

**DISPUTE RESOLUTION SERVICE**

**D00010773**

**Decision of Independent Expert**

Southern Fabrication Ltd

and

Southern Fabrications (Sussex) Ltd

**1. The Parties**

**Complainant:**

Southern Fabrication Ltd  
5 Mannings Heath Rd  
Mannings Heath  
Poole  
Dorset  
BH12 4NQ  
United Kingdom

**Respondent:**

Southern Fabrications (Sussex) Ltd  
24 Park Rd South  
Havant  
Hants  
PO19 1HB  
United Kingdom

**2. The Domain Name**

*southernfabrications.co.uk*

### 3. Procedural History

17 January 2012, 22:08	- Dispute received.
18 January 2012, 12:25	- Complaint validated.
24 January 2012, 14:02	- Notification of Complaint sent to Parties.
15 February 2012, 09:47	- No response received.
15 February 2012, 09:47	- Notification of no response sent to Parties.
28 February 2012, 11:31	- Response received.
28 February 2012, 11:31	- Notification of response sent to Parties.
01 March 2012, 08:00	- Reply received.
01 March 2012, 08:01	- Notification of reply sent to Parties.
01 March 2012, 08:02	- Mediator appointed.
07 March 2012, 15:38	- Mediation started.
22 March 2012, 12:40	- Mediation failed.
22 March 2012, 12:40	- Close of mediation, documents sent.
23 March 2012, 12:06	- Expert decision payment received.

### 4. Factual Background

- 4.1 The Complainant was formed as a partnership in September 1971 – and the partnership continued until the Complainant was incorporated as a limited company on 10 April 2000 (Company No. 3968217).
- 4.2 The Complainant has been trading for over 40 years in structural steelwork and related services, supplying the major trades along the South Coast of England.
- 4.3 The Respondent is a limited company (Company No. 6144600) - incorporated in 2007 under a different company name, changing its name to its current company name on 23 February 2009.<sup>1</sup> It also trades in structural steelwork within in the same geographical area as the Complainant.<sup>2</sup>
- 4.4 The Domain Name was registered by the Respondent on 6 February 2009. The Respondent uses the website affiliated with the Domain Name (the 'Website') to offer the same goods/services as the Complainant.
- 4.5 The Complainant registered its domain name, *southernfabrication.co.uk*, on the 18 February 2011.

### 5. Parties' Contentions:

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<sup>1</sup> Information gathered by a basic search of Companies House, UK, register.

<sup>2</sup> Based on evidence provided to the Expert, and information set out on the website affiliated with the Domain Name (as of the date of the Decision).

## The Complaint:

- 5.1 In summary, the Complainant submitted that the Domain Name should be transferred to it for the reasons below.

### The Complainant owns Rights in the Domain Name

- As it has been going for over 40 years, the Complainant stated that it has never advertised its services; relying instead on word of mouth, people's recommendations, and customer Internet searches to generate custom.
- The Complainant stated that it bought the domain names, *southernfabrication.co.uk* and *.com*, in order to create a website presence for its business.

### The Domain Name, in the hands of the Respondent, is an Abusive Registration

- The Complainant stated that - the Respondent had registered its company name as *Southern Fabrications (Sussex) Ltd* with Companies House, is a company that also makes structural steelwork, and the Respondent has only been trading for a few years. The Complainant stated that the Respondent registered the Domain Name, and the domain name, *southernfabrications.com*, by "just adding" an 's' to the end of the Complainant's company name (the 'Name').
- The Complainant stated that the Respondent answers the phone as "Southern Fabrication", and has its search engine optimisation key words set to *southernfabrication* - so that when a person types *southernfabrication* into Google, the Respondent's name appears first.
- The Complainant considered that the Complainant's and the Respondent's similar names cause "massive confusion" to its customers. The Complainant stated that it knows of customers and suppliers who have tried to contact it but have got the Respondent instead.
- The Complainant stated that the Respondent sent out leaflets to its customers with the Complainant's Name on them but that those leaflets had the Respondent's phone number on them. [The Expert assumes, based on the evidence provided to him, that the Complainant's reference to the Respondent's use of the Name is to the Respondent referring to itself as *Southern Fabrications* (i.e. with the pluralisation 's' at the end of the Name).]

