

DISPUTE RESOLUTION SERVICE

D00010469

Decision of Independent Expert

Hamways Limited

and

Mr Jon Whitehead

1. The Parties:

Complainant: Hamways Limited
30 City Road
London
EC1Y 2AB
United Kingdom

Respondent: Mr Jon Whitehead
61A Perham Road
Basement Flat
London
W14 9SP
United Kingdom

2. The Domain Name:

hamways.co.uk

3. Procedural History:

16 November 2011 15:51 Dispute received
17 November 2011 10:12 Complaint validated
17 November 2011 10:23 Notification of complaint sent to parties
28 November 2011 11:32 Response received
28 November 2011 11:33 Notification of response sent to parties
01 December 2011 01:30 Reply reminder sent

05 December 2011 17:21 Reply received
05 December 2011 17:21 Notification of reply sent to parties
06 December 2011 15:20 Mediator appointed
08 December 2011 15:34 Mediation started
13 January 2012 11:40 Mediation failed
13 January 2012 11:41 Close of mediation documents sent
25 January 2012 01:30 Complainant full fee reminder sent
26 January 2012 12:42 Expert decision payment received

I was thereafter contacted by Nominet and asked to confirm that I was able to provide an Expert Decision. I responded to Nominet confirming that I had no conflict preventing me from providing a decision.

The matter was thereafter duly referred to me, Simon Chapman, ("the Expert") for an Expert Decision.

It should be noted that the Registrant of the Domain Name according to the *whois* information held by Nominet is Jack Whitehead, although the Respondent identified herein is Jon (or Jonathan) Whitehead who is the son of Jack Whitehead. I am satisfied from the information that I have seen that the Domain Name was registered for the use and benefit of Jon Whitehead and that notwithstanding the name recorded in the *whois* information, Jon Whitehead should properly be regarded as the registrant of the Domain Name and the Respondent to this Complaint. In this respect I am mindful that Nominet's Dispute Resolution Service Policy (the "Policy") defines a Registrant as "*the person (including a legal person) in whose name or on whose behalf a Domain Name is registered*".

If I am wrong as to the conclusion reached above, I am nevertheless content that Nominet have properly notified the Complaint to the recorded registrant and the registrant has been given the opportunity to submit a Response to the Complaint.

4. Factual Background

The Complainant was incorporated in 2007 and has since traded as a chartered surveyors practice and/or a property managing agent under the name "Hamways", and prior to incorporation for many years as "Hamways Chartered Surveyors".

The Domain Name was registered in July 2008. It was registered by Jack Whitehead, but on behalf of his son, the Respondent. The Respondent is the leaseholder of a property for which the Complainant is the managing agent. When the Respondent encountered a number of difficulties concerning the maintenance of his property he registered the Domain Name as "a forum for the documentation" passing between him and the Complainant concerning those difficulties and his complaints.

The Complainant has objected to the Respondent's registration and use of the Domain Name and they have communicated with each other both directly and via legal representatives, although the Respondent has on each occasion rejected the

Complainant's objections. The Complainant made an offer last year of £2,500 to acquire the Domain Name from the Respondent, although this was rejected.

5. Parties' Contentions

Complaint

The Complainant asserts that it has 'Rights' as defined in the Policy because of the goodwill that it has gained as a result of its extensive use of the name "Hamways" and/or "Hamways Chartered Surveyors"; the use of the domain name <hamways.com>; and the fact that one of its directors and its company secretary both have the surname 'Hamway'.

It says that the Domain Name is an Abusive Registration because the Respondent registered it (i) to prevent the Complainant from being able to do so; (ii) to gain leverage in his attempts to purchase the freehold of the building in which his flat is situated; (iii) to unfairly use the website to the detriment of the Complainant; (iv) to confuse the Complainant's customers or potential customers; (v) to defame the Complainant and/or pressure it in the dispute over the maintenance of his property; (vi) because false details of the Registrant were provided to Nominet; and (vii) he has no apparent rights in the Domain Name.

