

DISPUTE RESOLUTION SERVICE

D00012778

Decision of Independent Expert

Herts Fire and Security Ltd

and

Mr Gavin Rees

1. The Parties:

Complainant: Herts Fire & Security Ltd
14 Martinfield Business Centre
Welwyn Garden City
Herts
AL7 1HG
United Kingdom

Respondent: Mr Gavin Rees
5 Martinfield Business Centre
Welwyn Garden City
Herts
AL7 1HG
United Kingdom

2. The Domain Name(s):

hertsfireandsecurity.co.uk ("the Domain Name").

3. Procedural History:

The Complaint was submitted to Nominet on 29 April 2013. On 30 April 2013, Nominet validated the Complaint and notified it to the Respondent on 1 May

2013. The Respondent was informed in the notification that it had 15 working days, that is, until 23 May 2013 to file a response to the Complaint.

On 22 May 2013 the Respondent filed a Response. On 29 May 2013, the Complainant filed a Reply to the Response. The case proceeded to the mediation stage. On 25 June 2013, Nominet notified the Parties that mediation had been unsuccessful and invited the Complainant to pay the fee for referral of the matter for an expert decision pursuant to paragraph 8 of Nominet's Dispute Resolution Service Procedure Version 3 ("the Procedure") and paragraph 7 of the corresponding Dispute Resolution Service Policy Version 3 ("the Policy"). On 26 June 2013, the Complainant paid the fee for an expert decision. On 28 June 2013, Andrew D S Lothian, the undersigned, ("the Expert") confirmed to Nominet that he was not aware of any reason why he could not act as an independent expert in this case. Nominet duly appointed the Expert with effect from 3 July 2013.

4. Factual Background

The Complainant is Herts Fire & Security Limited, a company incorporated in England under company number 7114374 with its registered office in Welwyn Garden City, Hertfordshire. The Complainant was incorporated on 31 December 2009 and upon incorporation was named Herts CCTV Limited. The Complainant changed its name to Herts Fire & Security Limited on 4 May 2012. The Complainant says that it moved to its present address, taking warehousing and office space, on 1 February 2013.

The Respondent is the managing director of T & J Fire & Security Limited ("T & J"), a company incorporated in England under company number 7192707. T & J has offices on the same industrial estate to which the Complainant recently moved. The Respondent registered the Domain Name on 11 February 2013. At an unknown date prior to 13 February 2013, the Respondent instructed Cook & Partners Limited, Chartered Accountants, to incorporate a company named Hertfordshire Fire & Security Limited. Cook & Partners Limited wrote to the Respondent on 13 February 2013 referring to the recent set up of Hertfordshire Fire & Security Limited and enclosing a form for signature by the Respondent authorising HM Revenue & Customs to liaise with Cook & Partners Limited in respect of the tax affairs of the said new company.

According to a printout produced by the Respondent, on 2 April 2013, a forum user by the name of "HertsCCTV" posted an entry on a website named www.thesecurityinstaller.co.uk. So far as material to the present dispute, the entry stated in part: "...On another note the local fire company in the same estate as us has seen our vans as we moved into premises in feb and on the 11 feb took hertsfireandsecurity.co.uk the **** schoolboy error but the

domain was not available at the time and I did not keep an eye on it. not affecting business anyway!!!! hehehehehe..."

5. Parties' Contentions

Complainant

The Complainant contends that it has traded as Herts Fire & Security Limited for over four years and submits that it has "hundreds/thousands of satisfied customers". The Complainant produces an extract of its registration details from the UK Companies House website together with a bank statement in its company name for the period from 13 March to 14 April 2013, a directory listing from the website www.yell.com showing an entry for the Complainant and a colour advertisement featuring the Complainant's company name and contact details.

The Complainant notes that it had previously attempted to register the Domain Name; however each time this was attempted the Domain Name had been unavailable for registration. The Complainant states that on 11 February 2013 it was informed by an employee of T & J that the Respondent had registered the Domain Name and was using it to divert traffic to the website of T & J. The Complainant adds that the said employee did not agree with the Respondent's ethics. The Complainant notes that it sees the Respondent's registration of the Domain Name as sharp practice in an industry which should have high moral standards and integrity.

