

DISPUTE RESOLUTION SERVICE

DRS 18803

Decision of Independent Expert

Elevate Loft Conversions Ltd

and

Space Invaders Loft Conversions Limited

1. The Parties:

Complainant: Elevate Loft Conversions Ltd
8 Trevor Drive
Allington
Maidstone
Kent
ME16 0QW
United Kingdom

Respondent: Space Invaders Loft Conversions Limited
9 High Street
WEST MALLING
Kent
ME19 6QH
United Kingdom

2. The Domain Names:

<elevateloftconversions.co.uk>
<elevatelofts.co.uk>
<elevateloftsltd.co.uk>

3. Procedural History

The Complaint was filed with Nominet on 21 April 2017. Nominet validated the Complaint on 24 April 2017 and notified the Respondent by post and by email, stating that the Response had to be received on or before 16 May 2017. The Response was filed on 12 May 2017. Nominet notified the Response to the parties on the same day. Nominet notified the Complainant that a Reply had to be received on or before 22 May 2017 further to an extension granted by Nominet due to technical problems faced by the Complainant. The Respondent's Reply was received on 22 May 2017 and the mediator was appointed on 25 May 2017.

The Informal Mediation procedure failed to produce an acceptable solution for the parties and so on 7 June 2017 Nominet informed the Complainant that it had until 21 June 2017 to pay the fee for the decision of an Expert pursuant to paragraph 7 of the Nominet Dispute Resolution Service Policy ("the Policy"). On 22 June 2017 the Complainant paid Nominet the required fee and also sent a non-standard submission to Nominet pursuant to paragraph 17 of the Policy. The Expert decided to admit the Complainant's non-standard submission as it simply provided supporting documents referred to in the Complaint and Reply.

On 26 June 2017 the undersigned, David Taylor ("the Expert"), confirmed to Nominet that he was independent of each of the parties and that, to the best of his knowledge and belief, there were no facts or circumstances, past or present (or that could arise in the foreseeable future) that needed to be disclosed as they might be of such a nature as to call in to question his independence in the eyes of one or both of the parties.

On 11 July 2017 the Expert sent a request for a Further Statement by the Complainant to Nominet, in accordance with paragraph 17.7 of the Policy. The Expert requested the Complainant to produce evidence sufficient to establish unregistered rights in the name Elevate Loft Conversions Ltd. Nominet sent this request to both parties by email on 12 July 2017 and gave the Complainant until 19 July 2017 to file a Further Statement and the Respondent until 25 July 2017 to submit any comments in relation to the Complainant's Further Statement only. On 19 July 2017, the Complainant produced the requested evidence. No further submissions were received by Nominet from the Respondent.

4. Factual Background

The Complainant is a company registered in the UK on 21 November 2014 specialized in loft conversions.

The Respondent is also a loft conversion company registered in the UK on 27 June 2014, although its predecessor company, Space Invaders Ltd, was registered in 2003. The Respondent's website is available at <http://www.spaceinvaderslimited.co.uk>.

The Complainant's representative is a former employee of the Respondent's predecessor company, Space Invaders Ltd.

The Disputed Domain Names were registered by the Respondent on 1 September 2016 and they are not resolving. The Respondent's representative then registered the company Elevation Loft Conversions Ltd on 25 April 2017, four days after receiving the Complaint.

5. Parties' Contentions

Complaint

The Complainant submits that it is a UK company registered since November 2014 (Company No. 9322097). The Complainant further submits that the Disputed Domain Names are Abusive Registrations as the Respondent, who is a competitor of the Complainant, primarily registered them to prevent the Complainant from registering the Disputed Domain Names despite its rights in the name Elevate Loft Conversions Limited.

The Complainant also explains that the Respondent is an "old friend" and a former employer in the same industry. The Complainant further submits that the Respondent was aware of the Complainant's business activities and that the Respondent has attempted to block the Complainant's progression by registering the Disputed Domain Names. The Complainant argues that, since purchasing the Disputed Domain Names, the Respondent has not used nor intended to use them as they cannot do so given that they have no relevance to the Respondent's business but to the Complainant's. The Complainant contends that the Respondent is simply holding on to the Disputed Domain Names to continually disrupt the Complainant's business. The Complainant considers that the Respondent's conduct is abusive as the Respondent has deliberately registered the Disputed Domain Names to hinder the Complainant's development. In this regard, the Complainant points out that it has been unable to set up a website and the Respondent is preventing the Complainant from generating potential new business. The Complainant also states that the Respondent has shown particular interest in disrupting the Complainant.

