

# **DISPUTE RESOLUTION SERVICE**

**D00018167**

## **Decision of Independent Expert**

Backwell Wood Estate

and

Mr Ken Rees

### **1. The Parties:**

Lead Complainant: Backwell Wood Estate  
Royal Talbot House  
Bristol  
BS1 6BB  
United Kingdom

Complainant: Bellwind-Edis Limited  
Royal Talbot House  
Bristol  
BS1 6BB  
United Kingdom

Respondent: Mr Ken Rees  
West End Lane  
Nailsea, Bristol  
BS48 4DB  
United Kingdom

### **2. The Domain Name(s):**

backwell-logs.co.uk

### **3. Procedural History:**

The Complaint was submitted to Nominet on 8 November 2016 and was validated and notified to the Respondent by Nominet on the same day. The Respondent was

informed in the notification that he had 15 working days, that is until 29 November 2016, to file a response to the Complaint.

On 9 November 2016, the Respondent filed a Response. On 10 November 2016, the Complainant filed a Reply to the Response and the case proceeded to the mediation stage. On 16 November 2016, Nominet notified the Parties that mediation had been unsuccessful and, pursuant to paragraph 10.5 of Nominet's Dispute Resolution Service Policy Version 4 ("the Policy"), invited the Complainant to pay the fee for referral of the matter for an expert decision. On 21 November 2016, the Complainant paid the fee for an expert decision. On 22 November 2016, 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 25 November 2016.

#### **4. Formal and Procedural issues**

In the present case, it appears to the Expert that the author of the Complaint and Reply has mistakenly listed Bellwind-Edis Limited as sole Complainant in Nominet's online form. The Complaint itself focuses more particularly on a different but closely related entity named Backwell Wood Estate, which is most probably a partnership. This partnership appears to be the entity which is asserting the elements set out in paragraph 2.1 of the Policy. As a preliminary matter, therefore, the Expert is faced with a question as to which entity is or should be treated as the Complainant or indeed whether both entities together are or should be treated as joint Complainants.

The Policy states in the Definitions section, paragraph 1, that:

***Complainant** means a third party who asserts to [Nominet] the elements set out in paragraph 2.1 or, if there are multiple Complainants, the 'lead complainant' (see paragraph 4.2.1)".*

Paragraph 4.2.1 of the Policy provides that more than one person or entity may jointly make a complaint and that where this happens the joint complainants must specify one of their number who will be the lead complainant to receive correspondence and who is entitled to act on behalf of all complainants, while paragraph 4.2.2 of the Policy provides that the joint complainants must specify which of their number is to become the sole registrant of the domain name(s) under dispute if the complainants are successful (noting that this does not bind the Expert).

The wording of each of the Complaint, Response and Reply indicates to the Expert that both Parties have treated Backwell Wood Estate as the lead Complainant and Bellwind-Edis Limited as, at most, a joint Complainant. For example, the Complaint does not refer to "the Complainant" as such but mainly references the partnership and its partners, Mr and Mrs Edis. The Response principally addresses itself to "Backwell Woodlands" and/or "Backwell Woods", meaning the partnership, and raises a substantive issue as to whether that business has ever traded as "Backwell Logs". It only mentions Bellwind-Edis Limited in passing.

It seems to the Expert that Bellwind-Edis Limited has been introduced in the Complaint as an attempt to specify that company in accordance with paragraph 4.2.2

of the Policy. It is described as being the nominee holder of Mr and Mrs Edis's domain names and its presence in the *dramatis personae* of the case only makes sense in that context. In contrast, the submissions relating to Backwell Wood Estate mean that it can only be viewed as the entity claiming Rights in a name and allegedly affected by the registration and/or use of the Domain Name.

In light of the apparent mistake on the part of the author of the Complaint, the Expert is faced with two options. The first is to dismiss the Complaint out of hand on the grounds that the sole Complainant as listed in the online form is not the party described in the Complaint as having Rights in respect of a name identical or similar to the Domain Name. The second is to proceed with a more practical and purposive approach of treating the partnership as the lead Complainant, aligned with the definition in paragraph 1 of the Policy, and the limited company as a joint Complainant on the basis that everything else in the case papers logically bears that out.

The Expert has decided to follow the second option. There is nothing before the Expert indicating that the Parties did not understand where the issues lay or that the Respondent has been placed at any disadvantage as a consequence of the way in which the original sole Complainant was listed. Most importantly, the Expert does not consider that the Respondent is in any way prejudiced by the partnership being treated as the lead complainant at this stage, given that the substance of the Response shows that this is his expectation.

