

DISPUTE RESOLUTION SERVICE

D00011562

Decision of Independent Expert

Walker Hamill Limited

and

Scope Enterprises Inc

1. The Parties:

Complainant: Walker Hamill Limited
105 Jermyn Street
St James's
London
SW1Y 6EE
United Kingdom

Respondent: Scope Enterprises Inc
Main Street, No 556
Charlestown
NA
Saint Kitts and Nevis

2. The Domain Name(s):

walkerhamill.co.uk

3. Procedural History:

02 July 2012 14:29 Dispute received
03 July 2012 13:23 Complaint validated
20 July 2012 14:08 Notification of complaint sent to parties
08 August 2012 02:30 Response reminder sent
13 August 2012 10:09 No Response Received

13 August 2012 10:11 Notification of no response sent to parties

16 August 2012 10:40 Expert decision payment received

4. Factual Background

The Complainant is a recruitment business established in 1989 which specialises in all levels of business and finance appointments and trades under its name Walker Hamill Limited. The Complainant registered a trade mark WALKER HAMILL on 24 January 2002 under number 2291060 in respect of services in Class 35 comprising recruitment services, human resource management and recruitment advertising. It holds a Certificate of Renewal of Trade Mark in respect of this trade mark dated 26 October 2011 showing that its registration has been renewed until 24 January 2022.

The Respondent made no Response in these proceedings and there is no evidence as to its activities other than the Domain Name registered to its name.

5. Parties' Contentions

The Complainant

The Complainant says that it was established in 1989 and provides a search and selection service for business and financial appointments at all levels of management. The Complainant says that it spends significant sums advertising vacancies for its clients on various websites as well as advertisements in the Financial Times. The Complainant says that it is amongst the top four advertisers by spend in the appointments section of the Financial Times for the past 15 years.

The Complainant says that it registered a trade mark WALKER HAMILL on 24 January 2002 under number 2291060. The Complainant believes that the use of the Domain Name infringes its trade mark and so should be transferred to the Complainant.

The Complainant points to the website to which the Domain Name resolves which advertises other recruiters and directs candidates to those websites. The Complainant says that this is infringement of its Trade Mark and causes it financial harm.

The Complainant considers that the registration of the Domain Name and the use to which it is being put unfairly disrupts its business. The Complainant says that the website to which the Domain Name resolves appears to be an aggregator site which sells advertising to direct competitors of the Complainant.

The Complainant says that the job vacancies advertised on the website to which the Domain Name resolves are of a type which the Complainant would advertise for its own clients but this website diverts traffic to websites of competitors of

the Complainant, thereby potentially causing a loss as a consequence of the Respondent's use of the Domain Name.

The Complainant also fears that use of its name also suggests that the website to which the Domain Name resolves is a site endorsed by the Complainant. This, according to the Complainant, would confuse candidates.

In conclusion, the Complainant would like an order transferring the Domain Name.

The Respondent

The Respondent made no Response.

6. Discussions and Findings

Rights

"Rights" are defined in the DRS Policy as being "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 has enclosed copies of its trade mark registration showing an initial registration for WALKER HAMILL for services in Class 35 dated 22 June 2002 and a renewal dated 26 October 2011 extending that registration to 24 January 2022. Both are in the Complainant's name. This name is identical with the Complainant's corporate name (with the exception of the suffix "limited").

The Complainant has also made brief mention in its application of its activities in the field of recruitment and has also referred (again, briefly) to its advertising. However, apart from the brief references I have referred to, it has provided no evidence at all to support these contentions. It may well be that it has acquired through use some sort of common law rights, but without at least some evidence to justify this, it is not possible to take these contentions further in this application.

However, the existence of the registered trade mark is sufficient to justify the existence of Rights as required by the DRS Policy.

By paragraph 2(a)(i) of the DRS Policy, the Complainant must show that it has "Rights in respect of a name or mark which is identical or similar to the Domain Name". In this case, by removing (as is customary in these decisions) the suffix ".co.uk" the Complainant's Rights as disclosed by its registered trade mark are identical to the Domain Name, the only distinction being the absence of a space between the two elements disclosed in the trade mark.

