertising revenue, and possibly to force the Complainants to resume the use of their services.

The Respondent denies that the Agreement of 2000 has ever been terminated and claims to be entitled to continue to benefit from the revenues generated by the website to which the disputed domain name resolves.

The Respondent claims that it acquired the cinema website business from WWW.CO.UK Limited in December 2010; that all existing contracts were legally assigned to the Respondent at that time and have since been run in accordance with existing practises. The Respondent asserts that it was not obliged to provide the Complainants with any prior information with regards to that sale and change of ownership of the business of WWW.CO.UK Limited. The Respondent also says that, contrary to the Complainants' accusation, no fee has ever been invoiced by the Respondent to the Complainant.

The Respondent argues that section 9 of the Agreement of 2000 quite clearly states that: "this agreement shall commence on the date hereof by both parties and continue thereafter unless terminated by either party giving 36 months' notice in writing sent by recorded delivery to the registered office of the other party". The Respondent denies ever having received any such notice.

The Respondent's position is that it is not willing to sell the disputed domain name unless it recoups all lost revenue for the next 36 months in accordance with the contract or alternatively the Complainant can take down the competing website at <silverscreencinemas.com> and allow the Respondent to carry on running the website at the address of the disputed domain name.

## 6. Discussions and Findings

Paragraph 2 of the DRS Policy states that

- a. A Respondent must submit to proceedings under the DRS if a Complainant asserts..., according to the Procedure, that:
  - i. The Complainant 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.
- b. The Complainant is required to prove to the Expert that both elements are present on the balance of probabilities.

In the present case, the disputed domain name is identical to the business name and registered trademark of the Complainants and the Complainants therefore succeed in the first element of the above test.

This Expert finds however that establishing whether or not the disputed domain name is an Abusive Registration involves a dispute which is beyond the scope of the DRS Policy.

That the first named Complainant entered into the Agreement of 2000 with WWW.CO.UK Limited is not in dispute between the parties. Under that agreement, the first named Complainant granted WWW.CO.UK Limited the exclusive right to establish and maintain a website for the Complainants' business. The agreement could be terminated by either party giving 36 months' notice in writing sent by recorded delivery to the registered office of the other party

The Respondent on the other hand claims that it has lawfully been assigned the benefit of the Agreement of 2000; that it is contractually entitled to continue to use the disputed domain name as the address of a web site pursuant to the Agreement of 2000; and that the Complainant is in breach of contract.

The Complainants take the position that the Agreement of 2000 was validly terminated in December 2010 and that in any event the benefit of the agreement does not accrue to the Respondent.

It would appear that whether the disputed domain name is an Abusive Registration in the hands of the Respondent is a matter of construction of the contract and in particular finding as to whether the Respondent is lawfully the successor in title of the benefit of the Agreement of 2000 and whether that agreement was validly terminated by the Complainant.

In DRS 04632 David Munro v Celtic.com, Inc. the Appeal Panel stated that “[t]he Panel supports the view expressed by several Experts (including the Expert in this case) that as a general proposition contractual disputes are best left to the courts to resolve.”

In the circumstances this Expert finds that the issues in dispute are contractual in nature, outside the scope of the Policy and for another forum to decide. This Panel therefore directs that no action should be taken on foot of this Complaints and recommends that the parties engage meaningfully in an ADR process.

**7. Decision**

This Expert directs that NO ACTION be taken in respect of the Complaint.

**Signed** .....  
James Bridgeman

**Dated 18 August 2014**