

DISPUTE RESOLUTION SERVICE

D00015214

Decision of Independent Expert

Douglas Wright

and

Mr Graeme Cunningham

1. The Parties:

Lead Complainant: Douglas Wright Solicitors
78 John Finnie Street
Kilmarnock
Ayrshire
KA1 1BS
United Kingdom

Respondent: Mr Graeme Cunningham
100 John Finnie Street
Kilmarnock
KA1 1BB
United Kingdom

2. The Domain Name:

douglaswrightsolicitors.co.uk (“the Domain Name”)

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

16 December 2014 15:28 Dispute received
17 December 2014 13:32 Complaint validated
17 December 2014 14:15 Notification of complaint sent to parties
17 December 2014 17:25 Response received
17 December 2014 17:25 Notification of response sent to parties
24 December 2014 01:30 Reply reminder sent
29 December 2014 11:17 Reply received
29 December 2014 11:23 Notification of reply sent to parties
29 December 2014 11:23 Mediator appointed
05 January 2015 09:57 Mediation started
23 January 2015 14:15 Mediation failed
23 January 2015 14:16 Close of mediation documents sent
04 February 2015 01:30 Complainant full fee reminder sent
09 February 2015 11:15 Expert decision payment received

4. Factual Background

The Complainant and the Respondent are individuals, each trading as solicitors in Kilmarnock. They were formerly in a 50/50 partnership, trading under the name "Douglas Wright Solicitors". On 27 August 2013, while the partnership was still in existence, the Respondent registered the Domain Name for use as the firm's website. To the Complainant's knowledge, the Respondent named himself as registrant but used the firm's address.

Following subsequent dissolution of the partnership in acrimonious circumstances, the Complainant continued to practice as "Douglas Wright Solicitors" whereas the Respondent started trading under a new name: "GMC Criminal Lawyers", a few doors away from the Complainant's office.

The Respondent retained the Domain Name and redirected it to the website of his own practice at www.kilmarnockcriminallawyers.co.uk.

5. Parties' Contentions

Complaint

A summary of the Complaint is as follows:

The Domain Name reflects the Complainant's personal name.

The Respondent registered the Domain Name on the Complainant's instructions.

Persons searching for the Complainant's website are automatically redirected to the Respondent's website. This was not what was intended when the Domain Name was registered and so the Domain Name is now an abusive registration.

Clients and potential clients are being fooled into thinking that the Respondent is acting under the Complainant's name and that the Complainant controls the Domain Name.

Response

A summary of the Response is as follows:

The Complainant did not instruct the Respondent to register the Domain Name. The Respondent himself decided to do this and to create a website. The Complainant was unaware of the matter and was less than enthusiastic when he found out. He has no grasp of modern technology and felt that a website was not required.

When the business relationship between the parties broke down, with the Complainant having retained a significant amount of the Respondent's money, the Respondent decided in accordance with his rights as owner of the Domain Name to direct it to his current website. There is nothing on the website which suggests or infers that the Respondent is acting on the Complainant's behalf or under his name. The website clearly relates to a different business.

The Complainant is disappointed that the Respondent has opened a competing business and is worried that he will lose some of the business serviced by the Respondent for the last five or more years. The Complainant is acting unprofessionally.

The Respondent is prepared to transfer the Domain Name to the Complainant in return for payment of £5000.

Reply

A summary of the Reply is as follows:

The Response does not address the Complaint. Rather, it supports the Complainant's case.

The Respondent registered kilmarnockcriminallawyers.co.uk on the same day that he registered the Domain Name. He could have used this domain name if he simply wanted to open a website for his competing business. It is obvious that he decided to use the Domain Name, which includes the Complainant's name, to fool the Complainant's clients into thinking that the Respondent was still linked to the Complainant's firm.

The Respondent knows very well that many of the Complainant's clients rely on information on the Complainant's website, including up to date contact details. It has taken the Complainant many years to establish himself in the area and create a reputation.

The Respondent's willingness to sell the Domain Name shows that he has no interest in answering the points raised in the Complaint and that he is not using the Domain Name in the manner that it was originally intended.

6. Discussions and Findings

General

To succeed, the Complainant has to prove in accordance with paragraph 2 of the DRS Policy on the balance of probabilities, first, that it has rights (as defined in paragraph 1 of the DRS Policy) in respect of a name or mark identical or similar to the Domain Name and, second, that the Domain Name, in the hands of the Respondent, is an abusive registration (as defined in paragraph 1 of the DRS Policy).

Complainant's rights

The meaning of "rights" is clarified and defined in the DRS Policy in the following terms:

"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 Complainant relies on unregistered rights in the name "Douglas Wright Solicitors".

Paragraph 2.2 of the DRS "Expert's Overview" on Nominet's website states that, in the case of 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)."

