

DISPUTE RESOLUTION SERVICE

D00017997

Decision of Independent Expert

English Heritage Buildings LLP

and

EH Roofing Ltd

1. The Parties:

Lead Complainant: English Heritage Buildings LLP
Coldharbour Farm Estate
Dallington
Heathfiled
East Sussex
TN21 9LQ
United Kingdom

Respondent: EH Roofing Ltd
8 Moor Hill
Hawkhurst;Cranbrook
KEN
TN18 4PE
United Kingdom

2. The Domain Name(s):

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

The procedural history is as follows:

22 September 2016 09:26 Dispute received
27 September 2016 14:40 Complaint validated
27 September 2016 14:45 Notification of complaint sent to parties
14 October 2016 02:30 Response reminder sent
18 October 2016 11:38 Response received
18 October 2016 11:38 Notification of response sent to parties
21 October 2016 02:30 Reply reminder sent
24 October 2016 17:34 Reply received
24 October 2016 17:34 Notification of reply sent to parties
08 November 2016 15:22 Mediator appointed
08 November 2016 15:22 Mediation started
16 January 2017 16:25 Mediation failed
16 January 2017 16:26 Close of mediation documents sent
18 January 2017 10:56 Expert decision payment received

4. Factual Background

The Complainant builds and supplies “oak framed” buildings. The Complainant has traded under the name “English Heritage Buildings” since its incorporation in 2011.

The following trade marks are registered in the name of “English Heritage Building Limited”:

- UK trade mark no. 2106880 comprising a device incorporating the stylised words “ENGLISH HERITAGE BUILDING products”, filed on 3 August 1996.
- EU trade mark no. 2984631 comprising a device incorporating the stylised words “ENGLISH HERITAGE BUILDINGS”, filed on 11 February 2003.

The Respondent was incorporated in May 2015.

The Respondent registered the Domain Name on 5 August 2015 and has used it a website promoting its roof contracting services under the trading name “English Heritage Roofing”.

5. Parties' Contentions

Complaint

A summary of the Complaint is as follows:

The Complainant owns registered trade marks for "English Heritage Buildings" in Canada, Hong Kong, Norway, Switzerland, China and Japan.

The Complainant has been trading under the name "English Heritage Buildings" since 2002 and has established substantial goodwill therein.

The annual sales "for English Heritage Buildings" were approximately £2,730,590.00 for the year ending March 2016. The 2016 advertising budget was £370,720.00.

The Domain Name in the hands of the Respondent is abusive.

It was primarily registered to confuse internet users. It was inevitable that there would be a high likelihood of confusion between the Respondent and the Complainant, as shown by the Respondent's website. The Respondent has included an image of a "Traditional oak framed barn Sandhurst, Kent" on its webpage, which is similar to images used on the Complainant's website.

The Domain Name took unfair advantage of and/or was unfairly detrimental to the Complainant's rights as at the time of registration or acquisition of the Domain Name.

The Respondent had knowledge of the Complainant's substantial goodwill and intended to confuse the public.

The Respondent has placed advertisements in local newspapers. While it did not use the Domain Name, the Respondent has used an email address including the term "ehoakandbuilding". It is reasonably foreseeable that the public would be confused by the combined advertisement and email address.

The Respondent's website appears on the first page of Google for searches against "English Heritage Roofing", whereas the Complainant appears on the second page.

For the above reasons, the Domain Name is detrimental to the Complainant's business.

Response

The Response consists of an email from the Respondent (see further below), the operative part of which is as follows:

“I cannot see how my domain can be complained about, why didn't they purchase this domain when was available?

Also how can it be confused with building?- its EnglishHeritageROOFING under trading name of EH Roofing Ltd

What is there website address is it anything near mine? or is it EHBP.com?

When my website is accessed it has pictures of roofs I have completed not anything like they do.

Oak framers all advertise 'English oak' as there product to be used is that not more like them rather than roof tiles?

I think the complaint is a bit far fetched and would like to carry on with my business proceedings without hassle of people with nothing better to do, I don't go around moaning about other roofers saying to similar to me- I don't have the time.

So please close this case, or if they want the domain from me they can make me a offer to purchase?”

Reply

In its Reply the Complainant made the following observations:

It was not possible for the Complainant to purchase and/or register every variant of its registered trade mark as a domain name.

There is a very high probability of a likelihood of confusion resulting from the Respondent's use of the Domain Name.

While the Respondent asserts that its website includes pictures of roofs and that it has not “completed anything like the Complainant”, nonetheless there are highly similar images portrayed on both the Respondent's and the Complainant's website.

The registration and use of the Domain Name is an attempt by the Respondent to divert business from the Complainant. The Respondent has deliberately chosen a logo which is similar to that of the Complainant.

6. Procedural Issues

The “Response” is in the form of an email to Nominet which did not comply with various formal requirements specified in paragraph 7.3 of the DRS Policy, including the requirement for a “Statement of Truth”.

