

DISPUTE RESOLUTION SERVICE

D00018341

Decision of Independent Expert

Harpenden Roofing Company Limited

and

Mr Myles Cash

1. The Parties:

Complainant: Harpenden Roofing Company Limited
West End Farm
Bendish
Hitchin
Hertfordshire
SG48JE
United Kingdom

Respondent: Mr Myles Cash
19 Alldicks Road
Hemel Hempstead
Hertfordshire
HP3 9JJ
United Kingdom

2. The Domain Name:

harpendenroofing.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 into question my independence in the eyes of one or both of the parties.

04 January 2017 14:19 Dispute received
05 January 2017 09:52 Complaint validated
05 January 2017 09:56 Notification of complaint sent to parties
13 January 2017 12:17 Response received
13 January 2017 12:17 Notification of response sent to parties
16 January 2017 10:54 Reply received
16 January 2017 10:54 Notification of reply sent to parties
19 January 2017 12:33 Mediator appointed
19 January 2017 15:35 Mediation started
07 February 2017 11:19 Mediation failed
07 February 2017 11:20 Close of mediation documents sent
17 February 2017 01:30 Complainant full fee reminder sent
21 February 2017 10:59 Expert decision payment received

4. Factual Background

The Complainant, incorporated under the name Harpenden Roofing Company Limited on November 11, 1997, provides roofing services in Harpenden, Hertfordshire.

The Domain Name, harpendenroofing.co.uk, was registered by the Respondent, Mr Myles Cash, on November 7, 2011. It resolves to the website of Optimum Home Improvements Limited, a company run by the Respondent. Incorporated on August 6, 2015, that company provides, in and around Hemel Hempstead, Hertfordshire, including in Harpenden, roofing services similar to those of the Complainant.

5. Parties' Contentions

Complainant

The Complainant asserts the right to the Domain Name because it has used the trading name Harpenden Roofing Company Limited to provide roofing goods and services since its incorporation under that name on 11th November 1997. Previously the business traded simply as Harpenden Roofing for some 14 years, trading primarily in the town and environs of Harpenden.

The registered name of Harpenden Roofing Company Limited is and has been recognised by the public, contractors and suppliers, as indicating both materials and services are supplied by the Complainant, which can be evidenced by advertisements and invoices received and issued.

The Domain Name is an abusive registration because the services offered by Optimum Home Improvements Limited, as shown on its website, to which the Domain Name resolves, are substantially similar to those offered by the Complainant. The Respondent's registered office in Hemel Hempstead, Hertfordshire, and

secondary site in Watford, are both geographically proximate to Harpenden, and in particular offer their services to that locality, as shown on the web site.

Optimum Home Improvements Limited has used the Domain Name to mislead and confuse people into thinking that the Domain Name is controlled by, operated by, registered to, authorised by, or otherwise connected to the Complainant. When the Domain Name is entered directly on the address bar of a search engine, the searcher, a potential customer, is delivered to the web site of Optimum Home Improvements Limited. This clearly leads to “initial interest confusion” since the searcher is led to a web site which offers goods and services substantially similar to those of the Complainant’s business in a geographical location matching both Complainant’s and Respondent’s trading area. There is no similarity between the trading names of the Respondent’s and the Complainant’s businesses, but there is close similarity between the trading type and nature and geographical scope of both businesses. Evidence of confusion is provided by the signed statement of a customer of the Complainant’s business.

The Complainant believes the Domain Name was primarily registered in November 2011 to stop the Complainant registering it. When the Complainant went to register its own domain name in March 2012, the most direct and closely matching domain name was unavailable as already registered by the Respondent, so the Complainant’s web designer chose the hyphenated harpenden-roofing.co.uk. Searchers are much less likely to be able guess the correct URL for the Complainant’s web site. The Respondent would have been well aware of the existence of the Complainant’s business, as it has appeared in Yell.com and other electronic business databases of Hertfordshire, even before it had a web site and its own domain name in 2012. The Complainant has extensively advertised both in hard copy forms, project location displays and advertisements and is well known in the area of Harpenden as suppliers of roofing materials in the area for at least the last 30 years.

Respondent

The Respondent, Mr Myles Cash, says he is the legal owner of the Domain Name and that he runs his own company, Optimum Home Improvements Limited.

The Respondent denies claiming to be Harpenden Roofing or any other firm, saying he purchased key words such as “Harpenden roofing” and “Hemel Hempstead roofing” as these are areas and are often used to search for traders. He says he is within his legal right as owner to use this name as one of his many web addresses. No laws are being broken, the Respondent is not impersonating any other firm and is only using a domain name that he owns, not any one else's.

Reply

The Complainant says the Respondent has failed to understand or address the concerns issued in the complaint.

6. Discussions and Findings

Pursuant to paragraph 2.1 of the Nominet Dispute Resolution Service Policy, version 4, applicable to all disputes filed on or after 1 October, 2016 (“the Policy”), for a complainant to succeed it must prove on the balance of probabilities that:

1. it has Rights in respect of a name or mark which is identical or similar to the Domain Name; and
2. the Domain Name, in the hands of the Respondent, is an Abusive Registration.