The Complainant asserts that T & J registered the Domain Name as soon as they became aware of the Complainant's presence in the business estate where T & J is located. The Complainant submits that the diversion of traffic from the Domain Name to T & J's website at www.tandjfire.co.uk constitutes an Abusive Registration.

The Complainant states that it made trial calls to T & J seeking the Complainant's personnel, however was told by T & J's sales staff that the Complainant had been taken over by T & J. The Complainant submits that this is a blatant lie and sharp practice.

The Complainant submits that the Domain Name should be considered at best to be a blocking registration and probably was registered with a view to deceiving the public into trading with the Respondent's company rather than the Complainant.

Respondent

The Respondent states that T & J was founded in 1973 and this year celebrates forty years trading in Hertfordshire. The Respondent notes that

over this time T & J has evolved, re-branded and diversified into other industry sectors, however its company name is no longer reflective of its position within the industry. The Respondent notes that in 2010 T & J registered the company name T. and J. Fire and Security as the security side of the business had grown.

The Respondent submits that it was natural that T & J would pursue the possibility of a name change, as it is based in Hertfordshire and is one of the largest fire and security companies in the area, with a rich history and thousands of satisfied customers. The Respondent states that the name Hertfordshire Fire and Security has a natural affinity and accordingly it registered this at Companies House. The Respondent adds that the purchase of the Domain Name was a natural extension of the company name, submitting that Herts is a common abbreviation of Hertfordshire and an obvious choice for T & J to keep the website address as short as possible while maintaining the name. The Respondent asserts that T & J has a right to a website name that is an abbreviation of its company name. The Respondent notes that the Complainant's current domain name is hertsfiresecurity.co.uk and that this is missing the 'and' out of choice, while the Respondent has chosen to leave it in within the Domain Name.

The Respondent submits that it is factually incorrect that an employee of T & J alerted the Complainant to the purchase of the Domain Name and that the said employee did not agree ethically with the registration. The Respondent states that he informed Richard Thatcher, an employee of the Complainant, that T & J had bought the name during a meeting in T & J's offices. The Respondent submits that Mr Thatcher did not express any concern regarding this and that he stated that the two companies could work together. The Respondent contends that the fact that the website was openly discussed at a meeting demonstrates that T & J were not planning on using it abusively. The Respondent adds that, accordingly, his ethics should not be questioned. The Respondent notes that at the said meeting Mr Thatcher supplied his business card. The Respondent produces a copy and notes that this displays the Complainant's old website address, www.hertsccctv.com.

The Respondent states that T & J has seven companies registered and many more domain names. The Respondent submits that as www.tjfire.co.uk is T & J's main company page it makes perfect sense for all currently non active sites to revert there. The Respondent adds that as the company name has been registered at Companies House and the address is parked until the company becomes active he fails to see how this constitutes an Abusive Registration.

With regard to the Complainant's claims concerning trial calls, the Respondent comments that this is a fabrication which has been invented purely to give the impression of an Abusive Registration. The Respondent submits that the only people in T & J who were aware of the Domain Name's registration were

the four company directors, none of whom answer the switchboard telephone number.

The Respondent contends that T & J has not tried to deceive the public and states that the fact that the Domain Name is directed to T & J's main company page, which is clearly branded as T. and J. Fire, is proof of that. The Respondent refers to the post on the security installers' website referred to in the Factual Background section above and states that this was made by the Complainant. The Respondent says that the posting shows the Complainant stating that this "has not affected business anyway" less than a month before the present Complaint. The Respondent submits that this demonstrates that the Domain Name is not an Abusive Registration.

Complainant's reply to response

The Complainant repeats that the registration of the Domain Name was an attempt to hijack the Complainant's legitimate business. The Complainant submits that the fact that T & J might have a forty year history is irrelevant.

The Complainant adds that it is objecting to T & J's recent company name registration via the Company Names Tribunal as the Complainant considers this registration to be malicious and opportunistic.

The Complainant notes that it has CCTV proof of its being alerted to the registration of the Domain Name by a member to T & J's staff and adds that Mr Thatcher's meeting with the Respondent took place afterwards and was conducted in full knowledge of the facts.

The Complainant notes that it will pursue this matter through the courts, trade associations and regulators.

6. Discussions and Findings

General

In terms of paragraph 2(b) of the Policy the onus is on the Complainant to prove to the Expert on the balance of probabilities each of the two elements set out in paragraph 2(a) of the Policy, namely 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.

