

DISPUTE RESOLUTION SERVICE

D00013399

Decision of Independent Expert

Bendart Limited

and

Rebecca Weavers

1. The Parties:

Complainant: Bendart Limited
Bendart Limited
Charles Street
Great Yarmouth
Norfolk
NR30 3LA
United Kingdom

Respondent: Rebecca Weavers
Branton,
The Walk
Gorleston
Great Yarmouth
Norfolk
NR31 8AS
United Kingdom

2. The Domain Name(s):

advantagedigitalmedia.co.uk

3. Procedural History:

I can confirm that I am independent of each of the parties. To the best of my knowledge and belief, there are no facts or circumstances, past or present, or that could arise in the foreseeable future, that need be disclosed as they might be of such a nature as to call in to question my independence in the eyes of one or both of the parties.

09 October 2013	15:11	Dispute received
10 October 2013	08:53	Complaint validated
10 October 2013	09:11	Notification of complaint sent to parties
29 October 2013	01:30	Response reminder sent
31 October 2013	13:46	Response received
31 October 2013	13:46	Notification of response sent to parties
05 November 2013	01:30	Reply reminder sent
05 November 2013	16:35	Reply received
05 November 2013	16:36	Notification of reply sent to parties
05 November 2013	16:36	Mediator appointed
08 November 2013	10:48	Mediation started
26 November 2013	17:27	Mediation failed
26 November 2013	17:28	Close of mediation documents sent
04 December 2013	08:58	Expert decision payment received

4. Factual Background

The Domain Name was registered on 3 April 2006 in the name of the Respondent.

The Respondent's then husband had previously started a business, trading as Advantage Media, that was ultimately bought by the Complainant. He had then worked for the Complainant until leaving in 2000. However, a few weeks after the Domain Name was registered in 2006, the Respondent's husband re-joined the Complainant as its Website Manager with the role of developing its online digital business.

The Respondent's husband's employment contract with the Complainant included a clause requiring the Respondent's husband to transfer the registration of the Domain Name to the Complainant within 3 months. However, that never happened. But the Domain Name was used by the Complainant between 2006 until very recently, when the Respondent's by then ex-husband's employment with the Complainant ended. For much of that time the Domain Name was used as the Complainant's primary website address until recently, when the Complainant's primary website address became www.advantagemedia.co.uk, and the Domain Name resolved to that website address instead.

The Respondent's husband left the Complainant in acrimonious circumstances on 18 September 2013. On 7 October 2013, the Domain Name was redirected to resolve to a new one page website rather than the Complainant's website.

5. Parties' Contentions

In summary, the Parties' contentions are as follows.

- The Complainant was incorporated in 1980 and traded as Blackwell Print in its local area of East Anglia and nationally online from 1998 to date using the advantagemedia.co.uk domain name and, from 2006 to 7 October 2013, also using the Domain Name with both

domain names resolving to the same website. On 7 October 2013 the Complainant lost the use of the Domain Name, which is the cause of this complaint.

