

**DISPUTE RESOLUTION SERVICE**

**D00015985**

**Decision of Independent Expert**

**Howden Joinery Limited**

and

**Mr James Casey**

**1. The Parties:**

Lead Complainant: Howden Joinery Limited  
40 Portman Square  
London  
W1H 6LT  
United Kingdom

Respondent: Mr James Casey  
32a Dyer Lane  
Halifax  
HX3 5JH  
United Kingdom

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

howdensbathrooms.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.

26 May 2015 17:46 Dispute received

27 May 2015 11:48 Complaint validated  
27 May 2015 11:56 Notification of complaint sent to parties  
15 June 2015 02:30 Response reminder sent  
15 June 2015 11:41 Response received  
15 June 2015 11:42 Notification of response sent to parties  
18 June 2015 02:30 Reply reminder sent  
23 June 2015 11:24 Reply received  
23 June 2015 11:28 Notification of reply sent to parties  
23 June 2015 11:28 Mediator appointed  
25 June 2015 14:45 Mediation started  
25 June 2015 14:48 Mediation failed  
25 June 2015 14:49 Close of mediation documents sent  
03 July 2015 10:08 Expert decision payment received

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

The Complainant is the owner of the following registered trade marks:

- UK registered Trade Mark HOWDENS, registration number 2626504 registered on 2 November 2012 in classes 6, 19, 20, 35 and 42; and
- Community Trade Mark HOWDENS registration number 11463577, registered on 10 June 2013, in respect of specified goods and services in classes 6, 19, 20, 35 and 42.

Of particular relevance to this Complaint is that the specifications of goods for which both the UK Trade Mark and the Community Trade Mark are registered include inter alia the following in class 20: "... bathroom furniture... fitted bathroom furniture...bathroom cupboards...bathroom cabinets...bathroom cabinet doors...bathroom cabinet fronts...bathroom display units..."

The Complainant owns the domain name <howdens.com> which was registered on 23 March 1999. Since 2000 the Complainant has maintained a website at the <www.howdens.com> address to advertise its products and corporate values to the public. The Complainant also owns the following portfolio of domain names which incorporate its HOWDENS trade mark (or HOWDEN in the singular), including <howden.kitchen>, <howdenjoinery.co.uk>, <howdenjoinery.com>, <howdenjoinery.com>, <howdenjoineryplc.co.uk>, <howdenkitchens.com>, <howdenskitchen.co.uk>, <howdenskitchens.com>, <howdensonline.com> and <howdensreview.co.uk>.

The disputed domain name <howdensbathrooms.co.uk> was registered on 13 November 2014.

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

**The Complainant**

### The Complainant's Rights:

The Complainant relies on its rights in the above-referenced registered trade marks and further submits that it has a long established reputation in the use of the HOWDENS trade mark as a manufacturer and supplier of kitchen furniture, bathroom cabinets and associated joinery and appliances.

The Complainant states that it was incorporated in 1953 and re-branded itself from MFI to HOWDENS in 1995. Since then, the Complainant has gained a substantial reputation and goodwill with over £1 billion annual turnover operating out of over 590 depots nationwide and employing over 7,000 people. The Complainant's parent company, Howden Joinery Group plc is listed on the FTSE 250. Each year the Complainant supplies over 3.8 million kitchen and bathroom cabinets and 400,000 completed kitchens. It has over 250,000 registered trade customers. As a result, the Complainant claims to have become one of the UK's leading suppliers of kitchen and bathroom cabinets. All such business is conducted under and by reference to the trading name and trade mark HOWDENS.

The Complainant has provided examples of its advertising and promotional material including that posted on its website at <www.howdens.com> and press articles which it submits prove that HOWDENS has become an established name for quality joinery products

The Complainant operates a "trade-only" business model selling directly only to trade professionals which it submits sets it apart from its competitors. Each kitchen and bathroom cabinet collection is given a range name. One of the Complainant's most popular selling products is its GREENWICH kitchen and bathroom cabinet range. The Complainant has furnished images of examples of the GREENWICH ranges from the Complainant's website, advertisements of the Complainant's products and extracts from a brand awareness research study commissioned by the Complainant.

To protect the HOWDENS trade mark, the Complainant places strict quality controls on the ways in which its trade customers may use those marks, details of which are published on the Complainant's website.