Complainant's Rights

Paragraph 1 of the Policy provides that 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".

The requirement to demonstrate Rights under the Policy is not a particularly high threshold test. Rights may be established in a name or mark by way of a trade mark registered in an appropriate territory, or by a demonstration of unregistered so-called 'common law rights'.

The Complainant does not have a registered trade mark in the name in which it claims rights. In seeking to establish rights in its trading name, the Complainant is effectively claiming an unregistered trade mark in the name "Herts Fire & Security". The Expert considers that this name is a composite consisting of the geographic location "Herts" - a common abbreviation for Hertfordshire, and "Fire & Security" - a phrase descriptive of the type of services provided by the Complainant. As noted above, the Policy does allow complainants to establish rights in a descriptive term provided that the term has acquired a secondary meaning.

Paragraph 2.2 of the Expert's Overview document provides a guide as to what a complainant is required to prove in these circumstances:-

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).

Unfortunately, in the present case, the sum total of the Complainant's averments and evidence of the extent of its rights is its statement that it has "hundreds/thousands of satisfied customers", has been trading as Herts Fire & Security Limited for over four years, has a bank account in its company name and is listed as such both on the directory site www.yell.com and in a colour advertisement.

The evidence before the Expert as to the length of time that the Complainant has used the name or mark in question is somewhat contradictory. The Complainant states that it has been trading as Herts Fire & Security Limited for over four years. The extract which the Complainant provides from Companies House shows that this is not the case. The Complainant has been

incorporated for just over three and a half years. Furthermore the extract shows that until 4 May 2012 the Complainant was named Herts CCTV Limited.

The question of how long the Complainant has used the name or mark is not assisted by the www.yell.com listing, the colour advertisement or Mr Thatcher's business card, none of which bear any dates with the exception of the www.yell.com listing which shows that the website was visited on 30 April 2013. The business card, which was obtained by the Respondent, does show the Complainant's company name as Herts Fire & Security Limited, however it lists the Complainant's website and email address as being at the domain name hertscctv.com, which is a variant of the Complainant's former company name.

It is conceivable that the Complainant has used the trading name Herts Fire & Security throughout the period of its existence, notwithstanding the date of change of name of the limited company, and possibly even that this name was also used as the trading name of an entity that preceded the Complainant's incorporation as a company. However, there is no evidence to this effect before the Expert and accordingly the Expert is left with the notion that the Complainant has only been known by the name Herts Fire & Security since May 2012.

Turning to the question of the substance of the Complainant's business, the bank statement provided by the Complainant is an "advance notification of charges". It does not allow the Expert, for example, to determine the Complainant's turnover. The Expert is not provided with details of where and how often the colour advertisement has been published or over what period the Complainant has been listed at www.yell.com. The Complainant's assertion that it has "hundreds/thousands of satisfied customers" is not supported by any evidence.

In conclusion, the materials provided by the Complainant do not demonstrate to the Expert's satisfaction that it has used the name or mark in question for a not insignificant period and to a not insignificant degree or that the name or mark in question is recognised by the purchasing trade/public as indicating the goods or services of the Complainant.

In terms of paragraph 16(a) of the Procedure, the Expert must decide the Complaint on the basis of the Parties' submissions, the Policy and Procedure, however may also look at any websites referred to in the Parties' submissions. The Complainant had asserted that the web site at www.hertsfiresecurity.co.uk was also supportive of its case and the Expert therefore decided to review this site, which is the Complainant's corporate website, to determine whether there is any material published there which might support the Complainant's assertion of rights in the name Herts Fire & Security.

Unfortunately, the limited material which the Expert has been able to identify on the Complainant's website as relevant to this issue further confuses the picture. The "About" page states that the Complainant "was founded in 2005 and started life as Herts CCTV Limited but soon changed business name in 2011". Clearly both of these dates are contradicted by the Companies House extract. The only other relevant statements are found on the "Why Choose Us" page. This states that the Complainant services "the whole of Herts, Beds, Bucks, and London" and adds "We have a vast array of customers from local schools, retail shops large and small, warehouses, office buildings, and government buildings." Beyond that statement, there is no evidence provided as to the nature or extent of the Complainant's customer base and thus the extent of its trading goodwill.

