

DISPUTE RESOLUTION SERVICE

D00011686

Decision of Independent Expert

Abdul Rahman Reasat t/a Dewsbury Auto Dismantlers

and

Dewsbury Auto Salvage Ltd

1. The Parties

Complainant: Abdul Rahman Reasat t/a Dewsbury Auto Dismantlers
Mill Road, Firth's Yard
Dewsbury
West Yorkshire
WF13 2HP
United Kingdom

Respondent: Dewsbury Auto Salvage Ltd
379 Park Rd
Oldham
Lancs
OL4 1SF
United Kingdom

2. The Domain Name

<dewsburyautodismantlers.co.uk> ("the Domain Name")

3. Procedural History

04 August 2012 12:14	Dispute received
06 August 2012 12:48	Complaint validated
06 August 2012 12:56	Notification of complaint sent to parties
15 August 2012 09:47	Response received
15 August 2012 09:48	Notification of response sent to parties
20 August 2012 02:30	Reply reminder sent
22 August 2012 14:18	Reply received
23 August 2012 11:57	Notification of reply sent to parties
23 August 2012 12:03	Mediator appointed
29 August 2012 12:39	Mediation started
17 September 2012 14:05	Mediation failed

17 September 2012 14:05	Close of mediation documents sent
17 September 2012 15:46	Expert decision payment received
24 September 2012	Expert Appointed
25 September 2012	Respondent's non-standard submission received
02 October 2012	Complainant's non-standard submission received

After certifying that he was independent of the parties and knew of no reason why he could not accept the appointment, the undersigned Steven A. Maier was appointed to provide a Full Decision in the Complaint on 27 September 2012.

4. Factual Background

The Complainant is a vehicle dismantler and has traded in Dewsbury under the name "Dewsbury Auto Dismantlers" since November 2010.

The Respondent is also a vehicle dismantler and has traded in Dewsbury under the name "Dewsbury Auto Salvage" since 1988.

The Respondent registered the Domain Name on 15 November 2010.

The Complainant is the owner of UK registered trade mark number 2583018, comprising a device and the wording DEWSBURY AUTO DISMANTLERS, which was registered on 31 May 2011.

At the date of the Complaint, the Domain Name resolved to the Respondent's website at www.dewsburyautosalvage.com.

5. Parties' Contentions

The Complaint

The Complainant makes the following submissions in the Complaint:

- (1) That he commenced in business under the name "Dewsbury Auto Dismantlers" on or around 6 November 2010. In support of this, he provides evidence of an eBay account under the ID "dewsburyautodismantlers" which was opened on that date. Examination of the account online shows trading feedback dating from 10 November 2010.
- (2) That on 13 November 2010 he erected a large sign bearing the name "Dewsbury Auto Dismantlers" outside his business premises. He produces an invoice from a company named Vector Signs dated 13 November 2010, which states: "Applied vinyl graphics on the sign board to read "DEWSBURY AUTO DISMANTLERS TEL 01924 485152".
- (3) That the Respondent is a rival business which, like the Complainant, dismantles damaged vehicles and sells spare parts both in-house and online.
- (4) That the Respondent registered the Domain Name two days after the Complainant erected his sign and, owing to the close physical proximity of the two businesses, undoubtedly did so after having seen the sign.

- (5) That the Domain Name resolves to the Respondent's website and that the Respondent registered the Domain Name with the deliberate intention of impersonating the Complainant and confusing potential customers.
- (6) That the Respondent has, in the past, told potential customers that the Complainant's business does not exist, that it is in another part of town or that it is untrustworthy.
- (7) That the Respondent is only experienced in dismantling Japanese cars and provides a poor service in connection with European cars, which reflects badly on the Complainant's reputation in the light of the confusion between the two businesses.
- (8) That the Respondent agreed to transfer the Domain Name to him if he in turn agreed to remove an arrow from his business sign (the significance of the arrow is not explained). The Respondent also agreed to pay the cost of the removal of the arrow. Although the Complainant removed the arrow and the Respondent duly paid the cost, the Respondent then refused to transfer the Domain Name. The Complainant produces invoices addressed to the Respondent, which include reference to the transfer of the Domain Name, and a copy of the Respondent's cheque by way of payment.

The Complainant seeks a transfer of the Domain Name.

