

DISPUTE RESOLUTION SERVICE

D00013831

Decision of Independent Expert

Boodle Hatfield LLP

and

Bodle Kane

1. The Parties:

Complainant: Boodle Hatfield LLP
89 New Bond Street
London
W1S 1DA
United Kingdom

Respondent: Bodle Kane
17 Westmorland
17 Westmorland
road london se17 2ax
E8 3RU
United Kingdom

2. The Domain Name:

bodle-hatfield-llp.co.uk

3. Procedural History:

I 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 a such a nature as to call into question my independence in the eyes of one or both of the parties.

07 February 2014 16:25 Dispute received
10 February 2014 09:35 Complaint validated

11 February 2014 14:15 Notification of complaint sent to parties
28 February 2014 01:30 Response reminder sent
05 March 2014 08:12 No Response Received
05 March 2014 08:12 Notification of no Response sent to parties
11 March 2014 10:42 Expert decision payment received

4. Factual Background

The Complainant, Boodle Hatfield LLP, is a well-known London law firm established in 1722 which became known in 1896 as Boodle, Hatfield & Co, in 1986 as Boodle Hatfield and in 2012 as Boodle Hatfield LLP.

The Domain Name was registered on 24 October 2013. It resolves to a website presenting material copied from the website of another well-known law firm, Kingsley Napley LLP, substituting for the name of that firm the name “Bodie Hatfield LLP”. The website claims that “Bodie Hatfield LLP” is “an internationally recognised law firm based in central London”, offering similar services to those of the Complainant.

Persistent attempts by the Complainant to identify and contact the Respondent were unsuccessful.

5. Parties’ Contentions

The Complainant asserts common law trademark rights in the name Boodle Hatfield and that the close similarity or identity of that name and the Domain Name, together with the identity of legal services offered on the Respondent’s website, indicate that:

- (i) the Respondent registered the Domain Name primarily as a blocking registration against a name or mark in which the Complainant has Rights (invoking Part 3.a.i.B of the DRS Policy); or
- (ii) the Respondent registered the Domain Name primarily for the purpose of unfairly disrupting the business of the Complainant (Part 3.a.i.C); or
- (iii) the Respondent is using the Domain Name in a way which has confused people or businesses into believing that the Domain Name is registered to, operated or authorised by, or otherwise connected with the Complainant (Part 3.a.ii); and
- (iv) it is likely that the Respondent has given false or misleading contact details to Nominet (Part 3.a.iv). In particular, the Complainant believes the Domain Name is registered to a false or misleading name and address.

Further, the Complainant contends that:

- (v) the Respondent is not making use of the Domain Name or a domain name which is similar to the Domain Name in connection with a genuine offering of legal services or indeed any proper commercial use (Part 4.i.A);
- (vi) the Respondent has not been commonly known by the name or legitimately connected with a mark which is identical or similar to the Domain Name (Part 4. B);
- (vii) the Respondent has not made legitimate non-commercial or fair use of the Domain Name (Part 4. C);
- (viii) the Domain Name is neither generic nor descriptive and the Respondent is making unfair use of it in breach of the Complainant's rights under the name Boodle Hatfield as an unregistered trade mark (Part 4.C.ii).

The Complainant says there is no relationship between the parties so the Respondent's holding of and use of the Domain Name is not under any agreement or licence from the Complainant. Although the Complainant has no evidence of damage to its business or that the Domain Name was registered in order to prevent the Complainant from registering it in order to sell it to the Complainant for an inflated value, the Respondent is gaining unfair advantage from use of the Complainant's name or mark and threatens in the future to damage the goodwill in the Complainant's name.

Accordingly, the Complainant says the Domain Name is an abusive registration in that it has been misused. The website has the stolen content of another law firm, Kingsley Napley LLP, which is badly altered by partial substitution of the name "Bodie Hatfield LLP". The Domain Name is so similar to the Complainant's own name as to be a misleading instrument of fraud by itself. Finally the Domain Name is abusive in that people may waste time and money trying to contact the Respondent seeking legal advice which the Respondent is not registered to provide, damaging the profession and frittering away the client public's time and money when they are in need of legal assistance and services.

As already noted, there has been no Response to the Complaint.

6. Discussions and Findings

Under paragraph 2 of the Dispute Resolution Service Policy ("the Policy") a complainant is required to show, on the balance of probabilities, that;

- (1) it 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.

“Rights” are defined in the Policy as “rights enforceable by the Complainant, whether under English law or otherwise, and may include rights in descriptive terms which have acquired a secondary meaning”.

In view of its having carried on business under a name essentially comprising BOODLE HATFIELD since at least 1896, the Complainant undoubtedly has enforceable rights in the name and mark BOODLE HATFIELD. The Domain Name is clearly similar to the Complainant’s name and mark.

Leaving aside the indications that a false name and address were provided to Nominet, having regard to a) the registration by the Respondent of a domain name so closely similar to the name and mark of the Complainant; b) the use of the associated website to convey the false and misleading appearance of a genuine London law firm known as Bodie Hatfield LLP; and c) using material deliberately copied from the website of the law firm Kingsley Napley LLP, I cannot conceive of any legitimate purpose for which the Domain Name could possibly have been registered, nor of any legitimate use to which it could be put. The Domain Name is being used in a manner that both takes unfair advantage of and is unfairly detrimental to the Complainant’s Rights.

Accordingly the Panel accepts the Complainant’s contentions in their entirety and finds that, in the hands of the Respondent, the Domain Name is an abusive registration.

7. Decision

I find that the Complainant has proved, on the balance of probabilities, that it has rights in a name and mark which is similar to the Domain Name and that the Domain Name is an Abusive Registration in the hands of the Respondent.

I therefore direct that the Domain Name be transferred to the Complainant.

Signed Alan Limbury

Dated: March 26, 2014