Despite this, and despite the extensive guidance on Nominet's website warning of the need for evidence to back up parties' assertions, the

Complainant has not provided any evidence to substantiate his assertions as to rights.

However, the Respondent does not dispute the Complainant's assertion that he has been trading on his own for many years under the distinctive name "Douglas Wright Solicitors", both before and after the partnership with the Respondent. In view of this, as well as the fact that the establishment of rights is regarded as a low threshold test, I conclude that the Complainant has – very narrowly – established rights in this name and that this is identical to the Domain Name. Had the Respondent not accepted the Complainant's contentions on this issue, then the Complaint may well have fallen at this threshold.

Abusive registration

Is the Domain Name an abusive registration in the hands of the Respondent? Paragraph 1 of the DRS 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 took unfair advantage of or was unfairly detrimental to the Complainant's Rights."*

The Complainant does not suggest that the Domain Name was acquired in an abusive manner. The sole issue is whether the Respondent's retention of the Domain Name following dissolution of the partnership and redirection thereof to the Respondent's own website constituted abusive use.

As with the issue of rights, the Complainant failed to exhibit any evidence whatever in support of his case on abusive registration. One would have expected to see at least a screenshot of the redirected website. However, the Respondent admits the redirection and so the essential facts are not in dispute.

The Respondent claims that he was entitled to use the website in this manner because the Complainant allegedly retained a significant amount of the Respondent's money following the relationship breakdown. I am not in a position to assess whether or not the Complainant inappropriately retained a significant amount of the Respondent's money but, even if so, I fail to see how that could possibly justify the Respondent's redirection of the Domain Name to his own website after dissolution of the partnership. Any right of the Respondent to use the name "Douglas Wright Solicitors" must surely have terminated at that point; certainly the Respondent has not claimed otherwise.

It appears from the Respondent's invocation of the alleged debt due from the Complainant, as well as his offer in the Response to sell the Domain Name to the Complainant for £5,000, that the Respondent's real purpose in retaining and redirecting the Domain Name was to use the threat of diversion of the

Complainant's clients and potential clients to the Respondent as a bargaining chip to help him recoup his money from the Complainant. In my view that attempt to derive an unfair advantage constitutes abusive use of the Domain Name. If the Respondent considered that the Complainant owed him money, then there were other routes he could have followed.

The Respondent asserts that there is nothing on his website which suggests an association with the Complainant. However in the factual circumstances of this case the redirection in and of itself may well suggest that the Complainant has rebranded, has been sold or has ceased trading altogether. Each of these representations would be detrimental to the Complainant and its Rights. There is also the allied prospect of "initial interest confusion", which is explained in paragraph 3.3 of the DRS Experts' Overview in the following terms:

"Commonly, Internet users will visit web sites either by way of search engines or by guessing the relevant URL. If the domain name in dispute is identical to the name of the Complainant and that name cannot sensibly refer to anyone else, there is bound to be a severe risk that a search engine, which is being asked for the Complainant, will produce high up on its list the URL for the web site connected to the domain name in issue. Similarly, there is bound to be a severe risk that an Internet user guessing the URL for the Complainant's web site will use the domain name for that purpose.

In such cases, the speculative visitor to the registrant's web site will be visiting it in the hope and expectation that the web site is a web site "operated or authorised by, or otherwise connected with the Complainant." This is what is known as 'initial interest confusion' and the overwhelming majority of Experts view it as a possible basis for a finding of Abusive Registration, the vice being that even if it is immediately apparent to the visitor to the web site that the site is not in any way connected with the Complainant, the visitor has been deceived. Having drawn the visitor to the site, the visitor may well be faced with an unauthorised tribute or criticism site (usually the latter) devoted to the Complainant; or a commercial web site, which may or may not advertise goods or services similar to those produced by the Complainant. Either way, the visitor will have been sucked in/deceived by the domain name.

Findings of Abusive Registration in this context are most likely to be made where the domain name in issue is identical to the name or mark of the Complainant and without any adornment (other than the generic domain suffix). See for example DRS 00658 (chivasbrothers.co.uk)."

In my view there is a high likelihood of initial interest confusion arising in this case given that the Domain Name is identical to the name of the Complainant's business, without any adornment other than the generic domain suffix.

In these circumstances, I conclude that, on the balance of probabilities, the Domain Name is an abusive registration in that it has been used in a manner

which took unfair advantage of or was unfairly detrimental to the Complainant's rights.

7. Decision

I find that the Complainant has rights in a mark which is identical to the Domain Name and that the Domain Name is, in the hands of the Respondent, an abusive registration. I therefore direct that the Domain Name, douglaswrightsolicitors.co.uk, be transferred to the Complainant.

Signed: Adam Taylor

Dated: 4 March 2015