In all of these circumstances, the Expert will treat Backwell Wood Estate as lead Complainant. The Expert will treat Bellwind-Edis Limited as joint Complainant and nominated sole registrant of the Domain Name in terms of paragraph 4.2.2 of the Policy if the Complainants are successful. Where appropriate and for convenience, the lead and joint Complainants will be referred to together as "the Complainants" in the remainder of this decision.

## **5. Factual Background**

The Complainants are both owned by Ken and Karen Edis and appear to be family businesses. Backwell Wood Estate, trading as Backwell Logs, is a partnership which supplies seasoned logs from a sustainable source, being pure ash, a woodland mix, stove logs and kindling wood, to customers around Bristol and Somerset. Bellwind-Edis Limited is said to hold all of Mr and Mrs Edis's registered domain names.

The original gestation of the trading name Backwell Logs appears to be found in a logo design contained in an email dated 2 November 2015 from Backwell Wood Estate's designer, Martin Harris, to Mr Edis. This email refers to a prior meeting "on Friday" (presumably 30 October 2015) and indicates that Mr Harris was instructed to develop a logo for Backwell Wood Estate along with the registration of a corresponding domain name. Mock-ups were provided of the livery for a lorry. For an online presence, the email proposes the registration of backwelllogs.uk or backwell-logs.uk and puts forward suggested logo and layout styles featuring the latter domain name along with the legend "BACKWELL LOGS" in block capitals. Just over an hour after this email, Mr Edis sent an email to various individuals reporting that "Backwell Wood Estate will now start using the brand name "Backwell Logs"".

The domain name backwell-logs.uk was registered on 15 December 2015 and the Complainants state this was done by the company secretary of Bellwind-Edis Limited. The WHOIS record however shows that the registrant name of that domain name is "Company Secretary" and the registrant type is "UK Individual". Accordingly, while it is said to have been Mr and Mrs Edis's intention to hold all of their registered domain names in the name of Bellwind-Edis Limited, this has not been fully achieved in the case of the latter domain. Nevertheless, that intention is indicated to some extent by the way in which the registrant details have been entered.

At some point between 2 November 2015 and the filing of the Reply, arrangements were made by the Complainants to provide Backwell Wood Estate's lorry with new livery similar to the original mock-up featuring the block capitals "BACKWELL LOGS" in a logo on its doors. The rear and back of the lorry appear to feature the Domain Name. Presumably this was an error by the sign painters or person instructing them. The domain name then being used by Backwell Wood Estate was backwell-logs.uk and the lorry features backwell-logs.co.uk. This would however have been a relatively easy mistake for someone unfamiliar with Nominet's introduction of second level registrations directly under .uk to have made. The Complainants state that the lorry has been active in the Somerset area "for some weeks now".

The Complainant's website at [www.backwell-logs.uk](http://www.backwell-logs.uk) features the new "BACKWELL LOGS" logo prominently at the top of the page and notes at the bottom "Backwell Logs at Backwell Wood Estate".

The Respondent sells logs under the trading name "Somerset Logs". The Domain Name was registered on 3 October 2016. The Complainant claims (and the Respondent does not deny) that the Domain Name originally directed traffic to the Respondent's "Somerset Logs" website. By 3 November 2016, the Domain Name had been pointed to a Sedo Domain Parking page at which it was offered for sale in the sum of £10,000 and which featured sponsored advertising listings related to furniture. As at the date of appointment of the Expert, the Domain Name forwarded to a server at [bn.get-your-game-on.xyz](http://bn.get-your-game-on.xyz) but the website did not resolve.

The Respondent produces screenshots from the Complainants' website at [www.backwellwoods.org.uk](http://www.backwellwoods.org.uk). This site shows the Complainant's logs business described as "Backwell Woods" without using the trading name "Backwell Logs". The Complainant says that this is its old website, adding that the new site had not rolled out as at the date of the Reply.

## **6. Parties' Contentions**

### **Complainants**

The Complainants note that Backwell Wood Estate, trading as Backwell Logs, is primarily based in Somerset and add that the trading name was adopted in December 2015 when Mr and Mrs Edis registered the domain name backwell-logs.uk. The Complainants claim that this domain name is now held by Bellwind-Edis Limited.

The Complainants contend that Mr and Mrs Edis have established a significant reputation in Somerset and the surrounding areas in relation to the sale of logs which attaches to the name Backwell Logs and that they are entitled to trade as such.