- The Complainant stated that it has had the Respondent's suppliers phoning it by mistake, and that it had a payment of £40 000 transferred to it in error, as the payer got confused as to which company provided the payer with the service. [The Complainant provided the Expert with further examples of such confusion, including where a long standing client had sent an enquiry to the Respondent in error.]
- The Complainant considered that the situation is "getting out of control" – with every recommendation that the Complainant gets from its hard work and "a job well done" seeming to help advertise the Respondent.
- The Complainant submitted that the Respondent should not have registered a domain name which did not match its company name and which merely involved just adding an 's' to the end of what is the Complainant's Name, for a business doing exactly the same work and in the same product area.
- The Complainant asked for the transfer to it of the two names the Respondent has. [The Expert assumes that this is a reference to both the Domain Name and the *southernfabrications.com* domain name. The Expert notes that Nominet only has jurisdiction over *.uk* top-level domain names, and not *.com* top-level domain names. As such, the Expert can only consider the extent to which the Domain Name (as it ends with *.co.uk*), rather than any *.com* domain name, should be transferred to the Complainant under Nominet's dispute resolution procedure (the 'Procedure') and policy (the 'Policy').]

**Respondent's response:**

- 5.2 In summary, the Respondent submitted that the Domain Name should not be transferred to the Complainant for the reasons set out below.
- The Respondent registered the Domain Name on 6 February 2009 and has used the same without complaint, except by the Complainant in this case, ever since.
  - The Complainant registered the domain name *southernfabrication.co.uk* on the 18 February 2011, two years after the Respondent's registration of the Domain Name. The Respondent may make its own complaint at this confusing registration.
  - The Respondent submitted that, as its registration of the Domain Name was first in time to the Complainant's registration of *southernfabrication.co.uk*, its registration of the Domain Name should stand as against any subsequent registration that has caused or could cause confusion.

- The Respondent submitted that the only circumstance in which the Domain Name should be de-registered following the registration of a new domain (such as *southernfabrication.co.uk*) is where, at the time the Domain Name was registered, the intention was to defeat registration by a further domain with a similar name.
- The Respondent stated that a search of the Companies House register would reveal a number of companies registered with names similar to that of both the Complainant and the Respondent. [The Expert notes that no evidence was provided by the Respondent to support this statement.]
- The Complainant has failed to establish that the Respondent's registration of the Domain Name, which was registered two years before the Complainant registered *southernfabrication.co.uk*, is abusive.
- Finally, as evidence of the Complainant's bad faith, the Complainant has caused entries to be made on the 'web' under the title *southernfabrications* but, thereafter, referring to itself. The Respondent submitted that this would likely cause confusion and would appear to be a deliberate attempt by the Complainant to misuse its own domain.

**Complainant's Reply:**

5.3 The Complainant replied that, in summary:

- it chose its web address, [www.southernfabrication.co.uk](http://www.southernfabrication.co.uk), as it matches the Name – and when the Complainant's work is recommended by customers, it is natural that potential new customers would enter the Name into web search engines to find the Complainant and its contact details.
- However, by entering the Name into web search engines, what appears are links to the Domain Name, which is not the Complainant. In the Complainant's opinion, this confuses people.
- The Complainant stated that, when a person calls the Respondent, the Respondent's employees answer the phone as *Southern Fabrication*.
- Although the Respondent considered that there is no confusion, the Complainant has a record of phone calls from both new customers and, more confusingly, suppliers who are innocently confused by the misleading title of which company they are dealing with.
- The Complainant expressed its concern that, while its employees travel around the country promoting its business to potential new customers, a simple Google search using the Name brings up the

Respondent rather than the Complainant. In this way, the Complainant is essentially helping to advertise the Respondent's services.

- The Complainant considered it "strange" that the Respondent, a company that has only been trading for a few years, would use the Domain Name which does not match its business name but matches the Name of the Complainant.

