



NOMINET

Dispute Resolution Service

DRS 17010

Instarmac Group PLC

and

Metalboot

Decision of Independent Expert

1 Parties

Complainant: Instarmac Group PLC

Address: Birch Coppice Business Park,
Danny Morson Way, Dordon,
Tamworth
Staffordshire

Postcode: B78 1SE

Country: United Kingdom

Respondent: Metalboot

Address: 24 Carr Head Lane
Poulton le Fylde
Lancashire

Postcode: FY6 8JB

Country: United Kingdom

2 Domain name

<tileadhesive.co.uk>

3 Procedural History

- 3.1 On 27 January 2016 the complaint was received by Nominet, which checked that it complied with the Nominet UK DRS Policy (“the Policy”) and DRS Procedure (“the Procedure”). Nominet notified the respondent the same day. The respondent responded on 1 February 2016. The complainant replied on 3 February 2016. The matter was not resolved in mediation. The complainant requested referral of the matter for expert decision under the Procedure, and on 8 March 2016 paid the applicable fee.
- 3.2 I was appointed as expert on 14 March 2016. I have made the necessary declaration of impartiality and independence, confirming that I am independent of each of the parties and that 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.

4 Factual background

- 4.1 The complainant is a manufacturer and distributor of highway maintenance, paving, tiling and flooring materials.
- 4.2 On 1 January 2016 it acquired from Granwood Holdings Ltd. (“Granwood”) two companies (to which I will refer together as “Granfix”), whose business includes the manufacture of wall and floor tile adhesives.

5 Parties’ Contentions

Complainant

- 5.1 The complainant says its contract with Granwood for the purchase of Granfix provided for the transfer of the domain name as part of the acquisition.
- 5.2 It admits that in November 2015 it was informed that the domain name did not belong to Granwood, and therefore could not be included in the sale. It admits therefore that it purchased Granfix knowing that the domain name was not included in the sale.
- 5.3 The complainant argues that Granwood assumed it had complete ownership of the website. It suggests that the respondent registered the domain name in 2011 after Granfix commissioned its website.

- 5.4 It argues that Granfix trusted the respondent to build and supply a website, assuming the domain name would belong to it, since it had been registered on its behalf. It argues that invoices produced by the respondent are consistent with this assumption.
- 5.5 It contends that the domain name was used exclusively for Granfix from 2011. More recently, it says, the domain name redirected to <tileddrill.com>, which it says is completely unrelated to tiling adhesives. It says the domain name is not now being used for a website.
- 5.6 It says the domain name is the primary website for Granfix business and is printed on all corporate literature, including brochures leaflets, advertising, point of sale materials and posters. The respondent's registration is, it says, causing confusion to its customers.
- 5.7 The complainant argues that the domain name was knowingly registered for the primary purpose of selling it or for financial gain, and to cause disruption to Granfix.

Respondent

- 5.8 Anthony Gildert on behalf of the respondent says "Metalboot" is a name he uses for trading and blogging. He says he has personally owned, renewed and operated the domain name for many years. He says Granfix knew this.
- 5.9 The respondent says Granfix asked him for a website in 2010, and that he used the domain name for the site. The respondent says Granfix paid annually to rent the domain name. If anyone assumed Granfix owned the domain name, he says, they "assumed wrong".
- 5.10 The respondent says he owns <tileddrill.com> and that it is related to the domain name, because it has to do with tiles.
- 5.11 He denies that he abusively registered the domain name to profiteer from the acquisition of Granfix. He says the complaint is "complete and utter rubbish from start to finish".

6 Discussion and Findings

General

- 6.1 Under paragraph 2(a) of the Policy a complainant must show on the balance of probabilities that:
 - it has rights in respect of a name or mark which is identical or similar to the domain name, and that

- the domain name, in the hands of the respondent, is an abusive registration.