- The Complainant says the “Advantage” brand was started in 1994 by the Respondent's then husband, Mr Darren Weavers, via his company Advantage Media Design & Print Limited (AMDPL) and the Complainant acquired a majority shareholding in that company in 1998 in exchange for trade debts owed to the Complainant. AMDPL operated on a national basis using an in-house call centre to sell print to businesses and individuals mainly in the entertainment field. The Respondent says that Mr Weavers started the business under the name “Darren Weavers t/as AdvantageMedia” in 1992 and worked hard to build it into a successful business.
- The Complainant says Mr Weavers left the company in 2000 when the Complainant bought out the remaining shares from him and, in 2005, the business of ADMPL was merged with the Complainant's business and the limited company AMDPL has not traded since that time. At this point, the Complainant adopted the name www.advantagemedia.co.uk as a trading style. The Respondent says that in 2000 Mr Weavers was forced to leave the, by then, limited company he had created because of intimidation by the other directors and until 2005 AdvantageMedia traded as Advantage Media not as AdvantageMedia.co.uk.
- The Complainant says that in early 2006, Mr Weavers approached the Complainant with the idea of moving the business from one based on call centre selling to more online trading. The Complainant says that, to demonstrate the idea, Mr Weavers had speculatively registered the Domain Name to enable him to demonstrate his ability and the potential of such a move to the Complainant's directors. The Complainant is not sure why the Domain Name was registered in Mr Weavers' wife's name but in agreeing to his proposal the Complainant's directors arranged for Mr Weavers to sign a letter of appointment which contained an undertaking that *“Sole rights to any trading internet web site or other web names used will be transferred to [the Complainant] before the end of this 3 months (trial) period”*.
- The Respondent says the Domain Name was registered 6 weeks before Mr Weavers was asked to re-join the Complainant because by that time sales had reduced to almost nothing and the Complainant was, as it is now, in financial trouble and that no agreement exists between the Respondent and the Complainant. In its reply, the Complainant says that neither at the time mentioned nor at the present time is the Complainant in "financial trouble".
- The Complainant says that unfortunately the promised transfer of the Domain Name did not happen, as Mr Weavers was soon involved in divorce proceedings with the Respondent and the Complainant was given the impression that the relationship was such that it would preclude her co-operation for the transfer of the Domain Name. However, the Complainant says that now seems to have changed. The Respondent says the transfer of the Domain Name never happened because the Respondent would never have agreed to it. The Domain Name is not something the Respondent would transfer.
- The Complainant traded on-line as www.advantagedigitalmedia.co.uk with its original domain name of advantagemedia.co.uk resolving to the same website. Between 2006 and 2009 the turnover of the on-line operation reached a high of £1,126,394.00 per annum. This has reduced since that time to £854,512.00 in 2012.
- During 2012 the Complainant refreshed the website and, as from February 2013, decided to revert back to using advantagemedia.co.uk as its main domain name as it was shorter

and more convenient for customers. However, the Domain Name's website was set with a permanent redirect to resolve to www.advantagemedia.co.uk as there were many third party links to it and it was considered by the Complainant to be its "digital media" web address. The Complainant says this process and much of the work was done by Mr Weavers in his capacity as the Complainant's Website Manager. The Respondent says that Mr Weavers did not carry out any work other than 'superficial UI graphic work' and all of the work relating to the 'ill planned and badly implemented' version of AdvantageMedia should be credited to another member of the Complainant's team.

- During August 2013, it became apparent to the Complainant that Mr Weavers was under-achieving by a considerable amount in his role as Website Manager and, with the failure of informal meetings to elicit any sign of improvement, the Complainant was forced to start formal action against him which led to Mr Weavers resigning on 18 September 2013 with immediate effect. The parting was not amicable. The Respondent says that the fact that the website was under performing was not due to Mr Weavers and the results of his performance review will be the subject of a constructive dismissal tribunal claim currently being filed.
- On 7 October 2013 the Complainant says Mr Weavers changed the Domain Name's settings to remove the Complainant's right of access to it. The Complainant says that Mr Weavers' agreement in his May 2006 Contract of Employment led the Complainant to believe that the Domain Name would be transferred to the Complainant, but it now appears that he has used problems with his private life to enable him to attempt to prevent the Complainant from continuing to use the Domain Name as previously agreed. The Respondent says that no agreement between the Respondent and the Complainant exists and Mr Weavers was not and is not able to agree to transfer the Domain Name as it not and never has been his to transfer.
- The Complainant has used the Domain Name from May 2006 until 7th October 2013 and during that time paid all costs associated with maintaining it for the Complainant's use. The Complainant says this shows that, until Mr Weavers' resignation, the intent was that the Domain Name would remain available for the exclusive use of the Complainant. The Respondent says that the website never used 'AdvantageDigitalMedia' as a trading name and never used the '@AdvantageDigitalMedia' email preferring to use @AdvantageMedia, and that "*the website, the marketing and all the SEO work was carried out for AdvantageMedia not AdvantageDigitalMedia*". The Respondent says that she has never been consulted about the use of the Domain Name and has never entered into an agreement with the Complainant.
- Given the long period during which the Domain Name has been associated with the Complainant's website there are many third party links to it, some of which will survive online for a considerable time. If they do not resolve to the Complainant's website the Complainant says it is liable to cause the Complainant considerable loss of business. After so many years of trading under the name "Advantage Media" it is, in the market within which the Complainant operates, a very well-known and valuable asset. The Complainant says that Mr Weavers is deliberately and abusively trying to devalue that asset. The Respondent says she asked Mr Weavers to contact the Complainant's Chairman, Graham Gooda, to discuss the Domain Name and was told that the change to where the Domain Name now resolves was not making any difference to the Complainant's sales.
- The Complainant believes that Mr Weavers' aggressive actions with the Domain Name means that only written communication is possible with him. The Respondent says that Mr Weavers has not been aggressive at any point and has attempted to contact Graham