That slight distinction is insignificant, and I find that the Complainant has established Rights in a name or mark which is identical with or similar to the Domain Name as required by the DRS Policy.

Abusive Registration

The DRS Policy at paragraph 3(a) sets out a number of factors which may be evidence that the Domain Name is an Abusive Registration. Two of these factors appear to be relevant. The first is at paragraph 3(a)(i)(C), which states:

“Circumstances indicating that the Respondent has registered or otherwise acquired the Domain Name primarily ... for the purpose of unfairly disrupting the business of the Complainant”

The second is at paragraph 3(a)(ii), which states:

“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 Complainant includes as evidence a screen print of the website to which the Domain Name resolves. As the Complainant observes, this page contains in the right hand panel what appear to be advertisements for various positions in the finance sector. In the left hand panel, there are what appear to be search terms for such diverse elements as executive recruitment, banking, investments and baby walkers.

As at about midday on 27 August 2012, I took an image of the website to which the Domain Name resolves and include it as Annex A to this Decision. It can be seen that the website has changed somewhat, and focuses on vacancies. The basic format remains the same, however, with the panel on the left hand side purporting to show “top websites” and the panel at the right and bottom showing what are described as “accounting jobs”. As a test, I clicked on “Financial Analyst” and enclose at Annex B the result as at about midday on 27 August 2012. It will be seen that the click has taken me to a website called “searchmagnitude.com” and there is a further list, the first element appearing to advertise assistance in passing exams, the next two being “financial analyst jobs”, the next one being again for help in passing exams and the last being for the sale of law and business books. Each such heading has a link underneath which takes you to a different website.

At about the same time, by clicking on the first box for “financial analyst jobs” I was taken to the website shown at Annex C and by clicking on the box beneath it, I was taken to the website shown at Annex D.

The Complainant states that the website to which the Domain Name resolves appears to be an aggregator site. From the evidence submitted by it, and from the webpages I have annexed to this Decision, this appears to be correct. The function of the website to which the Domain Name resolves appears to aggregate a number of other websites, which are active in the area of business and accounting and to which it links. At least some of those links are to businesses

which appear to be advertising in their own right vacancies for positions in business or finance and therefore to be direct competitors to the Complainant.

It is my view that such an operation inevitably operates as a disruption of the Complainant's business. It is an operation which the Respondent on the evidence before me has no right to do. It is manifestly unfair as it tends to draw custom away from the Complainant and give it to businesses which appear to be its direct competitors. I therefore find the ground under paragraph 3(a)(i)(C) made out.

As to paragraph 3(a)(ii), there is no question that the Respondent is actually using, and not just threatening to use, the Domain Name in a way that is likely to confuse people or businesses into thinking that it is registered to or operated by the Complainant. The Domain Name, apart from the insignificant absence of a space and after excluding the suffix, is identical with the Complainant's trade mark. While the Complainant has not included any evidence of any actual confusion, I consider that there is a likelihood, perhaps a strong one given the close similarity of the Domain Name with the Complainant's Rights, that people or businesses will be confused as described in paragraph 3(a)(ii).

Paragraph 4

The DRS Policy provides at paragraph 4 a number of non-exhaustive factors which point to the Domain Name's not being an Abusive Registration. While the Respondent has not made any Response, it is necessary for me nonetheless to consider whether any of these factors applies. However, based on the evidence in front of me, the only such factor which could possibly apply is at paragraph 4(e), which states:

“Sale of traffic (i.e. connecting domain names to parking pages and earning click-per-view revenue) is not of itself objectionable under the Policy. However, the Expert will take into account:

- i. the nature of the Domain Name;
- ii. the nature of the advertising links on any parking page associated with the Domain Name; and
- iii. that the use of the Domain Name is ultimately the Respondent's responsibility.”