Response

The Respondent does not accept that the Complainant has Rights in the name 'Hamways' because other companies trade under that name. He does not accept that the Complainant has acquired goodwill in the use of its name, and nor does he accept that the Domain Name is identical to a name in which the Complainant has rights.

He does not accept that the Registration is abusive for the following reasons. (i) It was registered to enable him to communicate with the Complainant concerning the issues that related to the management of his property, and not to damage the Complainant's reputation. (ii) Information published on the site was factual and not defamatory. (iii) The site was not created to look like the Complainant's site and it is unlikely that anyone would have been confused. (iv) He has not submitted the site to search engines or attempted to draw it to public attention. (v) It is not the intention of the Respondent to sell or transfer the Domain Name, although any decision to sell the domain name would have to be taken by Jack Whitehead, as the registrant of the Domain Name. (vi) False details were not given to Nominet, the registrant is the Respondent's father. (vii) The Domain Name was not registered to assist in the purchase of the freehold of the Respondent's property, and nor is the Complainant prevented from using its name as it has the domain name <hamways.com>.

Reply

The Complainant asserts that the Domain Name is an Abusive Registration in the hands of either Jonathan Whitehead as the true registrant, or Jack Whitehead as the recorded registrant.

It says that the background to the dispute between the Respondent and the Complainant regarding the Respondent's property is not relevant to the dispute concerning the Domain Name. The true intention behind the registration of the Domain Name was to facilitate the resolution of the dispute concerning the property by airing information in a public forum, rather than using private methods of communication. The Complainant challenges the Respondent's assertion that only factual information was put on the site, and believes that certain information concerning repairs that had been undertaken were incorrect.

The use made of the Domain Name as a tribute or criticism site was not fair because it was intended to draw facts to the Complainant's attention, and insofar as he wanted to criticise the Complainant he should not have used a domain name identical to the Complainant's name.

The information posted on the site was done to draw adverse inferences to the Complainant's reputation, which could be viewed by persons seeking to locate the Complainant, or at the least to block the Complainant's use of the Domain Name.

6. Discussions and Findings

General

To succeed in this Complaint, the Complainant must, in accordance with paragraph 2 of the Policy, prove to the Expert on the balance of probabilities that:

- (i) it has Rights (as defined in paragraph 1 of the Policy) in respect of a name or mark identical or similar to the Disputed Domain Name; and
- (ii) the Disputed Domain Name in the hands of the Respondent is an Abusive Registration (as defined in paragraph 1 of the Policy).

The Complainant must make out its case to the Expert on the balance of probabilities.

Complainant's Rights

The DRS Policy defines Rights as follows –

“Rights means rights enforceable by the Complainant, whether under English law or otherwise, and may include rights in descriptive terms which have acquired secondary meaning.”

In my view the historical use of the name ‘Hamways’ by the Complainant would be such as to give rise to goodwill, and qualify the Complainant as having ‘Rights’ under the Policy. The fact that other parties also use the name or mark ‘Hamways’ is not such as to deprive the Complainant of goodwill in the sector in which it operates.

The Policy requires such Rights to be in a name or mark identical or similar to the Domain Name. For the purpose of analysing whether the Domain Name is identical or similar to the name or mark in which rights are claimed, one may ignore the .co.uk suffix. The comparison is therefore between ‘HAMWAYS’ on the one hand, and ‘HAMWAYS’ on the other. In my opinion the Complainant has established that it has Rights in a name or mark identical to the Domain Name.

Abusive Registration

I now go on to consider the extent to which the Domain Name is an Abusive Registration.

The Complainant asserts that the registration of the Domain Name is an Abusive Registration for the reasons identified above. The 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 took unfair advantage of or was unfairly detrimental to the Complainant's Rights"*

and goes on to set out a (non-exhaustive) list of factors which may be evidence that a domain name is an Abusive Registration.

