

DISPUTE RESOLUTION SERVICE

D00017794

Decision of Independent Expert

ForceDry Ltd

and

Mr Keith Westcott

1. The Parties:

Lead Complainant: ForceDry Ltd
Otterburn,
Manor Farm Lane,
Balscote,
Banbury,
Oxford,
Oxfordshire,
OX15 6JL,
United Kingdom

Respondent: Keith Westcott
Slated Barn,
Warwick Road,
Shotteswell,
Banbury,
Oxfordshire,
OX17 1UA
United Kingdom

2. The Domain Name(s):

forcedry.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.

28 July 2016 Dispute received
02 August 2016 Complaint validated
02 August 2016 Notification of complaint sent to parties
19 August 2016 Response reminder sent
24 August 2016 Response received
24 August 2016 Notification of response sent to parties
30 August 2016 Reply reminder sent
06 September 2016 Reply received
06 September 2016 Notification of reply sent to parties
06 September 2016 Mediator appointed
14 September 2016 Mediation started
10 October 2016 Mediation failed
10 October 2016 Close of mediation documents sent
20 October 2016 Complainant full fee reminder sent
24 October 2016 Dispute suspended
08 November 2016 Dispute opened
08 November 2016 Dispute suspended
24 January 2017 Dispute opened
26 January 2017 Expert decision payment received

4. Factual Background

The Complainant is a single member company incorporated on 9 July 2013. Prior to that date, Ross Verity, the owner of the Complainant had carried on business as a sole trader using the name FORCEDRY and that use was continued by the Complainant following its incorporation. In practical terms on the evidence the Complainant simply acts as a corporate vehicle for Mr Verity.

The Complainant builds and hires out temporary electric boiler systems for the purpose of force drying and commissioning liquid 'anhydrite' screeds to the heating and plumbing industry. The Complainant has invested in its business and the development of Know-How in the technology required to deliver its services.

The Complainant owns the domain name force-dry.co.uk which resolves to its website.

In 2013 the Complainant entered into negotiations to establish a business arrangement with the Respondent and a third party. The proposal was that the Respondent would act as a technical advisor supplying customer leads and certain drying equipment. The Complainant and the third party would fulfil the orders. The Respondent would receive a fee for leads generated.

In the course of these negotiations, the disputed domain name was registered by the Respondent and the Complainant was incorporated at Companies House.

The negotiations in 2013 were successful and while the arrangement started off well it ended within months and there has been no further business arrangement between the Complainant and the Respondent.

From 2013 until 28 June 2016 the Complainant has used the disputed domain name as the address for its website and as the main email account for its business.

The Complainant later registered the similar domain name <force-dry.co.uk>.

On 30 October 2014 Mr Verity applied to register FORCEDRY as a UK registered trade mark. The application was granted and the mark was registered in his name on 30 January 2015 in class 37 in respect of “rental of screed drying apparatus and equipment; information, advice and consultancy in relation to the aforesaid services.”

5. Parties’ Contentions

Complainant’s Submissions

The Complainant says that on 28 June 2016 it started having difficulty with its emails.

At about that time the Respondent contacted the Complainant claiming rights over the Complainant’s business. The Complainant rejected the Respondent’s claim and made clear that the Complainant had no interest in the Respondent becoming a part of the business. There was a second contact on 18 July 2016 when the Respondent called the Complainant again and said he was going to start using the disputed domain name for his own ends.

The Complainant submits that when it first came to its attention that the disputed domain name was registered in the name of the Respondent it was not initially concerned because it understood that the disputed domain name had been registered by the Respondent on behalf of “the business” and because the Complainant was “still in control of the domain name” and the Complainant was receiving emails to its ross@forcedry.co.uk account.

In support of these submissions the Complainant has provided a copy of the registration certificate for UK registered trade mark FORCE DRY registration number UK00003079374 together with evidence of use of the email address ross@forcedry.co.uk in correspondence with a customer on 24 July 2013 and a subsequent email from the Respondent, addressed to a number of third parties, on 15 July 2013 in which the Respondent states that he acted as “the technical person advising ForceDry in regards to underfloor heating”.

The Complainant submits that the use of the disputed domain name by any other party would undermine and damage the significant investment of time, effort and money it has made and in these circumstances the Respondent’s threat to use the

domain name for his own ends is abusive and unnecessary, and an infringement of the Complainant's trademark.

The Complainant submits that the Respondent is taking unfair advantage of the Complainant's rights in a way that is seriously detrimental to its business. There is a significant potential for unauthorised exposure of the Complainant's confidential and business information through emails sent to addresses at the forcedry.co.uk address which has been continuously and exclusively in use by the Complainant for three years from 2013 up until 28 June 2016.

Respondent's Submissions

As a Response, the Respondent has simply filed a copy of the letter sent by his solicitors to the Complainant on 23 August 2016 as a response to the Complainant's cease and desist letter of 3 August 2016.