The Complainants assert that the Domain Name was registered by the Respondent on 3 October 2016. The Complainants contend that the registration of the Domain Name was intended to encroach on their intellectual property and the goodwill contained within their trading name in the Somerset area. The Complainants assert that the use of the Domain Name by a competing business which does not trade under that name is likely to cause confusion in the minds of the public as it seeks to associate the Respondent's business with that of the Complainants.

The Complainants note that the Domain Name originally forwarded traffic to the Respondent's competing business and submit that this demonstrates an intention to divert trade and to mislead the public into thinking that the two businesses are the same. The Complainants add that the continued presence of third party products being sold under the Domain Name is likely to cause substantial damage to their reputation and goodwill, resulting in loss of business.

The Complainants narrate that their solicitor wrote to the Respondent on 19 October 2016 requesting that the Respondent desist from using the Domain Name and to transfer it in order to avoid further confusion, noting that no response was received to that letter.

The Complainants refer to the screenshot of the website associated with the Domain Name dated 3 November 2016 and point out that the Respondent is offering the Domain Name for sale for £10,000. The Complainants submit that the Respondent's primary purpose in registering the Domain Name was to sell it to the Complainants for a substantial premium and/or to divert customers away from the Complainants' business.

### **Respondent**

The Respondent states that he purchased the Domain Name because it was available for sale and adds "we own most log website addresses in the North Somerset area to help our sales". The Respondent comments "I believe that this is not a crime and if it is then we should be chasing [a third party] for one of our domains in which we are not".

The Respondent notes that if the Complainants wish to purchase the Domain Name they are welcome to do so and have already been told this. The Respondent notes that the Domain Name is parked with Sedo with a price tag of £10,000.

The Respondent asserts that "Backwell Woodlands" at no time refer to themselves as "Backwell Logs", even on their main website. In support of this submission, the Respondent relies on the website in the public domain at [www.backwellwoods.org.uk](http://www.backwellwoods.org.uk) and produces a copy of the Backwell Woods website as a screenshot.

## **Complainants' Reply to Response**

The Complainants assert that the Respondent's screenshots are of the Complainants' old website, noting that this is in the process of being renewed but that the new site is not yet rolled out.

The Complainants submit that they have been trading as Backwell Logs for twelve months and produce emails providing the background to their adoption of the trading name together with a flyer which they state has been distributed around Somerset, the photograph of their lorry with new livery featuring the brand and an internal document from November 2016 confirming the trading style.

The Complainants add that they have received a telephone call from a domain name broker or third party claiming to own the Domain Name and suggesting that the Respondent has sold it. The Complainants submit that this supports their position that the Respondent is attempting to exploit his position and to extract money from the Complainants.

## **7. Discussions and Findings**

### **General**

In terms of paragraph 2.2 of the Policy the onus is on the Complainants to prove to the Expert on balance of probabilities each of the two elements set out in paragraphs 2.1.1 and 2.1.2 of the Policy, namely that the Complainants have Rights in respect of a name or mark which is identical or similar to the Domain Name; and that the Domain Name, in the hands of the Respondent, is an Abusive Registration.

### **Complainants' 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'.

In the present case, the Complainants claim Rights in the lead Complainant's trading name "Backwell Logs" which they state has been in use by the Backwell Wood Estate partnership for a year. The Expert notes that in citing their trading name in this context, the Complainants are effectively claiming the existence of a corresponding unregistered trade mark.

Paragraph 2.2 of the Experts' Overview Version 2 provides a guide as to what is required for a complainant to prove that it has rights in an unregistered trade mark:

*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).*

In the present case, the Complainants have provided materials showing how their trading name was conceived just over a year ago and the manner in which it has been deployed in the Somerset area, in respect of both vehicle livery and promotional flyers. The Expert has also reviewed the Complainants' current website at [www.backwell-logs.uk](http://www.backwell-logs.uk) (see paragraph 18.1 of the Policy, in terms of which an expert may (in their entire discretion) check any material which is generally available in the public domain). In total, the materials presented by the Complainants are broadly supportive of their case that the trading name has been in active use for approximately a year and is being used to advertise their sustainable wood business to the purchasing public in the Bristol and Somerset areas. While the Expert would have preferred to have seen more extensive evidence, it is the Expert's opinion that what has been produced is just sufficient to support the Complainants' claim to an unregistered trade mark in the trading name "Backwell Logs".