### Similarity of Disputed Domain Name and Complainant's Mark:

The Complainant submits that the disputed domain name <howdensbathrooms.co.uk> is identical or confusingly similar to the HOWDENS trade mark as it contains the distinctive HOWDENS trade mark in its entirety and differs from the Complainant's trade mark only by the addition of the descriptive word "bathrooms". The Complainant submits that the additional element does nothing to distinguish the disputed domain name <howdensbathrooms.co.uk> from the Complainant's trade mark but in fact increases the likelihood of confusion among Internet users because the Complainant has an established reputation as a manufacturer and supplier of bathroom related products under and by reference to the HOWDENS trade mark and name. Members of the public are likely to associate the disputed domain name with the Complainant and internet users who visit the website linked to the disputed domain name are likely to be confused into thinking that the website is operated by, associated with, or endorsed by the Complainant when such is not the case.

Abusive Registration:

The Complainant submits that to the best of its knowledge, the Respondent is not and has never been commonly known by the disputed domain name, whereas the Complainant has been trading under and by reference to HOWDENS since 1995. The Complainant has not at any time authorized, licensed, or given its consent to the Respondent to use the HOWDENS trade mark as part of the disputed domain name.

The disputed domain name redirects to a live commercial website under a different domain name: <http://jembathroomsoffers.co.uk/> which purports to offer bathroom furniture under the name BATHROOM DISCOUNTS GREENWICH. The Complainant submits that these sales are in competition with the Complainant's bathroom furniture and the situation is worsened by the fact that the Complainant has a GREENWICH range of bathroom furniture. The use of the disputed domain name in this manner takes unfair advantage of the Complainant's trade marks and furthermore is likely to be unfairly detrimental to the Complainant's rights as the Complainant has no control over the quality of the Respondent's products.

The Complainant submits that it is inconceivable that the Respondent was unaware of the Complainant and/or the HOWDENS trade mark and prior rights when the disputed domain name was registered because the Complainant has an established, substantial and widespread reputation and goodwill in the use of the HOWDENS name and mark in the United Kingdom for kitchen and bathroom cabinets produced and/or supplied by the Complainant; the Complainant has registered HOWDENS as a trade mark in the UK and the wider EU in relation to bathroom products and a simple online trade mark search would have revealed this information to the Respondent; the Respondent is in the same field of business as the Complainant and it is reasonable to assume he would be aware of the Complainant which is one of the UK's biggest companies in the industry; a Google search for "Howdens Bathrooms" returns results listing the Complainant's website as each of the top four hits and so it is reasonable to assume the Respondent either carried out a similar search or, given the high online profile of the Complainant, came across the Complainant's bathroom cabinet range when he considered registering the disputed domain name; and the Respondent address is in close proximity to, being only 1.4 miles from, one of the Complainant's depots.

Finally the Complainant submits that the manner in which the Respondent is using the disputed domain name is likely to give rise to a false representation that the Respondent is the Complainant, or is associated or connected to it (*British Telecommunications v One In A Million* [1998] EWCA Civ 1272). The close similarity (if not identity) of the disputed domain name to the Complainant's Trade Marks coupled with the deliberate redirection of the disputed domain name to a website offering products which compete with those of the Complainant indicate that it is being used as an instrument of fraud. It appears the Respondent is using the disputed domain name as a lure to attract internet users to its website on the pretence that such site is authorised by or connected with the Complainant.

The Complainant submits that it follows that the Respondent is using the disputed domain name for potential commercial gain. Internet users searching online for "Howdens bathrooms" are likely to be diverted away from the Complainant's website. The Respondent's website does not use the name 'Howdens Bathrooms'; it is branded 'Bathroom Discounts Greenwich'. It contains no indication or clarification as to the Respondent's relationship with the Complainant.

The Complainant further argues that the risk of confusion between the Complainant's business and the Respondent's business is heightened by the Complainant's trade-only business model. Without any clarification on the Respondent's the homepage as to its relationship with the Complainant, potential internet users are led to believe that the website is either the Complainant's website or a website of an official trade customer of the Complainant, which it is not.

### **Response**

In a very brief Response the Respondent states that the disputed domain name <howdensbathrooms.co.uk> was bought as the Respondent's company manufactures bathrooms at a site called Howden Industrial Estate. He asserts that he will be using the disputed domain name fairly and legitimately; and that his associated business has been distributing bathroom furniture, ceramic showers, taps and enclosures for many years in Ireland and the UK.

The Respondent submits that he does not see why the Complainant should claim the disputed domain name. He asserts that he is not in direct competition with the Complainant as his business is solely Bathrooms and the Complainant's business is a mixture of wooden products with bathroom furniture being only a small proportion of its product range. In conclusion the Respondent states that he has entered mediation regarding this dispute and is waiting for a representative from the Complainant to contact him so that the Parties can find a way forward.