The Response

The Respondent makes the following submissions by way of response:

- (1) That, on setting up his new business, the Complainant deliberately chose a business name similar to that of the Respondent with the intention of diverting away business that the Respondent had spent many years building up.
- (2) That, on the Complainant's own admission, both he and the Respondent are vehicle dismantlers. The Respondent is known by many businesses in Dewsbury as "Dewsbury auto dismantlers" or "Dewsbury car breakers" as well as "Dewsbury Auto Salvage". In the circumstances, the Respondent had every right to register the Domain Name.
- (3) That, in addition to the Domain Name, the Respondent is also the owner of the domain names <dewsburyautosalvage.com>, <dewsburyautosalvage.co.uk> and <dewsburyautobreakers.co.uk> all of which are used legitimately in connection with its business. The Domain Name and the name <dewsburyautobreakers.co.uk> were registered on the advice of the Respondent's web developers when the Respondent updated its website.
- (4) That the Domain Name was registered before the Complainant registered any company name or trade mark.
- (5) That the Respondent was unaware of the Complainant's eBay business. Further, it disputes that the Complainant's sign was erected on 13 November 2010. The Respondent produces a photograph of a "Dewsbury Auto Dismantlers" sign, which includes reference to the Complainant's website at www.dewsburyauto.co.uk. The Respondent points out that the domain name <dewsburyauto.co.uk> was only registered on 2 Feb 2011

and queries how it can in the circumstances have appeared on a sign that was erected on 13 November 2010.

- (6) That the Complainant uses the domain name <dewsburyauto.co.uk> for the purposes of his business and that the Complainant registered another domain name, <dewsburyautodismantlers.com>, only after the Respondent had registered the Domain Name.
- (7) That there are at least 10 other domain names similar to the Domain Name (details are not provided). The Respondent questions whether the Complainant will also try to claim those names.
- (8) That it agreed to pay the Complainant the costs of taking down a sign the Complainant had erected some 30-40 yards from the Respondent's premises. However, there was no agreement to transfer the Domain Name to the Complainant and the Complainant's invoices to this effect are false.
- (9) That the Respondent is not attempting to cause confusion with the Complainant's business and, on the contrary, it is seeking to distance itself from the Complainant.
- (10) That, contrary to the Complainant's submissions, the Respondent offers a first class service.

The Reply

The Complainant's Reply is drafted by a solicitor. It commences as follows:

"The Applicant makes this application as a precursor to making a civil claim in the High Court in England for compensation against the Present Domain Registrant (Dewsbury Auto Salvage Ltd) for damages and an injunction against Dewsbury Auto Salvage and/or Nominet to compel transfer of the domain dewsburyautodismantlers.co.uk [sic] should Nominet not facilitate the transfer of the aforesaid domain. The Applicant therefore makes this here Application without prejudice to his legal remedies under English law. The Applicant shall further canvass the Secretary of State for Business, Innovation and Skills with a view to ordering the compulsory winding up the Registrant company, criminal prosecution and the disqualification of its directors. The basis of the Applicant's civil claim against the Registrant shall be for breach of contract, unlawful interference with trade, passing off and fraudulent misrepresentation. The Applicant shall therefore await the deliberations of Nominet before issuing court proceedings (subject to compliance with Limitation Act 1980) and procedure Procedure 20(a) should not be applied."

None of this information is relevant to the Complaint. Paragraph 20(a) of the Nominet Dispute Resolution Service Procedure ("the Procedure") provides for DRS proceedings to be suspended if legal proceedings relating to the Domain Name are issued in a Court of competent jurisdiction before or during the course of DRS proceedings. There is no evidence that any such proceedings have been issued.

The Reply is otherwise largely repetitive of the Complaint, although it is now stated that the Complainant commenced in business on 30 October 2010. Insofar as the Reply addresses any matters arising out of the Response, the Complainant makes the following further submissions:

- (1) That the original plastic signs advertising his business were damaged, as a result of which he erected a more robust metal sign including an arrow. (The sign in the photograph submitted by the Respondent includes an arrow.) He suspects the Respondent of damaging the original signs.
- (2) That he has an audio recording of a representative of the Respondent agreeing to transfer the Domain Name to him. The Complainant produces an audio recording, which appears to comprise part of a telephone conversation between the Complainant and a representative of the Respondent concerning the removal of the arrow from the Complainant's sign, the payment made by the Respondent and the transfer of the Domain Name. Although the recording is incomplete, the call appears to have been initiated by the Complainant in order to complain about the Respondent's delay in transferring the Domain Name. The Respondent's representative, who appears to be the son of the proprietor of the business and to have detailed knowledge of the matters in dispute, appears to confirm that the Respondent agreed to transfer the Domain Name to the Complainant and still intends to do so. Specifically, he states that he has previously told the Complainant's brother: *"We'll give you the domain name, the domain name is yours."* It is implied that the delay in transferring the name is a result of the Complainant's delay in removing the arrow from his sign and that the matter cannot now be advanced until the return of the individual's father in two weeks' time. He states: *"My dad has said to me the minute he gets here the domain name is going to be yours."*
- (3) That the Complainant has evidence of actual confusion, in that a named customer purchased an engine from the Complainant, but then mistakenly communicated with the Respondent about it and was delayed in obtaining a resolution. (It is not made clear, however, whether this confusion is alleged to result from the Respondent's use of the Domain Name.)

Respondent's Paragraph 13(b) Submission

The Respondent submitted a non-standard submission to Nominet in response to the Reply. The Respondent contended for the purposes of paragraph 13(b) of the Procedure that there was an exceptional need for a further submission in view of the unusual nature of the Reply and the fact that it raised new matters and evidence upon which the Respondent had not had an opportunity to comment. I considered that, in view of the nature and content of the Reply, it was proper to allow the Respondent a further opportunity to respond and I therefore accepted the Respondent's non-standard submission.

In that submission the Respondent states:

- (1) That in view of the factual complexity of the matter and the Complainant's threat of Court proceedings, this matter should be decided by a Court and not by Nominet. The reference in the Reply to a contractual obligation to transfer the Domain Name underlines that this is primarily a contractual dispute and is properly a matter for the Court.
- (2) That the Domain name is descriptive and that the Complainant has failed to prove that he has Rights in the name for the purpose of the Nominet Dispute Resolution Service Policy ("the Policy").
- (3) That while the Complainant relies on a registered trade mark comprising a logo and wording, another application by the Complainant for the word

only trade mark DEWSBURY AUTO DISMANTLERS (reference number 2583137) was refused. The Respondent speculates that the reason for the refusal was the descriptive nature of the mark.

- (4) That the Complainant has abandoned its argument about having erected a sign in November 2010. The Complainant's 'arrow' sign was not erected until October 2011. The Respondent produces a letter from a business named Boiler Parts Centre, located at 128 Bradford Road, Dewsbury, stating that the Complainant's sign is located at 136 Bradford Road and did not appear until October 2011, with the arrow being added in February 2012. Therefore, the invoice produced by the Complainant either relates to another sign or is a fabrication. These factual matters should be explored before a Court.
- (5) That, following a number of discussions and meetings between the parties in February 2012, it was agreed on 27 February that the Respondent would pay the Complainant's costs of £240 of removing the arrow from the Complainant's sign. There was no agreement concerning the Domain Name. Since the first of the Complainant's invoices for the £240 purporting to refer to the transfer is dated 15 February 2012, i.e. before 27 February, this demonstrates that the invoices are forgeries. The Respondent also produces a letter from its accountants stating that it has not received the Complainant's invoice and that no relevant VAT has been reclaimed.
- (6) That the Respondent registered the Domain Name and also <dewsburyautobreakers.co.uk> on the advice of its web developer. The latter name was registered on 10 November 2010. The Respondent produces a letter dated 28 October 2010 from a marketing company, which states:

"Dear Waheed

We are about to finish up the frontend of your new website. We are mindful of the fact that there is a lot of SEO to be preserved.

As discussed during our telephone conversation, I don't think this domain would be enough to optimize the whole of SEO traffic.

We, therefore, would need to buy other relevant domains such as Dewsbury auto breakers and Dewsbury auto dismantlers.

Initially, we can redirect these domains to our main domain and in time turn these domains to fully fledged websites.

We should move to buy these domains asap and we can act on your behalf, if needed.

Please let us have your views on the above.

Sincerely,"

- (7) That it did not damage the Complainant's signs and would never do any such thing.

- (8) That the Complainant has provided no evidence of confusion and no proof concerning the specific individual referred to in the Reply who was said to have mistakenly communicated with the Respondent.
- (9) That, with regard to the audio recording:
 - (a) the conversation was with a member of the Respondent's staff who was not fully familiar with the relevant facts;
 - (b) the recording is incomplete and appears to have been edited;
 - (c) the purpose of the conversation was clearly to try to trap the Respondent; and
 - (d) the conversation was recorded without the knowledge or consent of the Respondent and was therefore unlawful (no authority for this proposition is provided).