Gooda to discuss the Domain Name only to be told that it would “*affect [the Complainant's] position to discuss it further*”. In its reply, the Complainant says that since submitting the complaint, Mr Weavers has telephoned once and verbally requested payment of £1,500 to both release the Domain Name and suspend any action he may be planning to take regarding his resignation but the Complainant declined the offer as it was advised that it could compromise its position were such action to be instigated.

- The Complainant has not at any time had any discussion or contact with the Respondent regarding the Domain Name, all contact having been through Mr Weavers. The Complainant says it has no knowledge of the present relationship Mr Weavers has with the Respondent, his former wife, but although the Domain Name is still registered with Nominet in the name of the Respondent, the Complainant points out that the contact address shown is the home address of Mr Weavers and his present partner. The Respondent agrees that this is correct, but says the Domain Name is and always has been registered in the name of the Respondent and the Complainant has never discussed the Domain Name or its use with the Respondent.
- The Complainant says that the Respondent's use of the Domain Name makes it an Abusive Registration as the Respondent gave the Complainant a written undertaking that, by virtue of the Complainant giving Mr Weavers employment, he would freely transfer ownership of the Domain Name to the Complainant. The Respondent says that the Domain Name was registered by the Respondent not Mr Weavers and that the Respondent has never been employed by the Complainant. She challenges the Complainant to produce evidence of it if any agreement exists between the Respondent and the Complainant.
- Since January 2006 The Complainant has invested a total of £295,000.00 with Google promoting the website associated with the Domain Name. The Complainant paid all costs and expenditure for the Domain Name and the advantagemedia.co.uk domain name since May 2006. The Respondent says she is unsure if this means the Complainant expects the Respondent to pay the fees and allow the Complainant to use it for free and perhaps the Complainant will now present the Respondent with a bill for the renewal fees. The Respondent says that the Complainant paid the fees because it would come to light that the Complainant was using the Domain Name without the Respondent's permission if they did not.
- The Complainant says the Registrar for the Domain Name (amongst others) was transferred by the Complainant from the original Registrar, Design Solutions, to the Complainant's present Registrar, EUK Hosts, with neither Mr Weavers nor the Registrar raising objection, but the Complainant does not have knowledge of the original email contact details with which the Domain Name was registered. The Respondent says that Design Solution transferred all the domain names “en masse” to EUKHost and did so without the knowledge that the Respondent had not given permission to do so and the Domain Name has now been pointed back to the original registrar, Design Solution, which is hosting the current web page to which it resolves.
- At present the Complainant says Mr Weavers has the Domain Name for sale on a single page site. This is where the Complainant's customers are diverted to when they use the website address associated with the Domain Name, which many will have stored and have used for years and to which many Google links are directed. The Complainant believes this gives the impression that the Complainant has gone out of business. The Respondent says that Mr Weavers is unable to sell the Domain Name as it is not and has never been registered in his name and that the Domain Name is not currently for sale.