In most circumstances where a Respondent has registered a domain name that is identical or similar to a name or mark in which the Complainant has rights, and the Complainant's name or mark was known to the Respondent, one would be unlikely to have a great deal of difficulty in concluding, as many Experts have previously, that the relevant domain name would be an abusive registration.

However, that would not be the case in circumstances where the domain name is being used for a site solely in tribute to or in criticism of a person or business (see Paragraph 4(b) of the Policy).

In *Hanna-Barbera Productions, Inc v Graeme Hay* (DRS 00389), the Respondent had registered the domain name <scoobydoo.co.uk> and was operating the relevant website as an unofficial tribute website. The website contained a notice/disclaimer which informed visitors that it was unauthorised and not connected to the relevant rights' owners. On the site, the Respondent made available for sale official merchandise, and he also allowed people to register sub-domains for email use. The appeal panel concluded that the disclaimer on the site was of little effect, because by the time it was seen the Respondent would have benefited from a business opportunity that it would not otherwise have had. It also concluded that for a tribute or criticism site, it was not necessary to select the exact name of the person to whom one wished to pay tribute or criticise, and that by doing so, it was likely that some 'initial interest confusion' would arise. The appeal panel were unanimous in the view that the adoption of an identical name in the circumstances of that case was not fair and said that "*Impersonation can rarely be fair*".

In Appeal case DRS 06284 (*rayden-engineering.co.uk* and *rayden-engineering.org.uk*) where the domain names in issue were identical to the Complainant's name, the Panel said that –

"In effect the Respondent is posing as the Complainant in order to attract members of the public to the site."

and went on to say that –

"As reflected in the <scoobydoo.co.uk> appeal decision cited above, the majority view amongst Nominet Experts is that where a registrant registers or uses a domain name so as to take advantage of "initial interest confusion", which causes a user to visit a website expecting it to have some connection with a well-known name comprised in or constituting the domain name, he takes unfair advantage of the Rights in the name."

In the present case, it is my view that the Respondent's true intention behind the registration of the Domain Name was that he wanted his complaint against the Complainant to be publicly accessible, such that people looking for the Complainant were likely to come across the Respondent's website, and for the content of that site to cause embarrassment to the Complainant. In that respect I agree with the Complainant's submission that the logical action for the Respondent to take if he had really only wanted to communicate with the Complainant would have been for him to email the Complainant, or choose a website address that would not cause such embarrassment, for example <jonwhitehead.co.uk> or similar. I am therefore of the opinion that the registration was for the purpose of a 'protest' site. I am unable to reach any view on whether the Respondent's protest was valid or not, however the selection of a domain name identical to the Complainant's name was unfair because it impersonated the Complainant and there is a strong likelihood that it would create initial interest confusion.

I would briefly add that the Respondent seems to have played rather fast and loose with the issue of who the registrant of the domain name is. On the one hand

he has been happy to communicate with the Complainant concerning the registration, but when it suited him, he appeared to hide behind the fact of his father being the registrant. I should say though that this view has not influenced the conclusion that I have reached above, and nor am I minded to reach a conclusion that false details were provided to Nominet. I am also not persuaded on the basis of the materials that I have seen, that there was an intention per se by the Respondent to block the Complainant's use of the Domain Name; that he had the intention to sell it to the Complainant; use it to gain leverage in his dispute with the Complainant; or to acquire the freehold of his property on more favourable terms.

In the circumstances as described herein, it is my view that the Domain Name takes unfair advantage of and is unfairly detrimental to the Complainant's Rights.

7. Decision

For the reasons set out above, I find that the Complainant does have Rights in respect of a name or mark which is identical to the Domain Name <hamways.co.uk> and that the Domain Name in the hands of the Respondent is an Abusive Registration. The Complaint therefore succeeds.

The disputed Domain Name should be transferred to the Complainant.

Signed Simon Chapman

Dated 03 February 2012