**Non-standard submission under paragraph 13b of the Procedure:**

- 5.4 On 12 April 2012, the Complainant asked that it be allowed to submit a non-standard submission under paragraph 13b of the Procedure, and filed with Nominet an explanation why in its view there was an exceptional need for such a submission.
- 5.5 On 16 April 2012, after consideration of the explanation provided, the Expert declined the Complainant's request as he considered that the explained substance of the non-standard submission had already been evidenced by the Complainant in the Complaint.

## **6. Discussions and Findings**

### *General*

- 6.1 To succeed in the Complaint, the Complainant has to prove pursuant to paragraph 2 of the Policy that, on the balance of probabilities<sup>3</sup>:

*"(i) [it] has Rights in respect of a name or mark which is identical or similar to the Domain Name [paragraph 2.a.i. of the Policy]; and,*

*(ii) The Domain Name, in the hands of the Respondent, is an Abusive Registration [paragraph 2.a.ii. of the Policy]."*

- 6.2 Addressing each of these limbs in turn:

#### *i) Complainant's Rights*

- 6.3 Paragraph 1 of 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;"*

also, the Complainant must have the Rights at the time of the complaint.<sup>4</sup>

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<sup>3</sup> I.e. on the basis that the Complainant's case is more likely than not to be the true version, see <http://www.nominet.org.uk/disputes/drs/legalissues/>.

<sup>4</sup> See for example, Nominet Appeal decision, *ghd*, DRS No. 03078, at page 9, para 9.2.2.

- 6.4 The Complainant has not brought forward evidence that it has obtained registered trademark protection for the Name; a registered trademark being an enforceable right as understood by the above definition.
- 6.5 Also, while the Name is identical to that of its registered company name at Companies House – in the view of the Expert, the mere registration of a company name does not of itself give rise to any Rights.
- 6.6 As the above definition of Rights embraces other enforceable rights other than a registered trade (or service) mark, the Expert has considered whether such a non-registered enforceable right arises in the Name (the Name being substantially identical (and certainly similar) to the Domain Name, not counting the generic *.co.uk* suffix or the addition of the pluralisation ‘s’ at the end).
- 6.7 The Expert considers that relevant to this consideration is whether:
- (a) the Complainant has used the Name for a not insignificant period and to a not insignificant degree; and,
  - (b) the Name is distinctive of (i.e. indicates to the purchasing public (including trade purchasers)) the goods or services of the Complainant.

Addressing each of these considerations in turn:

- 6.8 In relation to consideration (a), the Expert notes that the Complainant was formed in 1971 and has carried on its business activities under the Name ever since (either as a partnership or as a limited company). Therefore, the Complainant in this way has used the Name for a ‘not insignificant’ period.
- 6.9 In addition, the Expert considers that the use of the Name by the Complainant has been to ‘a not insignificant degree’. As mentioned above, the Complainant has run its business under the Name for over 40 years, generating sufficient business and consequent turnover to keep the business running for that considerable length of time.
- 6.10 In relation to consideration (b), the Expert considers that the Name serves to indicate to the purchasing public the goods or services of the Complainant, at least along the South Coast of England area (the ‘relevant geographic area’) in which each of the Parties trade.
- 6.11 The Expert considers that the Name itself is capable of being distinctive: the combination of the words ‘*Southern*’ and ‘*Fabrication*’ were unique to the Complainant in the relevant geographic area until the registration of the Domain Name by the Respondent.<sup>5</sup> The combination is not generic

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<sup>5</sup> The Respondent has asserted that there are other limited companies with similar names, but has produced no evidence in support of that assertion. The Expert does not know how similar the other names are, nor the nature and geographical area of the businesses in question.

and not a usual combination in the English language: the pluralisation of the Name does not distinguish the Domain Name from the Name.