- The Complainant says that Mr Weavers has now placed hidden links to a competitor's website within a photo image and within the Nominet registration certificate displayed on the website page and has (in spite of the Complainant's request to remove its copyright images) linked the website to the "Wayback Machine" showing historic versions of the Complainant's website. The Respondent says the Domain Name is hers and she can do as she pleases with it until Nominet advise her differently. The Respondent says she is unsure what the "hidden" links to which the Complainant is referring are, and she is unsure how a link to historic "Wayback Machine" cached sites can be subject to copyright as they are not being hosted on the Domain Name's website.
- The Complainant feels that the Respondent's registration of the Domain Name is without doubt an Abusive Registration and the damage being done to the Complainant's online business is potentially considerable, especially bearing in mind that customers will be led to believe that the Complainant has ceased trading. At present the Complainant can only conclude that Mr Weavers' aim is to discredit the name in which the Complainant has invested heavily and to cause a reduction in turnover on the Complainant's website. The Respondent says that Mr Weavers created the company and the name "AdvantageMedia" and as such has worked hard to grow the business only to be constructively dismissed from it. The Respondent asks why Mr Weavers would be trying to devalue it.

6. Discussions and Findings

General

In order to succeed the Complainant must prove, on the balance of probabilities, two matters, i.e. that:

1. the Complainant has Rights in respect of a name or mark which is identical or similar to the Domain Name; and
2. the Domain Name, in the hands of the Respondent, is an Abusive Registration.

These terms are defined in the Nominet DRS Policy 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 a secondary meaning.
- **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.

Complainant's Rights

The Complainant acquired the company and business previously started and run by the Respondent's then husband under the Advantage Media name. That company's business, and its trading assets, were subsequently transferred to the Complainant. Those assets will have

included any common law rights acquired by use of the Advantage Media name. Subsequently, from May 2006 until February 2013, the Complainant has used the Domain Name and its associated web address www.advantagedigitalmedia.co.uk as its principal online trading identity. From February 2013 to 7th October 2013 the Complainant reverted back to using advantagemedia.co.uk as its main domain name and associated web address, but arranged for the Domain Name to resolve to it.

The Respondent indicates that all of the use of the Domain Name by the Complainant was without her permission and there may be a moot legal point whether or not use of a name or mark without the true owner's knowledge and permission can generate enforceable passing off rights for the benefit of the user. However, whilst the response to the complaint purports to come from the Respondent, I have serious doubts that it was prepared by the Respondent rather than Mr Weavers. But even taking it at face value, it shows that the Respondent has a remarkably detailed knowledge of the historical internal workings of the Complainant's business and what Mr Weavers did or did not do whilst working for the Complainant and after leaving its employment. For example, she is able to state categorically that:

- Mr Weavers was asked to re-join the Complainant in 2006 because by that time the Complainant's sales had reduced to almost nothing;
- during 2012, when the Complainant refreshed its website and decided to revert back to using advantagemedia.co.uk as its main domain name, Mr Weavers did not carry out any work other than 'superficial UI graphic work' and the Complainant's 'ill planned and badly implemented' version of AdvantageMedia should be credited to another member of the Complainant's team;
- the fact that the Complainant's website was under performing by August 2013 was not due to Mr Weavers;
- The Complainant's website never used 'AdvantageDigitalMedia' as a trading name and never used the '@AdvantageDigitalMedia' email preferring to use @AdvantageMedia;
- the website, the marketing and all the "SEO" work (I presume the Respondent means 'search engine optimisation' work) undertaken by Mr Weavers was carried out for AdvantageMedia not AdvantageDigitalMedia; and
- that Mr Weavers has not been aggressive at any point.

When Mr Weavers re-joined the Complainant's business in 2006 and promised to transfer the registration of the Domain Name to the Complainant within 3 months, the Respondent was still married to Mr Weavers. Taking the response to the complaint at face value, the Respondent has clearly taken a close interest in the detail of Mr Weavers work for and his relationship with the Complainant. It is therefore likely that she will have been aware of the promise made by Mr Weavers to transfer the Domain Name to the Complainant as part of the arrangements by which he was again employed by the Complainant. In any event, judging by the level of detailed knowledge of the Complainant's business displayed by the Respondent in the response to the complaint, it is inconceivable that the Respondent did not, at the very least, know that for much of the time since 2006 the Complainant was using the Domain Name as part of its online trading identity and she never once questioned this or raised any objection with the Complainant.