The Response

The Respondent, Space Invaders Loft Conversions Limited, is a company registered in the UK since 27 June 2014, which was set up by two co-directors following the failure of a prior company, Space Invaders Ltd.

The Respondent's representative explains that the company Space Invaders Loft Conversions Limited was set up with the idea of subsequently setting up a new company called Elevate Construction, in order to salvage the friendship between both of its co-directors, whose friendship had been strained due to the failure of the previous company, Space Invaders Ltd.

The Respondent submits that "Elevate Construction" had already been taken as a business name and domain name and so it then attempted to acquire "Elevate Group" but this name was also taken both as a business name and domain name. The Respondent explains that, as a result of this, it proceeded to register "Elevation Loft Conversions" and "Elevate Loft Conversion" domain names and the company Elevation Loft Conversions Ltd. The Respondent submits that the Disputed Domain Names have absolute relevance to its business and company name and will prove vital in the success of its planned future venture with websites and Google advertising, etc.

The Respondent's representative further asserts that the Complainant's representative previously worked for the Respondent's predecessor company, Space Invaders Ltd, and

that upon leaving the company the Complainant's representative had expressed a desire to pursue other carpentry work. The Respondent's representative states that although he was aware that the Complainant's representative contracted works of a varied nature from another builder, he had no knowledge that the Complainant's representative intended to set up a loft conversion business or had in fact registered a company with the name Elevate Loft Conversions.

Finally the Respondent asserts that not owning the Disputed Domain Names would disrupt and hinder the Respondent's own progression and that its idea had already been hindered and disrupted by the Complainant's representative.

Reply

The Complainant states that the Respondent's response is a complete fabrication. The Complainant underlines that it has been in existence for three years now and that the fact that the Respondent also set up its company in 2014 shows that the Respondent's representative had no intention of setting up an additional loft conversion company with a similar name to the Complainant's name. The Complainant points out that the fact that the Respondent's additional company Elevation Loft Conversion Ltd was registered coincidentally 4 days after receipt of the Complaint, with no directors, no shareholders, no employees and certainly no trading history of any kind, shows that it is an "empty company". The Complainant submits that "this company has simply been registered in a panic attempt to continue disrupting the progress of my company".

The Complainant points out that it successfully operates its company solely by word of mouth and small advertising (sign on its vans and banners) and naively did not purchase any domain names or set up a website. The Complainant states that now that it is at the stage of expansion, a website is necessary for its advertising campaign and not having one is preventing the Complainant from generating a substantial amount of potential work. The Complainant also stresses that not owning the Disputed Domain Names and having a live website is causing considerable detriment to its business.

The Complainant also points out that it is clear that the Respondent's co-representatives are very active and currently working on numerous ongoing projects, as shown for instance by the Respondent's Instagram page (Space Invaders Group). The Complainant asserts that it finds odd that two experienced business owners would wait three years to register or pursue a business that is apparently very important to them.

Finally, the Complainant stresses that it has worked extremely hard to create a successful company and brand and that the Disputed Domain Names are crucial for its business whereas the Respondent's additional company Elevation Loft Conversions Ltd is clearly an empty company designed to block the Complainant's progression.

6. Discussions and Findings

General

Under paragraph 2.1 of the Policy, for the Expert to order a transfer of the Disputed Domain Names, the Complainant is required to demonstrate, on the balance of probabilities, both of the following elements:

"2.1.1 The Complainant has Rights in respect of a name or mark which is identical or similar to the Domain Name; and

2.1.2 The Domain Name, in the hands of the Respondent, is an Abusive Registration."

Complainant's Rights

The Policy defines Rights 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"*.