Rights

‘Rights’ are defined in the Policy 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.

Nominet’s online guidance tools for parties to disputes include the Experts’ Overview, which makes clear that this definition embraces rights other than trade mark and service mark rights (paragraph 1.4) and notes that the consensus view of recent Experts’ meetings has been that mere registration of a company name at the Companies Registry does not of itself give rise to any rights for this purpose (paragraph 1.7). The appeal panel in DRS 16594 (polo.co.uk) agreed with that approach.

Here the Complainant relies on its claimed use of its corporate name since 1997 as affording it Rights in that name, asserting that the name is and has been recognised by the public, contractors and suppliers as indicating materials and services supplied by the Complainant, which can be evidenced by advertisements and invoices received and issued. However, the Complainant has not produced any advertisements or invoices.

The only evidence produced by the Complainant relevant to this issue is a letter dated August, 2016 from a resident of Harpenden (“the Letter”), which states that the writer has resided in Harpenden for over 50 years; is well aware of many of the local businesses established to serve the local area, and knew Harpenden Roofing Company Limited as a local roofer, having used the Complainant some years previously.

Despite the paucity of this evidence, I am persuaded on the balance of probabilities that the Complainant has used the name Harpenden Roofing Company Limited for some years since its incorporation in 1997 and that, as a result of such use, the name is and has for some years been recognised by the purchasing public of Harpenden as the trading name of the Complainant. This conclusion is strengthened by the fact that the Respondent has not denied the Complainant’s local reputation.

As to whether the Complainant has enforceable rights in that name, it is important to note that although the words “Harpenden Roofing Company Limited” are descriptive, it is not a prerequisite of any action in passing-off that the Complainant demonstrate that those words have acquired secondary meaning or have ceased to be descriptive, as would be necessary where the name in question is a trade mark comprising descriptive words:

“The question is not whether a trader who has chosen to incorporate in his trading style words which are descriptive of the services he performs cannot as a matter of law succeed in a passing-off action based on the use by another trader of a trading style which, by reason of the incorporation of those words, is calculated to deceive, unless he establishes by evidence that such words have acquired a secondary meaning or have ceased to be descriptive of the services rendered...It is not a condition of success in the supposed action that the Plaintiffs should establish that the words in dispute had acquired a secondary meaning”. *Office Cleaning Services, Ltd., v. Westminster Window and General Cleaners, Ltd.*, RPC (1946) 63 (3): 39-43 per Lord Simonds at 41-42.

Accordingly I find that it is more likely than not that the Complainant has enforceable rights in the name Harpenden Roofing Company Limited. The registration of that company name supports this view, even though mere registration is not enough on its own to demonstrate Rights.

I also find the Domain Name to be similar to that name since it comprises the words “harpenden roofing” together with the generic domain suffix “.co.uk”. The absence of the words “Company Limited” and the presence of the suffix do not sufficiently distinguish the Domain Name from the name Harpenden Roofing Company Limited. The suffix is usually disregarded when considering identity or similarity but in this case the “.co” suffix contributes to the similarity by conveying the idea of a company.

Accordingly I find that the Complainant has Rights in respect of a name which is similar to the Domain Name. The Complainant has established this element.

Abusive registration

“Abusive Registration” is defined in paragraph 1 of the Policy 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. is being or has been used in a manner which has taken unfair advantage of or has been unfairly detrimental to the Complainant's Rights.

Paragraph 5 of the Policy sets out a non-exhaustive list of factors, any of which may be evidence that a domain name is an Abusive Registration. The Complainant relies upon the following factors:

- 5.1.1 Circumstances indicating that the Respondent has registered or otherwise acquired the Domain Name primarily:
 - 5.1.1.2 as a blocking registration against a name or mark in which the Complainant has Rights;

- 5.1.2 circumstances indicating that the Respondent is using or threatening to use the Domain Name in a way which has confused or is likely to confuse people or businesses into believing that the Domain Name is registered to, operated or authorised by, or otherwise connected with the Complainant.

Paragraph 3.3 of the Overview addresses the issue of confusing use as follows:

“What is meant by confusing use? The ‘confusion’ referred to in this paragraph of the Policy is confusion as to the identity of the person/entity behind the domain name. Will an Internet user seeing the domain name or the site to which it is connected believe or be likely to believe that “the domain name is registered to, operated or authorised by, or otherwise connected with the Complainant”?

...

Commonly, Internet users will visit web sites either by way of search engines or by guessing the relevant URL. If the domain name in dispute is identical to the name of the Complainant and that name cannot sensibly refer to anyone else, there is bound to be a severe risk that a search engine, which is being asked for the Complainant, will produce high up on its list the URL for the web site connected to the domain name in issue. Similarly, there is bound to be a severe risk that an Internet user guessing the URL for the Complainant’s web site will use the domain name for that purpose.