In the circumstances, I believe that the Complainant's extensive use of the Domain Name in relation to its online business from 2006 to February 2013 will have created passing off rights

in the Advantage Digital Media trading name that would be enforceable by the Complainant. That is a name or mark which is identical to the Domain Name.

In any event, before 2006 and since February 2013, the Complainant has extensively used the Advantage Media trading name. The Respondent says that even during 2006 to February 2013 when the Domain Name was used to resolve to the Complainant's website at www.advantagedigitalmedia.co.uk, the Complainant's website was actually using Advantage Media as its trading name rather than Advantage Digital Media. The Respondent acknowledges that this trading name was originally her husband's trading name and subsequently that of the company he started. That company, and all of its assets at the time, was subsequently acquired by the Complainant and the business later merged with the Complainant's business. Therefore, even on the Respondent's case, any separate rights associated with the Advantage Media trading name belong to the Complainant. That is a name or mark which is similar to the Domain Name.

In the circumstances, for the purposes of the Nominet DRS, I find that the Complainant has Rights in respect of a name or mark which is identical or similar to the Domain Name.

Abusive Registration

The Domain Name was registered a few weeks before the Respondent's then husband re-joined the Complainant's business with a role to develop the Complainant's online digital business.

Paragraph 3 of the DRS Policy sets out a non-exhaustive list of factors which may be evidence that the Domain Name is an Abusive Registration. Paragraph 3 v. states as follows:

v. The Domain Name was registered as a result of a relationship between the Complainant and the Respondent, and the Complainant:

A. has been using the Domain Name registration exclusively; and

B. paid for the registration and/or renewal of the Domain Name registration.

The Domain Name has only ever been used by the Complainant and it has paid for its renewal. But, as the Respondent repeatedly pointed out in the response, the Complainant's relationship was with the Respondent's then husband and not the Respondent herself.

But paragraph 3 of the DRS merely sets out non-exhaustive examples of circumstances that may evidence an Abusive Registration. In view of the Respondent's then existing knowledge of and her husband's previous dealings with the Complainant and its business, it is almost inconceivable that the Domain Name was registered for any purpose other than to be used as part of the plan for the Respondent's then husband to re-join the Complainant to develop its online digital business.

Paragraph 3 a i of the DRS Policy states as follows:

i. Circumstances indicating that the Respondent has registered or otherwise acquired the Domain Name primarily:

A. for the purposes of selling, renting or otherwise transferring the Domain Name to the Complainant or to a competitor of the Complainant, for valuable consideration in excess of the Respondent's documented out-of-pocket costs directly associated with

acquiring or using the Domain Name;

B. as a blocking registration against a name or mark in which the Complainant has Rights; or

C. for the purpose of unfairly disrupting the business of the Complainant;

With the Respondent's knowledge of the Complainant's business in April 2006, and no doubt knowing of her then husband's plan to re-join the Complainant to develop its online digital business, if the Domain Name had been registered by the Respondent for any purpose other than for it to be used by her then husband to develop the Complainant's online digital business, it could only have been for one of the purposes described by Paragraph 3 a i of the DRS Policy. As such, it would have been registered in a manner which, at the time when the registration took place, took unfair advantage of and was unfairly detrimental to the Complainant's Rights in its existing Advantage Media trading name.

The Domain Name was used extensively by the Complainant in relation to its online digital business until its relationship with the Respondent's husband ended in September 2013 in acrimonious circumstances. A few weeks later, the Domain Name was redirected from the Complainant's main website to a new 'one page' website.