I do not see the webpage to which the Domain Name resolves as being some sort of parking page. The Domain Name is all but identical to the Complainant's Rights and is being used in a way which makes the visitor to the webpage to which it resolves believe that he or she is seeing a webpage providing job vacancies such as would be provided by the Complainant. While I could appreciate that the Respondent is earning click-per-view revenue from those links, the very nature of some of those links is to direct people to other businesses which are direct competitors to the Complainant in a way which cannot be justified.

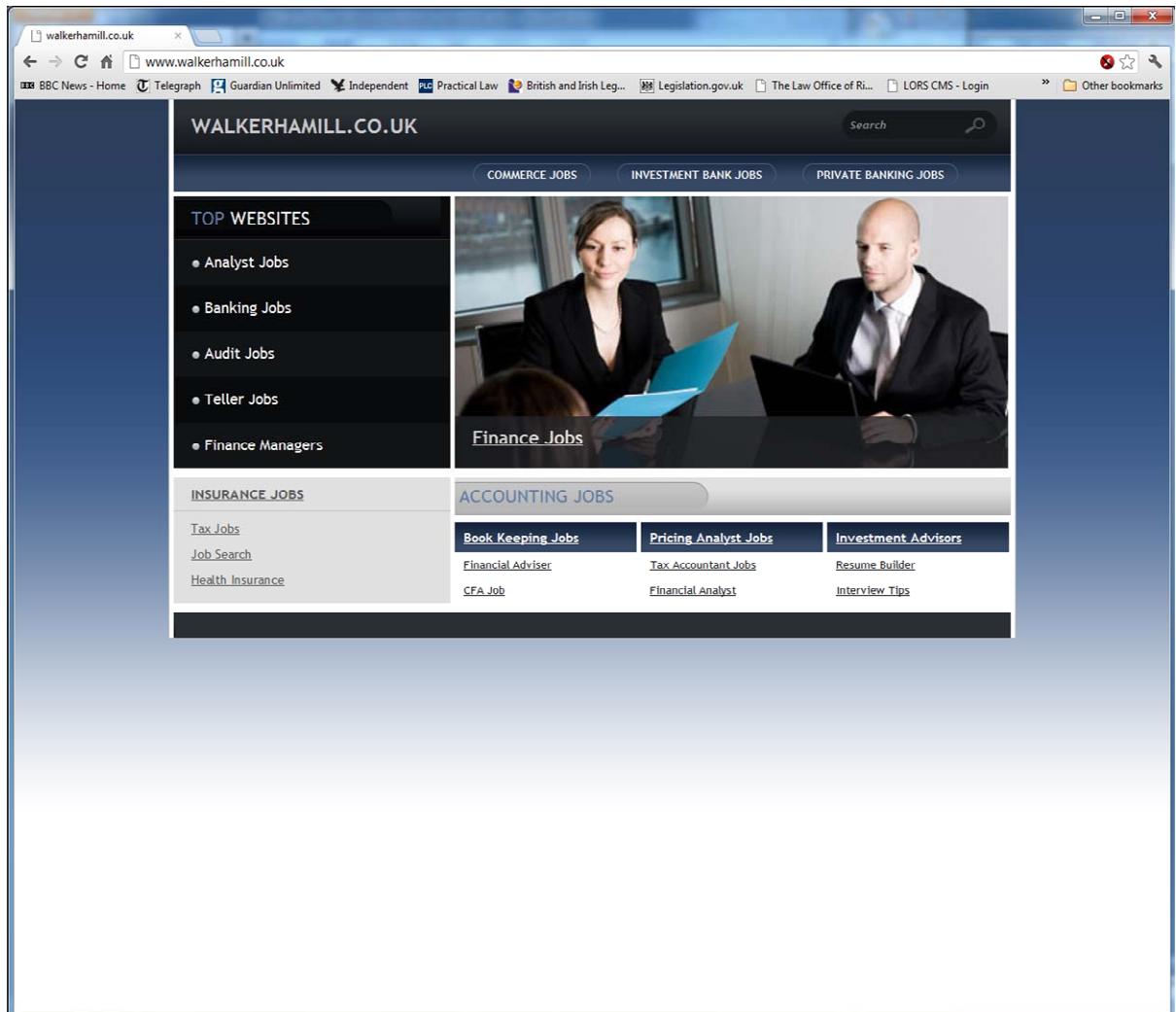
I cannot see that any other ground under paragraph 4 applies or that there are any other reasons applying in the Respondent's favour.