In such cases, the speculative visitor to the registrant’s web site will be visiting it in the hope and expectation that the web site is a web site “operated or authorised by, or otherwise connected with the Complainant.” This is what is known as ‘initial interest confusion’ and the overwhelming majority of Experts view it as a possible basis for a finding of Abusive Registration, the vice being that even if it is immediately apparent to the visitor to the web site that the site is not in any way connected with the Complainant, the visitor has been deceived. Having drawn the visitor to the site, the visitor may well be faced with an unauthorised tribute or criticism site (usually the latter) devoted to the Complainant; or a commercial web site, which may or may not advertise goods or services similar to those produced by the Complainant. Either way, the visitor will have been sucked in/deceived by the domain name.

...

In DRS 07991 (toshiba-laptop-battery.co.uk) an aspect which the appeal panel regarded as being indicative of abusive use was the fact that the Respondent was using the domain name featuring the Complainant’s trade mark to sell in addition to the Complainant’s goods, goods competing with the Complainant’s goods.

Findings of Abusive Registration in this context are most likely to be made where the domain name in issue is identical to the name or mark of the Complainant and without any adornment (other than the generic domain suffix). See for example DRS 00658 (chivasbrothers.co.uk).

Despite criticism by the Court of Appeal in *Interflora v. Marks and Spencer* [2014] EWCA Civ. 1403 of the use of “initial interest confusion” as a concept relevant to English trade mark law, the Appeal Panel in DRS 15788 (starwars.co.uk) concluded that initial interest confusion remains an applicable principle in determining whether or not a domain name registration is abusive.

Paragraph 8 of the Policy sets out a non-exhaustive list of factors, which may be evidence that the Domain Name is not an Abusive Registration. Two potentially applicable here are:

8.1.1 Before being aware of the Complainant’s cause for complaint (not necessarily the ‘complaint’ under the DRS), the Respondent has:

8.1.1.1 used or made demonstrable preparations to use the Domain Name or a domain name which is similar to the Domain Name in connection with a genuine offering of goods or services; and

8.1.2: The Domain Name is generic or descriptive and the Respondent is making fair use of it.

In determining whether the Domain Name is an Abusive Registration, the Letter is of critical importance. It recounts how the writer, already familiar with the Complainant’s name, having used its services some years ago, and wishing to obtain from the Complainant an estimate for further roofing work in Harpenden, guessed that the Domain Name was that of the Complainant and discovered, upon arrival at the website to which the Domain Name resolved, that it was that of a different company, Optimum Home Improvements Limited, offering services in Harpenden and elsewhere similar to those of the Complainant. This was accordingly a clear case of “initial interest confusion” in which the speculative visitor to the Respondent’s web site visited it in the hope and expectation that the web site was a web site “operated or authorised by, or otherwise connected with the Complainant”.

The Respondent says Harpenden is an area and that areas are often used to search for traders, hence he has the legal right to use the Domain Name and is not impersonating anyone. However, there are circumstances in which use of the name of an area as part of a descriptive name may lead to deception, as shown for example in the Australian High Court decision in *Hornsby Building Information Centre Pty Limited v. Sydney Building Information Centre Limited* [1978] HCA 11; 140 CLR 216, per Stephen J. at 231:

“If the first commercial art gallery in a city meets with an enthusiastic response from the public, competitive galleries are likely to be attracted to the field. They will be free to enter it and to describe themselves as art galleries, that being the descriptive name appropriate to their business; and this despite the fact that the pioneer gallery might have chosen also to style itself "art gallery", prefixed by a regional name. For competitors' conduct to be misleading and deceptive they would have to have adopted as their names the same or a similar regional prefix followed by "art gallery". A quite distinct regional prefix, followed by "art gallery" would neither mislead nor deceive.”

Here the Respondent, located geographically close to the Complainant, registered the Domain Name harpendenroofing.co.uk some years after the Complainant adopted the descriptive name Harpenden Roofing Company Limited, and has used the Domain Name to resolve to a website offering competing roofing services in Harpenden. It is important to remember that, in the words of Lord Simonds in *Office Cleaning Services, Ltd., v. Westminster Window and General Cleaners, Ltd.* (supra) at 42:

“...just as in the case of a trademark the use of descriptive words is jealously safeguarded, so in the case of trade names the Courts will not readily assume that the use by a trader as part of his trade name of descriptive words already used by another trader as part of his trade name is likely to cause confusion and will easily accept small differences as adequate to avoid it”.

Although the Complainant’s name has not acquired secondary meaning and includes the words “Company Limited”, which do not form part of the Domain Name, those words are usually ignored by Internet users seeking website addresses, just as the generic domain suffix “.co.uk” is ignored when considering whether a domain name is identical or similar to a complainant’s name or mark. Accordingly, despite these differences between the Complainant’s name and the Domain Name, I find that the Respondent is using the Domain Name in a way which has confused or is likely to confuse people or businesses into believing that the Domain Name is registered to, operated or authorised by, or otherwise connected with the Complainant, and accordingly that the Domain Name is an Abusive Registration.

The Complainant has established this element.

ii. Decision

I direct that the Domain Name, <harpendenroofing.co.uk> be transferred to the Complainant.

Signed

Dated: March 7, 2017