While, as noted above, the test for Rights in a name is a relatively low threshold, in the present case the Expert does not consider that the Complainant has put forward a sufficient case to pass that threshold, particularly given that the name in which the Complainant claims rights is generic/descriptive and there is inadequate evidence of the establishment of any secondary meaning. Indeed, the limited evidence which has been produced and the often unsupported averments appear in more than one instance to be mutually contradictory.

In all of these circumstances, therefore, the Expert finds that the Complainant has failed to prove on the balance of probabilities that it has Rights in the name Herts Fire & Security within the meaning of the Policy.

Abusive Registration

In the present case, the failure of the Complainant to prove Rights in the name or mark in question means that the Complaint must fail. However, for completeness the Expert will also consider the question of 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;*

This general definition is supplemented by paragraph 3 of the Policy which provides a non-exhaustive list of factors which may be evidence that the Domain Name is an Abusive Registration. Paragraph 4 of the Policy provides

a similar non-exhaustive list of factors which may be evidence that the Domain Name is not an Abusive Registration.

The essence of the Complainant's case is that the Domain Name has been registered as a blocking registration by the Respondent (effectively a submission in terms of paragraph 3(a)(i)(B) of the Policy) and/or that the Respondent is using the Domain Name with a view to deceiving the public into trading with the Respondent's company rather than the Complainant (effectively a submission in terms of paragraph 3(a)(ii) of the Policy).

As noted in the preceding section, the name "Herts Fire and Security" is a generic/descriptive phrase. The first element, "Herts", is a common abbreviation for the geographic area Hertfordshire. The second element, "Fire & Security" is descriptive of a business operating in the field in which both of the Parties trade. Accordingly, it is an inescapable fact that the Complainant has selected a very generic/descriptive name for its business; one which it is not inconceivable that third parties in a similar line of business might themselves select on an entirely innocent basis, unconnected with the Complainant or its trading name.

Can such a term in the Domain Name constitute an Abusive Registration? This question has been considered in paragraph 4.9 of the Expert's Overview which provides as follows:-

"4.9 Can use of a purely generic or descriptive term be abusive?

Yes but, depending on the facts, the threshold level of evidence needed to establish that this is the case is likely to be much higher. It may well often depend upon the extent to which such a term has acquired a secondary meaning, which increases the likelihood that any registration was made with knowledge of the rights that existed in the term in question. In many such cases where there is little or no evidence of acquired secondary meaning the Respondent is likely to be able to show that the domain name in question has been arrived at independently and accordingly cannot have been as a result of an Abusive Registration..."

The key elements which the Expert draws from this passage for the present case are (1) a domain name consisting of a generic or descriptive term may be an Abusive Registration if the complainant proves that the registration was made with knowledge of the complainant's rights in that term; (2) if a respondent can show that a domain name was arrived at independently it cannot have been as the result of an Abusive Registration, albeit that a domain name could still subsequently become an Abusive Registration through the manner of its use; (3) where there is evidence of acquired secondary meaning the respondent is less likely to be able to show that it arrived at the domain name independently.

The most significant issue for the Complainant with this analysis is that it has failed to prove to the Expert's satisfaction that it has rights in the name "Herts Fire and Security". However, for completeness, the Expert will address the Complainant's case that the registration was made with the knowledge of its rights in the name and intent to target these. The Complainant's case on this topic may be summarised as follows - first, there is the proximity in timing between the Complainant's relocation into the same industrial estate as the Respondent's company and the registration date of the Domain Name; and secondly, there is the alleged approach to the Complainant from a member of the Respondent's staff to alert the Complainant to the Respondent's allegedly unethical behaviour.

On the subject of the proximity in timing, while the Domain Name was indeed registered within two weeks of the Complainant's relocation to the same industrial estate as the Respondent's company, the Respondent has been able to provide evidence that it had adopted the phrase "Fire & Security" in the name of company number 7192707, which was incorporated in March 2010, almost three years before the Complainant's relocation. The Respondent's explanation is that the Respondent's company had selected this company name to reflect the changing nature of the security side of its business. The Respondent says that that in due course it identified the name "Hertfordshire Fire and Security" independently of the Complainant by choosing to add the geographic descriptor "Hertfordshire", to the phrase "Fire and Security" which it was already using. Having combined these (with Herts in the abbreviated form) within the Domain Name (an ampersand not being permitted in a domain name for technical reasons), the Respondent states that it likewise instructed its company's accountants to register the corresponding limited company name. The Respondent states that this name has a "natural affinity" as the Respondent is based in Hertfordshire and is one of the largest fire and security companies in that area. It follows that the Respondent is arguing that it came upon the name independently and that the timing is coincidental.