7. Decision

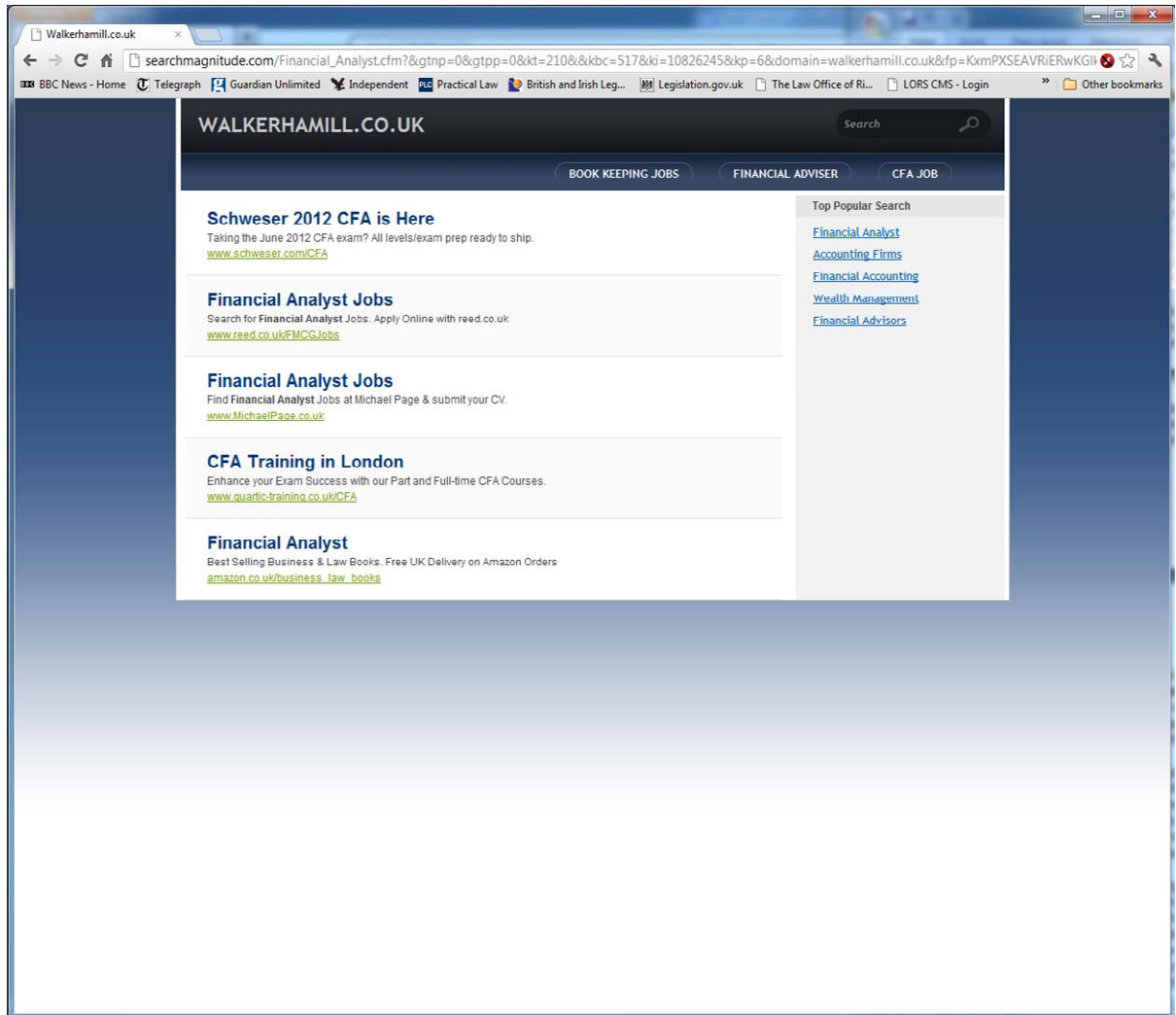
My decision is therefore to order that the Domain Name shall be transferred to the Complainant.