The Respondent's response to the complaint ended by referring me in support of her response to the current website to which the Domain Name resolves at www.advantagedigitalmedia.co.uk. When I visited the site it displayed the following:

AdvantageDigitalMedia.co.uk

"Any Old Aluminium,

Any Old Aluminium,

Any Any Any Old

Aluminium"

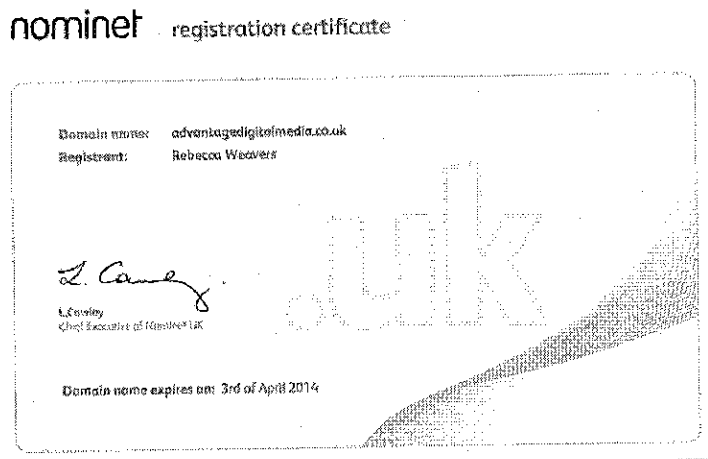


The 7-10" Digital Mix



Contact

Who has owned the domain since 1st April 2006?



Please note: This site has no association with sites of similar names.

The "Contact" button had a link that automatically opened an email in Outlook addressed to info@advantagedigitalmedia.co.uk. Presumably any email sent there would be picked up by the Respondent (or Mr Weavers). The "Who has owned the domain since 1st April 2006?" link was a link to the 'Whois' look up facility on Nominet's website.

The Complainant is rightly concerned that its customers who have been used to seeing the Complainant's website when visiting www.advantagedigitalmedia.co.uk, and who may well have associated it with the Complainant by way of automatic links or having it saved as one of their 'favourite' website addresses, will now be faced with a very different and strange website page. The Complainant says some customers will believe they have gone out of business.

Paragraph 3 a. ii. of the DRS Policy states as follows:

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 Respondent may say that no one now visiting the site would, when they see it, think that it is operated or authorised by the Complainant and she may point in particular to the disclaimer at the foot of the website page that "This site has no association with sites of similar names". She may also point to the Nominet registration certificate displayed on the page and the link to the 'Whois' look up facility to demonstrate that no one would believe the Domain Name is or ever has been registered to anyone other than the Respondent. I strongly suspect that those elements of the current webpage were included with Paragraph 3 a. ii. of the DRS Policy specifically in mind.

However, even if visitors to the website immediately realise that it is no longer the Complainant's website and do not assume any sort of endorsement or other connection, given the history of the use of the Domain Name by the Complainant, they may well have visited the site in the initial hope and expectation that it would be a website "operated or authorised by or otherwise connected with the Complainant".

This is what is known as 'initial interest confusion' and is commented on in the DRS Experts' Overview, which is published on the Nominet website to assist all participants or would-be participants in disputes under the DRS Policy by explaining commonly raised issues and how

Experts, the members of Nominet's panel of independent adjudicators, have dealt with those issues to date and identifying any areas where Experts' views differ. The DRS Experts' Overview makes clear that the overwhelming majority of Experts view initial interest confusion as being a possible basis for a finding of Abusive Registration particularly where, as in this case, the Domain Name is identical to the name or mark of the Complainant and without any adornment other than the generic domain suffix. As the Experts' Overview comments, the vice of initial interest confusion is that even if it is immediately apparent to the visitor to the website that the site is not in any way connected with the Complainant, the visitor has been sucked in and deceived by the domain name.

In the circumstances, I have no hesitation in finding that the current use of the Domain Name to resolve to the website shown above means that the Domain Name has been used in a manner which took unfair advantage of or was unfairly detrimental to the Complainant's Rights

7. Decision

For the reasons outlined above I find that the Complainant has proved, on the balance of probabilities, that it has Rights in respect of the names ADVANTAGE MEDIA and ADVANTAGE DIGITAL MEDIA, being names or marks which are, respectively, identical and similar to the Domain Name, and that the Domain Name, in the hands of the Respondent, is an Abusive Registration.

In the circumstances I order that the Domain Name be transferred to the Complainant.

Signed

Dated 27 December 2013

Chris Tulley