The Complainant's case is that the timing is not coincidental and that this may be demonstrated by the approach which it says that it received from an employee of the Respondent's company on the same day that the Domain Name was registered. However, neither of the Parties' submissions on this topic have been of much assistance to the Expert. It appears from both Parties' submissions that a meeting did take place at some point after the Domain Name was registered although the date, or the reason for the meeting, is not known. The Respondent states that the meeting was between Mr Thatcher of the Complainant and the Respondent.

The Complainant says in the Reply that the meeting between Mr Thatcher and the Respondent took place after its contact with "a member of T & J staff". Despite allegedly possessing CCTV evidence of this contact, the Complainant fails to produce extracts of this or otherwise to provide any other details such as, most importantly, the identity of the employee concerned.

The Respondent simply denies that such prior contact took place, stating that the Complainant's account is factually incorrect and referring to the meeting which both Parties agree did take place. The Expert is left with a very confused picture, and faced with the Respondent's denial and the lack of any supporting evidence of the Complainant's position, the Expert considers that this matter does not advance the Complainant's case. Accordingly, the Expert considers that the Respondent's case that the registration of the Domain Name was arrived at independently and that the timing was coincidental must be preferred.

As noted above, even where a respondent can show that a domain name was arrived at independently it could still subsequently become an Abusive Registration through the manner of its use. In the present case, the Complainant states that the Domain Name has been used to divert traffic to the Respondent's existing website as part of a plan to confuse the Complainant's customers into dealing with the Respondent's company. The Complainant supports this argument by stating that it made trial calls to the Respondent's company during which the caller was falsely told that the Complainant had been taken over by the Respondent's company. Again, the Complainant relies on assertions which are not backed with supportive evidence. The Complainant does not even indicate the time and date of the calls and who made them. For its part, the Respondent denies that such telephone conversations took place and adds that the staff who had access to the switchboard were in any event unaware of the purchase of the Domain Name.

Without suitable evidence, the Expert is not in a position to prefer the Complainant's version of events regarding the trial calls. That said, they are not in themselves determinative of the issue of confusion or the potential for confusion. On this subject, the Expert considers that the decision of the Appeal Panel in *Wise Insurance Services v. Tagnames Limited*, DRS04889, is of assistance. In that case, the Appeal Panel found that because the complainant had adopted a descriptive name for its business it could not complain about the use of the same descriptive name by a third party. The Appeal Panel also noted that the limitations of the goodwill associated with the complainant's use of its name made the likelihood of confusion itself very low.

In the present case, as the Expert found above, the extent of the Complainant's trading under the name Herts Fire & Security is uncertain, and indeed the Complainant's evidence is even contradictory in places, such that it does not establish to the Expert's satisfaction that the Complainant has anything more than very limited goodwill, if any, in that name. Accordingly, on the basis of *Wise, supra*, the Expert finds that the likelihood of confusion being generated by the Domain Name is very low. Added to this must be the fact that the Respondent relies upon a forum posting which it says was made by the Complainant and which it submits indicates that the Domain Name has not affected the Complainant's business. The Complainant had an

opportunity to respond to this allegation in its Reply and chose not to address the point. In these circumstances it may be presumed that it does not deny that the forum posting was made by it. While there may be an element of bravado in its public disclosure that the Domain Name has not affected business, the Expert nevertheless must take the contradictory nature of the Complainant's statement into account on the question of confusion.

In all of these circumstances, the Expert finds that the Complainant has failed to prove on balance of probabilities that the Domain Name is an Abusive Registration.

7. Decision

The Expert finds that the Complainant has failed to prove that it has Rights in a name or mark which is identical to the Domain Name or that the Domain Name, in the hands of the Respondent, is an Abusive Registration. The Expert therefore directs that no action be taken with regard to the Domain Name.

Signed
Andrew D S Lothian

Dated 16 July, 2013
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