The Complainant seeks to assert Rights in the Disputed Domain Names based on its company name Elevate Loft Conversions Ltd. However, the consensus view amongst Nominet Experts is that *"the mere registration of a company name at the Companies Registry does not of itself give rise to any rights"* for the purpose of this proceeding (see the Experts' Overview, paragraph 1.7).

In view of the fact that the Complainant's company name is in and of itself insufficient to establish Rights for the purposes of the Policy, and that the Complainant has not supplied evidence of registered trade mark rights, it is necessary to examine whether the Complainant can rely on other Rights, such as unregistered trade mark rights, to support its Complaint.

In this regard, Paragraph 2.2 of the Experts' Overview provides that: *"If the right is an unregistered trade mark right, evidence needs to be put before the Expert to demonstrate the existence of the right. This will ordinarily include evidence to show that (a) the Complainant has used the name or mark in question for a not insignificant period and to a not insignificant degree (e.g. by way of sales figures, company accounts etc) and (b) the name or mark in question is recognised by the purchasing trade/public as indicating the goods or services of the Complainant (e.g. by way of advertisements and advertising and promotional expenditure, correspondence/orders/invoices from third parties and third party editorial matter such as press cuttings and search engine results)."*

The Complainant has submitted considerable evidence showing that it has been trading as "Elevate Loft Conversions" since 2014 and that it has made substantial efforts to develop its business, as shown by invoices, brochures, photograph of its van displaying the name "Elevate Loft Conversions", etc. Furthermore, the first hurdle under the Policy is intended to be a "relatively low-level test" and the objective is simply to demonstrate "a *bona fide* basis for making the complaint" and so the Expert considers that the Complainant has established Rights in accordance with the Policy. See paragraph 2.3 of Experts' Overview.

The Policy also requires the Expert to examine whether the name in which the Complainant has Rights is identical or similar to the Disputed Domain Names. The Disputed Domain Names contain the terms ELEVATE LOFT CONVERSIONS, ELEVATE LOFTS, and ELEVATE LOFTS LTD and so the Complainant's name is recognizable in the Disputed Domain Names. Furthermore, it is accepted practice under the Policy, where appropriate, to discount the ".co.uk" suffix for the purpose of assessing identity or similarity, and so the Expert finds that the Complainant's name and the Disputed Domain Names are similar.

Therefore, the Expert finds that the Complainant has Rights in respect of a name or mark which is similar to the Disputed Domain Names, in accordance with paragraph 2.1.1 of the Policy.

Abusive Registration

Paragraph 1 of the Policy defines "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."

Paragraph 5.1 of the Policy sets out a non-exhaustive list of factors which may be evidence that a domain name is an Abusive Registration. The Complainant appears to rely on the following:

"5.1.1 Circumstances indicating that the Respondent has registered or otherwise acquired the Domain Name primarily:

5.1.1.1 ...

5.1.1.2 as a blocking registration against a name or mark in which the Complainant has Rights; or

5.1.1.3 for the purpose of unfairly disrupting the business of the Complainant;

The Expert agrees with the Complainant that the Respondent's the Disputed Domain Names are Abusive Registrations in accordance with paragraph 5.1.1.2 and 5.1.1.3 of the Policy.

On the basis of the Parties' submissions, the Parties accept that the Complainant was established by a former employee of the Respondent's predecessor company and set up his own competing business using the name "Elevate Loft Conversions Ltd". The Respondent's explanation as to why it registered the Disputed Domain Names is that it originally intended to set up a new company called "Elevate Construction" but that the business name and corresponding domain names were already taken, and that the same occurred with the name "Elevate Group". The Respondent also explained that it then opted for "Elevation Loft Conversions" as a company name and registered "Elevation Loft

Conversions" domain names as well as the Disputed Domain Names. The Respondent further asserts that it was aware that the Complainant continued carrying out carpentry work upon leaving the Respondent's predecessor company but denies having knowledge that the Complainant had established a company called Elevate Loft Conversions Ltd. The Respondent does not argue nor has submitted evidence that the Complainant was aware of the Respondent's intention to establish a company using the name "Elevate Construction", "Elevate Group" or "Elevation Loft Conversions".