6.12 The Expert also considers that, on the balance of probabilities, the Complainant has generated goodwill and reputation in the Name sufficient to give rise to unregistered trade mark rights in respect of the Name.<sup>6</sup> Relevant to this is the Complainant's general longevity of over 40 years in the provision of what are specialised goods/services, namely the provision of steelwork structures and related services, in the relevant geographic area.<sup>7</sup>

6.13 Given the reasoning above, as well as the fact that the requirement to demonstrate 'Rights' is not a particularly high threshold (Nominet appeal panel decision, *Seiko-shop* DRS 00248), the Expert considers that, at the time of the Complaint, the Complainant had Rights in a Name which is substantially identical (and certainly similar) to the Domain Name.

*ii) Abusive Registration*

6.14 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;"*

6.15 *In relation to i. above* – given the Complainant's goodwill and reputation in the Name in the relevant geographic area, as described for example at paragraphs 6.11 and 6.12 above, the Expert considers that it is highly unlikely that the Respondent was not aware of the Complainant and its Name at the time of its registration of the Domain Name in 2009. The Expert notes that nowhere in the Response does the Respondent suggest that it was unaware of the Complainant and its Name at that time.

6.16 Further, and given the obvious risk of resultant confusion (see below at paragraph 6.20 *et seq.*), the Expert considers that, on the balance of probabilities, the Respondent's intention at the time of registering the Domain Name was to gain a commercial advantage over the Complainant

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<sup>6</sup> Goodwill has been defined as: "the benefit and advantage of the good name, reputation and connection of a business. It is the attractive force which brings in custom." - *Inland Revenue Commissioners v Muller & Co Margarine Ltd* [1901] A.C. 217 at 223,224.

<sup>7</sup> The case of *Redwood Tree Services Ltd v Warren Apsey t/a Redwood Tree Surgeons* [2011] EWPC 14) supports the fact that small businesses with only local custom can generate Goodwill in a localised geographic area sufficient to successfully prevent third parties from passing off in that area.



– by seeking to rely on the Complainant’s goodwill and reputation in the Name in order to generate web traffic to the Website, looking to generate commercial orders on the back of that.

- 6.17 Thus, the Expert considers that the registration of the Domain Name took unfair advantage of, and was unfairly detrimental to, the Complainant’s Rights.
- 6.18 *In relation to ii. above* – the Expert considers that the Domain Name has been used in a manner which took unfair advantage of, and was unfairly detrimental to, the Complainant’s Rights.
- 6.19 Paragraph 3 of the Policy sets out a non-exhaustive list of factors which may be evidence that the Domain Name is an Abusive Registration. In this case, the Complainant refers in substance to the factor set out at Paragraph 3.a.ii. of the Policy, which states that:
- “[there may be evidence of an Abusive Registration if there are] Circumstances indicating 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;”*
- 6.20 Given the evidence before him, including general market confusion between the Complainant and the Respondent and the reference on the Website to the Respondent’s name as being “Southern Fabrications”,<sup>8</sup> the Expert considers that the Respondent’s use of the Website has confused and is likely to confuse those accessing the Website into believing that the Domain Name (and the goods/services offered for sale on the Website) is the Complainant’s or is at least authorised by the Complainant: which is not the case.
- 6.21 The Expert considers that the Respondent has taken unfair advantage of the Complainant’s Rights in the Name as the Respondent has generated potential custom from those accessing the Website under the false impression that the Website and the goods/services sold there were the Complainant’s.
- 6.22 Also, such use of the Domain Name has been unfairly detrimental to the Complainant as the use of the Website in the way described above has diverted potential Internet traffic away from the Complainant’s website, and thus the Complainant has lost possible sales income as a consequence.
- 6.23 The Expert has considered whether there is evidence before him to suggest that any of the factors listed at Paragraph 4 of the Policy demonstrate that the Domain Name is not an Abusive Registration but does not consider any are relevant.

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<sup>8</sup> Based on information on the homepage of the Website, as of the date of the Decision.

## **7. Decision**

- 7.1 The Expert finds that, on the balance of probabilities, the Complainant has Rights in the Name which is substantially identical (and certainly similar) to the Domain Name and the Domain Name in the hands of the Respondent is an Abusive Registration. Therefore, the Expert directs that the Domain Name be transferred to the Complainant.

Signed Dr Russell Richardson

Dated 23 April 2012