Even if the Expert had not been satisfied that the Complainants had showed sufficient evidence regarding the term "Backwell Logs", the materials before the Expert (particularly the website screenshots produced by the Respondent, which the Complainant indicates come from its old website) are substantially supportive of the notion that the Complainants have used the term "Backwell" in the course of trade, together with other terms, for a longer period and to a greater degree than they have used the current trading name. This term is the primary element of the partnership name "Backwell Wood Estate" and has clearly been abbreviated to "Backwell Woods" on the website in connection with the sale and supply of sustainable wood fuel. Accordingly, the public in the area where the Parties' businesses trade would be likely to associate the name "Backwell Logs" with the Complainants' businesses at the very least in a descriptive sense, in other words, that this name denotes logs supplied from the Complainants' Backwell Wood Estate.

By contrast, the Respondent claims that the Complainants are not trading as Backwell Logs in any respect, making reference to the website at [www.backwellwoods.org.uk](http://www.backwellwoods.org.uk). However, the Expert is satisfied first, that this is an older website predating the rebranding evidenced in the Complainants' late 2015 emails and, secondly, that in any event the Respondent's argument on this topic is defeated by the fact that the Complainants are in a position to show Rights in the term "Backwell" alone, which is entirely sufficient for present purposes.

Turning to a comparison between the unregistered marks "Backwell Logs" and "Backwell" and the Domain Name, the Expert notes that the unregistered mark "Backwell Logs" is almost alphanumerically identical to the third level of the Domain Name, the first (.uk) and second (.co) levels typically being disregarded as being required for technical reasons only. The principal difference is the presence of a hyphen in the Domain Name. This is of no consequence as white space is not permitted in domain names and hyphens are typically used as a substitute in order

to separate encapsulated words. The mark "Backwell" is likewise similar to the Domain Name as it is repeated in its entirety at the beginning of the Domain Name and the generic term "logs" has simply been added to that mark with the hyphen separator. That term does not serve to distinguish the mark from the Domain Name as, in the Expert's opinion, the primary focus of the Domain Name is on the distinctive "Backwell" element and not the more generic "logs" qualifier.

In all of these circumstances, the Expert finds that the Complainants have proved on the balance of probabilities that they have Rights in the names or marks "Backwell Logs" and "Backwell" and that such marks are similar to the Domain Name.

### **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. is being or 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 5.1 of the Policy which provides a non-exhaustive list of factors which may be evidence that the Domain Name is an Abusive Registration. Paragraph 8.1 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, first, that the Respondent registered the Domain Name primarily for the purpose of selling it to the Complainant for valuable consideration in excess of the Respondent's documented out-of-pocket costs; and secondly, that the Respondent is using or threatening to use the Domain Name in a way which is likely to confuse people or businesses into believing that it is registered to, operated or authorised by or otherwise connected with the Complainant. These submissions are based upon paragraphs 5.1.1.1 and 5.1.2 of the Policy respectively.

Taking the issue of confusion first, the Complainants assert, and the Respondent does not deny, that the Respondent operates a business in the Somerset area in competition with that of the Complainants and that, when it was first discovered by the Complainants, the Domain Name was pointing to the Respondent's business website. The Respondent reinforces this in the Response where he notes that he owns most log website addresses in North Somerset to help his sales. The Respondent says that this is not a 'crime'. However, if a domain name which the Respondent selects for his portfolio of log website addresses is similar to the name of a rival business such activity can fall foul of paragraph 5.1.2 of the Policy in that the domain name concerned may be likely to confuse people or businesses into believing that it is registered to, operated or authorised by, or otherwise connected with, the rival business, in this case the Complainant's business. In present circumstances, this is a possible basis for a finding of Abusive Registration.



Such confusion as the Respondent may have caused originally through use of the Domain Name will have continued upon his placing of the Domain Name with Sedo with a view to offering it for sale. It is evident from the screenshot produced by the Complainants that the Sedo page also featured pay per click advertising and, while this related to furniture rather than sustainable fuel, such that confusion might have been dispelled upon arrival at the website, the association of the Complainants' trading name with the Domain Name is nevertheless likely to have caused initial interest confusion. Paraphrasing the Experts' Overview Version 2, this is defined as the speculative visitor to the registrant's website visiting it in the hope and expectation that the website is operated or otherwise connected with the complainant, the vice being that even if it is immediately apparent to such visitor that the site is not in any way connected with the complainant, the visitor has been deceived; the visitor may well be faced with a commercial website which may or may not advertise goods or services similar to those produced by the complainant. Initial interest confusion is regarded by the majority of experts as a possible basis for a finding of Abusive Registration. Accordingly, while paragraph 8.5 of the Policy indicates that connecting domain names to parking pages and earning click-per-view revenue is not of itself objectionable under the Policy, in the present case the Expert regards the nature of the Domain Name, being a close variant of the lead Complainant's business name and domain name, as being objectionable due to the confusion (including initial interest confusion) which is likely to result.