Rights

- 6.2 Rights are defined in the Policy as rights enforceable by the complainant, whether under English law or otherwise. They may include rights in descriptive terms which have acquired a secondary meaning.
- 6.3 At the third level (i.e. disregarding “.co.uk”) the domain name can be read, and in my view is most naturally read, as consisting of a two-word phrase, “tile adhesive”, which is descriptive of products such as those sold by the complainant and its competitors.
- 6.4 The complainant asserts no registered trade mark similar to the domain name.
- 6.5 The question is therefore whether it has rights because the term “tile adhesive” has acquired a secondary meaning denoting the complainant or its products.
- 6.6 The complainant says that the domain name was used by Granfix from 2011 to 2015, and is printed on all its marketing materials. It has produced photographic evidence that the domain name is printed on brochures. It has not however produced substantial evidence that the descriptive term “tile adhesive” has become recognised as denoting Granfix or its products specifically.
- 6.7 In my view, particularly given the descriptive nature of the domain name, the evidence is insufficient to demonstrate the existence of unregistered trade mark rights in a name or mark similar to the domain name.
- 6.8 The complainant asserts rights in connection with the contract under which it bought Granfix. It argues that Granwood assumed it owned the domain name, and that the domain name was specifically referred to in the contract for sale of Granfix. However it also admits it knew before it acquired Granfix that Granfix did not own the domain name and that it was not included in the purchase.
- 6.9 The definition of rights in the Policy does not exclude contractual rights to the domain name itself. However where the right is disputed (as it is here) or the surrounding circumstances are complex, the complaint may be rejected as not being appropriate for adjudication under the Policy.
- 6.10 As the appeal panel said in *David Munro v Celtic.com Inc* (DRS 04632 <*ireland.co.uk*>), as a general proposition contractual disputes are best left to the courts to resolve. The appeal panel went on to say that pure contractual disputes of this kind are outwith the scope of the Policy. It is clear from the appeal panel’s reasoning that it was concerned that DRS experts could not resolve such issues fairly. The appeal panel’s decision in the *Ireland* case is not binding on me, but does have persuasive force.
- 6.11 A contractual question like this is in my view best left to a court especially where, as here, only of the one parties to the contract is involved in the domain name

dispute. Arguably a DRS expert could not fairly determine Granwood's contractual obligations for DRS purposes without knowing Granwood's views.

- 6.12 I am therefore, as the *Ireland* appeal panel put it, unable to satisfy myself on the balance of probabilities that the complainant has rights in the domain name.
- 6.13 But in any event, the complainant accepts it knew the domain name was not included in the purchase of Granfix, so it is not clear that a contractual right to the domain name is being asserted at all. The complainant seems only to be asserting some kind of moral right or expectation. But rights are defined in the Policy as rights enforceable by the complainant.
- 6.14 For this reason, therefore, I am not satisfied that the complainant has contractual rights in relation to the domain name.
- 6.15 It might be argued in support of the complainant's assertion of rights that this case raises issues analogous to those mentioned in paragraph 3(a)(v) of the Policy.
- 6.16 Paragraph 3(a)(v) of the Policy provides that it may be evidence of abusive registration where the domain name was registered as a result of a relationship between the complainant and the respondent, and the complainant has been using the domain name registration exclusively and paid for its registration and/or renewal. Here, it appears that the domain name was registered as a result of a relationship between the respondent and a business now owned by the complainant.
- 6.17 It might also be argued that the underlying assumption of paragraph 3(a)(v) is that such circumstances, reflecting a contractual or similar relationship between the parties, may have given rise to rights in respect of the domain name.
- 6.18 In my view, however, paragraph 3(a)(v) of the Policy deals only with possible evidence of abusive registration. The two requirements to prove rights and abusive registration are distinct under the Policy. It follows that rights must be independently demonstrated before paragraph 3(a)(v) of the Policy can be relied on. Paragraph 3(a)(v) does not create a special exemption from the requirement to prove the existence of rights, and cannot be used on its own as the basis of a finding that the complainant has rights in respect of the domain name.
- 6.19 In those circumstances, I am not satisfied that the complainant has rights in respect of a name or mark identical or similar to the domain name.

7 Decision

- 7.1 I do not find that the complainant has rights in a name or mark which is identical or similar to the domain name.
- 7.2 The complaint must therefore fail. It is not necessary to consider whether the domain name, in the hands of the respondent, is an abusive registration.

7.3 I direct that no action be taken.

Carl Gardner

6 April 2016