The Expert is, however, not persuaded by the Respondent's explanation for registering the Disputed Domain Names. The Respondent states that his new company is called "Elevation Loft Conversions Ltd" yet, given the nature of the Respondent's company name, the Disputed Domain Names would not seem relevant to the Respondent's business. The Respondent has stated that, in addition to having registered the Disputed Domain Names, it has also registered "Elevation Loft Conversions" domain names. However, the Respondent has failed to provide any evidence in this regard. The Expert has therefore carried a brief search on Nominet's Whois database and has found that the domain names <elevationloftconversions.co.uk> and <elevationloftsltd.co.uk>, which would seem more appropriate for the Respondent's business, are, at the time of writing of this decision, available for registration. Furthermore, the domain name <elevationlofts.co.uk> appears to have been registered (albeit using a privacy protection service) on 24 April 2017, precisely on the same day the Complaint was notified to the Respondent. Moreover, the Respondent's company Elevation Loft Conversions Ltd was registered on 25 April 2017, four days after the filing of the Complainant's Complaint with Nominet. The Respondent has not provided any explanation as to why it waited until having notice of this dispute to register the company name on which it seeks to rely on to justify its interest in the Disputed Domain Names. The Expert is therefore of the view that these facts are, on the balance, strong indications that the Respondent had no genuine intention to set up a company with a similar name to the Complainant's but was rather attempting to seek to retrospectively justify the Respondent's choice of the Disputed Domain Names.

The Expert therefore finds that, on the balance, given the overall circumstances of this case, in particular the prior relationship between the Parties and the nature of the Disputed Domain Names themselves, which are highly similar to the Complainant's name, coupled with the timing of the Respondent's company registration, it seems likely that the Respondent had knowledge of the Complainant's Rights at the time of registration of the Disputed Domain Names and therefore, in the absence of any evidence that the Respondent's intentions were *bona fide*, registered them primarily as a blocking registration and for the purpose of unfairly disrupting the Complainant's competing business, in accordance with paragraphs 5.1.1.2 and 5.1.1.3 of the Policy.

As for (ii) above, and whether the Respondent has used the Disputed Domain Names in an abusive manner, the Disputed Domain Names are not resolving. However, paragraph 5.1.2 of the Policy expressly provides that evidence of a threatened use may constitute evidence of abusive use: "*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*". The Expert therefore finds that, given the overall circumstances of this case, including the nature of the Disputed Domain Names which are relevant to the Complainant's business, the prior relationship between the Parties, and the fact that the Complainant has now established itself as a

competitor of the Respondent, the Respondent's non-use of the Disputed Domain Names constitutes in the circumstances of this case a threat hanging over the head of the Complainant that amounts to Abusive Registration within the meaning of the Policy, as Internet users will likely be misled into thinking that the Disputed Domain Names are registered to, operated or authorised by the Complainant, when in fact they are not. See paragraphs 1.3 and 3.3 of the Experts' Overview and DRS0658 (<chivasbrothers.co.uk>).

Finally, paragraph 4 of the Policy provides a non-exhaustive list of circumstances which may be evidence that the Disputed Domain Names are not Abusive Registrations. None of those circumstances would seem to assist the Respondent. In particular, there is no evidence that the Respondent has used or made demonstrable preparations to use the Disputed Domain Names in connection with a genuine offering of goods or services or in a legitimate non-commercial or fair manner. Neither is the Respondent commonly known by the Disputed Domain Names. Furthermore, the Disputed Domain Names are neither generic nor descriptive but rather enjoy a not insignificant degree of distinctiveness.

In conclusion, the Expert has considered the admissibility, relevance, materiality and weight of the evidence as a whole and is satisfied that the Complainant has succeeded in proving, on the balance of probabilities, that the Disputed Domain Names are Abusive Registrations, in accordance with paragraph 2.1.2 of the Policy.

7. Decision

The Expert finds that the Complainant has Rights in a name or mark which is similar to the Disputed Domain Names, and that the Disputed Domain Names, in the hands of the Respondent, are Abusive Registrations. The Disputed Domain Names should therefore be transferred to the Complainant.

Signed: David Taylor

Dated: 28 July 2017