Complainant's Paragraph 13(b) Submission

The Complainant submitted a non-standard submission of its own in response to the Respondent's non-standard submission. I did not consider it necessary to review the Complainant's further submission.

6. Discussions and Findings

This matter falls to be determined under the Policy and the Procedure. Under paragraph 2 of the Policy:

- "(a) A Respondent must submit to proceedings under the Dispute Resolution Service if a Complainant asserts to [Nominet], according to the Procedure, that:
 - (i) the Complainant has Rights in respect of a name or mark which is identical or similar to the Domain Name; and
 - (ii) the Domain Name, in the hands of the Respondent, is an Abusive Registration.*
- (b) The Complainant is required to prove to the Expert that both elements are present on the balance of probabilities."*

Under paragraph 1 of the Policy the term "Rights":

"... means 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 under paragraph 1 of the Policy, the term "Abusive Registration" means 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."*

Paragraph 3 of the Policy sets out a non-exhaustive list of factors that may be evidence that a domain name is an Abusive Registration. Paragraph 4 sets out a non-exhaustive list of factors that may be evidence that it is not. However, all these factors are merely indicative and remain subject to the overriding test of an Abusive Registration as set out above.

Jurisdiction

As a preliminary matter, the Respondent contends that because this matter is factually complex and is primarily a claim for breach of contract it should properly be determined by a Court and not by Nominet.

The approach of Nominet to claims based on an alleged breach of contract was considered by the DRS Appeal Panel in *David Munro –v- Celtic.com, Inc* [2007] DRS 04632, <ireland.co.uk>. It was held in that case that, while contractual rights may fall within the definition of Rights under paragraph 1 of the Policy, Nominet should generally decline to determine a dispute based exclusively on an allegation of breach of contract. This is primarily because a case of this nature may require the determination of potentially complex legal issues outside of the Policy, for example whether a binding contract has been formed (this was of particular relevance in the <ireland.co.uk> case which involved multi-jurisdictional issues).

The present case is not, however, based exclusively on an alleged breach of contract. While this is certainly one of the grounds relied on by the Complainant, he also relies on factual allegations which, if established, would fall within the circumstances indicating an Abusive Registration under paragraph 3 of the Policy. Furthermore, while the Complainant indicates that he intends to pursue civil proceedings (among other steps) if the Complaint is unsuccessful, there is no indication that he intends to withdraw the Complaint.

I am satisfied, therefore, that the proper course is for me to proceed to determine the Complaint under the Policy.

Rights

I find on the evidence that the Complainant commenced operations under the name "Dewsbury Auto Dismantlers" by no later than 6 November 2010 and was transacting business under that name by no later than 10 November 2010. While the name "Dewsbury Auto Dismantlers" is descriptive, it is not wholly descriptive in the sense that it is incapable of having acquired a secondary meaning distinctive of the Complainant. In my view, the Complainant's business activities give rise to a sufficient degree of secondary meaning to establish Rights for the purposes of paragraph 1 of the Policy.

The Complainant is also the owner of a registered trade mark which includes the wording DEWSBURY AUTO DISMANTLERS. The Respondent is correct to note that this is a device and word mark, in which the logo element can be assumed to play a significant part. However, the wording as well as the logo forms part of the trade mark, which on any infringement claim would be considered as a whole.

While the trade mark was registered some time after the Respondent registered the Domain Name, this is not relevant to the threshold test of whether at the date of the Complaint the Complainant has Rights in a relevant name for the purposes

of the Policy: the establishment of Rights does no more than qualify the Complainant to move to the next stage of the process, i.e. consideration of whether there is an Abusive Registration.

In the circumstances, I find that the Complainant has Rights in the name and mark "Dewsbury Auto Dismantlers" which is identical or similar to the Domain Name (ignoring the formal suffix). The first limb of the test under paragraph 2 of the Policy is therefore satisfied.

Abusive Registration

Leaving to one side the question of any contractual right (to which I will return below), in my view this case ultimately comes down to one fundamental question: did the Respondent register the Domain Name on 15 November 2010 (a) in response to the Complainant setting up in business under the name "Dewsbury Auto Dismantlers", or (b) without knowledge of the Complainant and as a result of the advice of its web developers to capture additional domain names?