### **Reply**

In Reply the Complainant stated added that the Response does not include a statement of truth, contrary to para 5(c)(v) of the DRS Procedure; that the Response is unsupported by any documentary evidence or credible arguments; and that the Respondent is incorrect in stating that the parties have entered mediation: in fact, the Respondent offered to sell the disputed domain name to the Complainant for £25,000.

## **6. Discussions and Findings**

In order for the Complainant to succeed in this Complaint, paragraphs 2.a and 2.b of the DRS Policy require the Complainant to prove on the balance of probabilities that

- i. the Complainant has Rights in respect of a name or mark which is identical or similar to the disputed domain name; and

- ii. the disputed domain name, in the hands of the Respondent, is an Abusive Registration.

### **Complainant's Rights**

The Complainant has proven on the balance of probabilities that it has rights in the HOWDENS name and mark. It is the owner of the above-referenced UK registered Trade Mark registration number 2626504 and Community registration number 11463577, registered on 2 November 2012 and 10 June 2013, respectively. It has furthermore established that on the balance of probabilities it has rights at common law in the goodwill associated with its use of the HOWDENS trade mark in bathroom and other furnishings since at least 1995.

The disputed domain name is clearly similar to the Complainant's HOWDENS mark, being the identical word with the additional descriptive element "bathrooms" which does not in any way serve to take away from the similarity of the word and mark, particularly so, because the distinctive element of the domain name is the Complainant's HOWDENS trade mark. It is well established for the purposes of comparison, the ccTLD <.co.uk> extension may be ignored.

In the circumstances, this Expert finds that the Complainant has succeeded in the first element of the test in paragraph 2.a of the DRS Policy.

### **Abusive Registration**

Paragraph 1 of the DRS 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;"

The Complainant has provided convincing evidence that it has a well established reputation as a manufacturer and supplier of *inter alia* bathroom furnishings, which it has for many years sold under the HOWDENS mark.

The Respondent is a competitor of the Complainant. While he has no connection whatsoever with the Complainant or its products, he nonetheless selected and registered the disputed domain name which fully incorporates the Complainant's trade mark with the additional descriptive word "bathrooms". The only explanation that he offers is that his company has an establishment at a "Howden Industrial Estate". He provides no evidence to support this assertion, and even if it were true it would not give either him or his company the right to use the Complainant's trade mark in such a manner.

This Expert accepts the Complainant's submissions that the disputed domain name was registered and is being used in order to take predatory advantage of

the Complainant's goodwill and rights in the HOWDENS mark by diverting Internet traffic away from the Complainant's website.

It is most improbable that the Respondent was not aware of the Complainant's HOWDENS mark and name when the disputed domain name was chosen and registered. A simple Internet search would have disclosed the Complainant's website. It is also improbable that the Respondent would not have become aware that the Complainant had registered the <howdens.com> domain name while he was in the process of registering the disputed domain name. Most convincingly, it is beyond belief that the Respondent which is in the same business as the Complainant which sells over 3.8 million kitchen and bathroom cabinets to the trade each year, was not aware of the Complainant's business.

In addition, the fact that the Respondent decided to register the Complainant's trade mark in combination with the word "bathrooms" is a clear indication that there was an intention at the time when the registration took place to take unfair advantage of the Complainant's Rights.

The Respondent's use of the disputed domain name to divert traffic to a web site that offers goods in direct competition with the Complainant's bathroom products is convincing evidence that the Respondent is using the disputed domain name in a manner which has taken unfair advantage of the Complainant's Rights and there is a risk that the use of the disputed domain name in this manner may have damaged the Complainant's reputation as a "trade-only" supplier, although this Expert does not have any evidence to support such a conclusion.

For completeness it should be added that it has not been necessary to consider the Complainant's submissions in the Reply that the Respondent did not furnish a statement of truth. Neither has it been necessary to consider whether the alleged offer to sell the domain name for £25,000 was made as alleged or if such an offer was made, the context in which it was made.

In the circumstances, this Expert finds that the Complainant has succeeded in proving both elements of the test in Paragraph 2 of the DRS Policy and is entitled to succeed in this Complaint.

## **7. Decision**

This Expert directs that the domain name <howdensbathrooms.co.uk> be transferred forthwith to the Complainant.

**Signed** James Bridgeman  
2015

**Dated** 22 July