At some point in the recent past, the Respondent has offered the Domain Name for sale at a price of £10,000. The Respondent says that the Complainants have been invited to purchase it, presumably by the Respondent or others on the Respondent's behalf. It is not possible for the Expert to determine with any certainty whether the Respondent's clearly expressed intention to offer the Domain Name for sale to the Complainants was the Respondent's primary purpose for its registration (see paragraph 5.1.1 and 5.1.1.1 of the Policy) but nevertheless, even if this followed upon an intent to divert traffic from the Complainants' business to the Respondent's website, it is certainly an indicator of Abusive Registration. The Respondent is unable to explain why he chose to offer this Domain Name for sale to the Complainants or why it would attract such a price (other than through its connection to the Backwell name or mark) and it appears to the Expert to be more than a coincidence that it was selected and registered by the Respondent after the Complainant adopted its domain name backwell-logs.uk, adopted a new livery and issued relative promotional flyers, particularly as the Domain Name differs from the Complainants' recently adopted domain name in only one respect, namely by being a third level domain name (the backwell-logs element falls under the .co.uk second and top level domains rather than directly under the top level domain .uk, as does the Complainants' domain name).

There remains a possibility, which should not be overlooked, that the primary intent of the Respondent may have been simply to disrupt the Complainants' business unfairly (see paragraph 5.1.1.3 of the Policy). Such disruption would inevitably occur by the use of the Domain Name as described by the Complainants and would also in the Expert's view be unfairly detrimental to the Complainants' Rights. Again, this is an indicator of Abusive Registration.

Turning to the Respondent's submissions in the Response, the Respondent first notes that the Domain Name was available to register on the Internet. This, in and of itself, is not a defence to a Complaint under the Policy. The Respondent appears to

be relying upon the principle that domain name registrations are typically permitted on a first-come-first-served basis. He extrapolates that the Domain Name's registration must be an acceptable activity because he was the first to register it, an act which he describes as "not a crime". However, while this first-come-first-served principle does apply in the case of domain name registrations, it is limited or qualified by the application of the Policy, to which the Respondent submitted as part of the registration process. Accordingly, this submission does not demonstrate that the Domain Name is not an Abusive Registration. Likewise, the Respondent's submission asserting that a third party business has registered a domain name corresponding to the Respondent's business name does not entitle the Respondent to do likewise by adopting the name of a competing business as his own.

The Respondent's final point is that the Complainants do not refer to themselves as "Backwell Logs". As noted above, this submission has been fully addressed in the Complainants' Reply in which the Complainants point out that the Respondent has produced a copy of their original website. The Complainants' new website at [www.backwell-logs.uk](http://www.backwell-logs.uk) was operating to promote the Complainants' business as at the date of the Expert's review of the case papers and indeed the domain name from the Complainants' former website now points traffic there. Furthermore, as also discussed earlier, in the Expert's opinion, it is the "Backwell" element of the Backwell Wood Estate partnership's name which is most likely to lead to people and businesses being confused by the Respondent's use of the Domain Name rather than whether the Complainants necessarily refer to themselves as "Backwell Logs".

Turning to consider the non-exhaustive factors in paragraph 8 of the Policy, whereby the Respondent might have demonstrated that the Domain Name is not an Abusive Registration, there is nothing before the Expert indicating that the Respondent has used or made demonstrable preparations to use the Domain Name in connection with a genuine offering of goods and services. The use of the Domain Name to drive traffic either to the Respondent's commercial website or to the Sedo platform, while in each case giving rise to an offering of goods or services, could in no way be described as genuine given the similarity of the Domain Name to the Complainants' business and trading names and the confusion likely to be caused to consumers. There is nothing before the Expert indicating that the Respondent has been commonly known by the name in the Domain Name or legitimately connected with an identical or similar mark, nor is there evidence that the Respondent has made legitimate non-commercial or fair use thereof. Finally, the Respondent has not asserted that the Domain Name is generic or descriptive.

In all of the above circumstances, the Expert is satisfied that the Complainants have proved on the balance of probabilities that the Domain Name, in the hands of the Respondent, is an Abusive Registration.

## **8. Decision**

The Expert finds that the Complainants have proved that they have Rights in a name or mark which is similar to the Domain Name and that the Domain Name, in the hands of the Respondent, is an Abusive Registration. The Expert therefore directs

that the Domain Name be transferred to the joint Complainant, Bellwind-Edis Limited.

**Signed** .....

**Andrew D S Lothian**

**Dated** 8 December, 2016 .....