In that letter it is stated that the Respondent accepts that he registered the disputed domain name but denies that any use of the trademark FORCEDRY by the Respondent or anyone else in the trade can constitute infringement of the Complainant's trademark or amount to passing off; that FORCEDRY is a generic term which characterises the Complainant's products; that the Complainant's trademark gives no right to prevent use of the descriptive elements by third parties; and that the Complainant's trademark registration is invalid having regard to s. 3(1)(c) of the Trade Mark Act as it is a mark which may serve in trade to designate the intended purpose of the services covered by the registration.

The Respondent argues that no matter how much use there has been of the mark FORCEDRY by the Complainant, the Complainant cannot possibly have built up an exclusive goodwill and reputation of which it can claim to be a beneficiary. In conclusion the Respondent's solicitors state that the Respondent intends to proceed to seek invalidation of the Complainant's trademark unless the Complainant voluntarily cancels the registration in its entirety and provides evidence of such cancellation within two weeks of the date of the letter.

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.

Paragraph 1 of the DRS Policy defines "Abusive Registration" as meaning 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.

Identical or Similar

The Complainant has furnished convincing evidence that it has rights in the trademark FORCE DRY through use since its incorporation. While the copy of the registration certificate for UK registered trade mark registration number UK00003079374 which has been submitted shows that the trademark is registered in the name of Mr Verity, and not the Complainant company, on the evidence the Complainant has used the trademark with the consent of Mr. Verity since its incorporation.

The disputed domain name is in substance identical to the Complainant's mark. The Respondent has asserted that Mr Verity's trade mark registration is invalid but that is not a factor that the Expert can take into account. The registration is subsisting and it is beyond the jurisdiction of this Expert to determine the status of a registered trade mark which is a matter for another forum.

Accordingly this Expert is satisfied that the Complainant has Rights in respect of a name or mark which is identical or similar to the disputed domain name

Abusive Registration

This Expert accepts the evidence of the Complainant, which has not been denied or refuted by the Respondent, that the Complainant has used the mark FORCE DRY in association with its business of building and hiring-out of temporary electric boiler systems, since incorporation; that prior to incorporation Mr Verity the owner of the Complainant company had used the mark in his business as a sole trader; that the Respondent had no rights of ownership in the Complainant's business but for a brief period acted as a technical consultant advising the Complainant with regard to underfloor heating.

This Expert also accepts the evidence that the Complainant was not aware that the disputed domain name was registered in the name of the Respondent and that this would not have been known to the Complainant while the business continued to use the disputed domain name without interruption for email purposes. When in mid- 2016 the Complainant first experienced problems with its long-standing use of the disputed domain name it became concerned and realising that the domain name was registered in the Respondent's name and it then called for the return of the domain name from the Respondent.

There is no evidence on the record that the Respondent has any rights in the name or mark FORCE DRY or that he has ever used or carried on business using that name.

On the contrary there is evidence that the Respondent registered the disputed domain name in connection with the discussions that were then taking place

about the Respondent becoming involved in the Complainant's business. When that relationship came to an end it would appear the Respondent then allowed the Complainant to use the domain name freely from 2013 to 2016. It was only in 2016 when the Respondent made claims to an interest in the Complainant's business that he apparently disrupted the use by the Complainant of email sent to one or more addresses at the domain name.

The Respondent's response is based entirely on the assertion that the disputed domain name is generic and that the trade mark registration relied upon by the Complainant is invalid.

The evidence in this case does not establish that the term "Force Dry" is in itself generic – no evidence has been adduced for example of any other parties using the term in a similar manner. Even if the term was descriptive when first adopted by the Complainant the evidence shows that the Complainant has used it for at least three years in relation to its business in a manner which has, on the evidence, enabled it to acquire a degree of distinctiveness. The Respondent's case to the contrary is mere assertion, unsupported by evidence and this Expert is not persuaded by it.

On the evidence this Expert finds that the disputed domain name is an Abusive Registration in the hands of the Respondent. In reaching this conclusion, this Expert has taken into account that the Respondent allowed the Complainant to use the disputed domain name for approximately three years without any interference. That is consistent with the Complainant's case that the domain name was registered for use by the Complainant in connection with its business.

The Respondent is in business in an area that is associated with that of the Complainant and has in fact for a brief period provided consultancy services to the Complainant's business. It follows that in these circumstances the threatened use of the disputed domain name by the Respondent would be likely to be confusing and unfairly detrimental to the Complainant's Rights

Accordingly this Expert finds on that balance of probabilities that the Respondent registered the disputed domain name on behalf of the Complainant, as alleged; that he has not used the disputed domain name himself for any purpose; nor has he carried on business using the disputed domain name. By refusing to transfer the disputed domain name to the Complainant, and threatening to use the disputed domain name himself, the Respondent is taking unfair advantage of the Complainant's rights.

7. Decision

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

Signed: James Bridgeman, Expert

Dated 9 February 2017