Signed Richard Stephens **Dated** 30 August 2012

Annex A



Annex B



Annex C

The screenshot shows the Reed.co.uk website interface. The browser address bar displays the URL: www.reed.co.uk/jobs/50k?keywords=financial%20analyst&parentsector=fmcg&WT.mc_id=SE-Bing-ReedB2C_50K&WT.srch=1&WT.srch=1&utm_source=bing&utm_. The page header includes the Reed.co.uk logo and navigation links for Jobs, Courses, and Career advice. A search bar is present with the text 'Find a job' and search criteria: 'keywords e.g. Web design' and 'near town or postcode'. Below the search bar, the results are filtered for 'financial analyst' jobs in the FMCG sector, with a salary range of £50k+. The search results list three job titles: 'Sales Finance Analyst', 'Financial Analyst', and 'Commerical Analyst'. Each job listing includes details such as the date posted, location, salary range, and the number of applications. The 'Sales Finance Analyst' job is posted on 17 August, located in London, South East England, with a salary of £50,000 - £55,000 per annum and 3 applications. The 'Financial Analyst' job is posted 3 days ago, located in Middlesex, South East England, with a salary of £225,000 - £275,000 per day and 1 application. The 'Commerical Analyst' job is posted on 17 August, located in London, South East England, with a salary of £50,000 - £55,000 per annum and 4 applications. The page also features a sidebar with search filters for FMCG, Salary, Work type, and Date posted.

Annex D

The screenshot shows a web browser window displaying the Michael Page International website. The browser's address bar shows the URL: www.michaelpage.co.uk/job-search-results.html?searchResultsSrc=SRC_ADV_JOB_SEARCH&freshSearch=true&jsc.orderBy=&pageIndex=1&javascriptEnabled=true. The website's navigation menu includes: Home, About Michael Page, Contact Us, Career Centre, Our Expertise, Employer Centre, and Submit Your CV. The main header features the Michael Page International logo and a navigation bar with the same items. Below the navigation, there is a promotional banner asking, "Do you check potential employees' Facebook profiles when recruiting your team?" with a "Join our group on LinkedIn" button and social media icons for Facebook, LinkedIn, and Twitter. The main content area is titled "Financial Services & Banking Jobs in London". It shows a search filter sidebar on the left with the following settings: Sector: Financial Services & Banking; Location: London; Salary: Lowest Salary; Job Type: All (with radio buttons for Perm, Temp, and Jobs added in last 7 days); and Keyword: Financial-Analyst. The search results section displays "No Matches Found" and a message: "Your Job Search returned no results. No matches were found for the particular search you made. However, to help you, our search engine has examined your parameters and found the jobs listed below. We hope they are of interest. Click on the links to see the job lists." Below this, two bullet points indicate: "659 jobs were found matching most of your search criteria but without the keyword specified." and "2 jobs were found matching most of your search criteria but not your choice of location." There is also a link to "Alternatively, try simplifying your criteria and search again in the 'Job Search' box on the left of this page." The sidebar on the left includes a "Start here" section with the same search filters, a "Submit your CV" button, a "Michael Page Scotland" button, and a "Featured Clients" section listing: Investment MANAGEMENT (Fundraiser, London, Permanent), fastmarketsLtd (Chief Financial Officer, London/Salisbury, Permanent), SAVcredit (Manager Forecasting, West Malling - Kent, Permanent), and Manufacturing COMPANY (Finance Director).