Reviewing the evidence that has been submitted, I accept the Complainant's evidence that he established an eBay account as "dewsburyautodismantlers" on 6 November 2010. It is also clear that he transacted business on that account from no later than 10 November 2010. I also accept the Vector Signs invoice as evidence that the Complainant erected a sign in Dewsbury on 13 November 2010 which included the name "Dewsbury Auto Dismantlers". While the Respondent alleges that the Complainant has abandoned that argument, I do not believe this to be the case: in fact, in the Reply, the Complainant appears to explain why the sign exhibited to by the Respondent refers to the website www.dewsburyauto.co.uk when the domain name <dewsburyauto.co.uk> was only registered on 2 February 2011. The Complainant states that this was a different sign, erected after his original sign was damaged. It also appears from the evidence of the Boiler Parts Centre business that more than one sign is involved.

So far as the Respondent's evidence is concerned, the letter from the marketing company dated 28 October 2010 is, on its face, persuasive evidence that the Respondent was motivated to register the Domain Name by the advice of its web designer rather than by any knowledge of the Complainant. However, a number of questions arise in connection with that letter. First, it appears odd that a web developer would write a formal letter to a customer for the sole purpose of confirming advice of the kind contained in the letter that had just been discussed in a telephone call: if anything was necessary, an email would be the more natural follow-up. Secondly, given the potential importance of the letter, it is curious that the Respondent did not produce it at the time of its Response, as opposed to its subsequent non-standard submission (which might or might not have been accepted). Thirdly, if the two domain names <dewsburyautobreakers.co.uk> and the Domain Name were both registered as a result of the letter, it is not clear why they were registered on different dates, i.e. 10 November and 15 November 2010 respectively. Finally, if the purpose of the exercise was to capture further relevant domain names, it is not clear why the Respondent did not also register the .com versions of these names, i.e. <dewsburyautobreakers.com> and <dewsburyautodismantlers.com>, particularly as its own primary URL is www.dewsburyautosalvage.com.

Turning briefly to the contractual side of the Complaint, for the reasons set out above, I make no finding as to whether the Respondent is in breach of any contractual obligation to the Complainant. I am, however, entitled to take

account of the parties' evidence concerning this issue, which constitutes part of the overall factual matrix, in forming a view as to the credibility of their respective positions overall. In this regard, I consider the evidence of the audio recording to be compelling evidence in the Complainant's favour. While the Respondent has made a number of objections to the recording, it does not dispute the essence of what was said and I do not consider that any of the objections undermines the central thrust of the conversation.

Returning to the fundamental issue referred to above, the conclusion I have reached on the balance of probabilities is that the Respondent registered the Domain Name in response to the Complainant setting up business under the name "Dewsbury Auto Dismantlers". The Respondent had traded under another name for 22 years prior to the Complainant's emergence, and to have registered a domain name which exactly reflected the Complainant's name within days of the Complainant commencing in business is simply too great a coincidence.

I conclude, therefore, that the Respondent registered the Domain Name primarily as a blocking registration against a name or mark in which the Complainant has Rights (paragraph 3.A.i.b. of the Policy) or for the purpose of unfairly disrupting the business of the Complainant (paragraph 3.A.i.c. of the Policy).

I also have regard to paragraph 3.A.ii of the Policy, which refers to 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. The Domain Name is virtually identical to the Complainant's business name and to the textual part of its registered trade mark and in these circumstances I consider that a degree of confusion among customers and potential customers is highly likely. However, given that the mark is descriptive in nature, it is also necessary to consider whether the Respondent's use of the Domain Name is unfair. In the circumstances described above, I find that the Respondent's use of the name does take unfair advantage of, or is unfairly detrimental to, the Complainant's Rights.

In the light of the above, I conclude that the Domain Name in the hands of the Respondent is an Abusive Registration for the purposes of paragraph 2 of the Policy.

7. Decision

Having found that the Complainant has Rights in a name or mark that is identical or similar to the Domain Name, and that the Domain Name in the hands of the Respondent is an Abusive Registration, the Complaint succeeds and I direct that the Domain Name <dewsburyautodismantlers.co.uk> be transferred to the Complainant.

Signed: STEVEN A. MAIER

Dated: 4 October 2012