According to the case record, Nominet emailed a copy of the Complaint to the Respondent because the Respondent had been unable to access the relevant Nominet online account and the Respondent replied with an email setting out its response.

Paragraph 24.8 of the DRS Policy states that if, in the absence of exceptional circumstances, a party does not comply with the procedure, the expert will draw such inferences from the party's non-compliance as he or she considers appropriate. Paragraph 24.3 states: “The Expert shall determine the admissibility, relevance, materiality and weight of the evidence.”

I will treat the email as a formal Response but I will bear in mind the lack of a Statement of Truth insofar as it is necessary for me to consider the veracity of the matters asserted in the email.

7. 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 defined in the 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”

The Complainant relies on the UK and EU trade marks mentioned above. However, these are registered in the name of “English Heritage Building Limited”, whereas the Complainant is called “English Heritage Buildings LLP”. The address of the proprietor of the trade marks is the same as that given for the Complainant.

The Complaint lists (and provides company details for) three companies, including the Complainant, saying that the three companies were registered by the Complainant - presumably meaning simply that these three companies are all part of the same corporate group. But neither the current nor the former names of these companies (all LLPs) equate to the name of the registered proprietor of the trade marks.

Paragraph 5.10 of the Expert Overview on Nominet's website envisages that in certain circumstances Experts may find it expedient to conduct simple online enquiries of a publicly available database and, accordingly, I have checked the Companies House website. This indicates that there is currently no company in existence called "English Heritage Building Limited"; instead, this is the former name of at least three different companies, none of which were included in those listed in the Complaint but all nonetheless have the same address as the Complainant.

Paragraph 2.2 of the Expert Overview says that, in the case of a licensee of a registered trade mark, the relevant licence, if asserted, will ordinarily be assumed if the Complainant can demonstrate that it is a subsidiary or associated company of the registered proprietor. But here, the Complainant has not even asserted the existence of a licence, let alone established its relationship with whichever entity is the registered proprietor of the mark. The Complaint simply assumes, wrongly, that the Complainant is itself the registered proprietor.

It was the responsibility of the Complainant to include as co-complainants any entities which owned any trade mark rights asserted in the Complaint – or at least to clearly explain any group connection in the case of an alleged licence. It has failed to do so and there is only so far that I can go in drawing inferences in the Complainant's favour, particularly given that there is apparently no English company whose current name matches the name of the registered proprietor of the two registered trade marks.

Accordingly, I have decided to disregard those two registered trade marks as well as the alleged registered trade marks in other countries, which the Complainant mentions but only in passing and without supporting evidence.

That leaves the question of unregistered trade mark rights.

Here too, the Complaint is unsatisfactory. For example, the Complainant relies on alleged turnover of some £2.7 million for the year ending March 2016, yet there is no documentary proof.

However, the Complainant has at least provided a very detailed brochure branded "English Heritage Buildings" which bears the Complainant's corporate name, indicating that it is the main trading company of the group.

In view of this, and given that Rights is a low threshold test and that the Respondent has not objected to the Complainant's claim to have traded under the name "English Heritage Buildings", I concluded that the Complainant has, narrowly, established unregistered Rights in that term.

While the Respondent rejects any likelihood of confusion on the grounds that the Complainant's name is "English Heritage Building" whereas the Respondent's name is "English Heritage Roofing", the only issue at this point of the discussion is whether Complainant's mark can be said to be "similar" to the Domain Name. In my view, it can. Both terms are dominated by the words "English Heritage"; the only distinction is that the Domain Name replaces the descriptive term "building" with another, not unrelated, descriptive term "roofing". Overall I consider that the trade mark and Domain Name remain similar.

The Complainant has established rights in a name or mark which is similar to the Domain Name.

Abusive Registration

Does the Domain Name constitute 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."*

Paragraph 5.1.2 of the Policy identifies the following as one of the non-exhaustive factors which may be evidence that a domain name is an abusive registration:

"[c]ircumstances 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 Complainant draws attention to an image of traditional oak-framed barn on the Respondent's website, which is said to be similar to the images used on the Complainant's website. It is true that the Respondent's website includes images of oak framed buildings but that of itself is hardly incriminating given that the Respondent is a roofing contractor. The Respondent appears to say that the images on its website are of buildings it has actually worked on although it then muddies the water somewhat by saying that the roofs it has completed are "not anything like they do".

In any case, more significant in my view is the fact that the Respondent has used a logo on its website and advertising which is strikingly similar to that of the Complainant, in that both are dominated by a large “H” whose horizontal line is replaced with a green leaf. I have reproduced them below:

Complainant’s logo:



Respondent’s logo.



Furthermore, the Complainant has also produced evidence of a local newspaper advertisement by the Respondent which is branded with the Respondent’s above logo plus the term “English Heritage Oak and Building” and which offers general building services, not just roofing. Furthermore, the first bullet point listed is “[t]raditional oak framed barns”. Given that the Respondent is here using a name which is even closer to the Complainant’s name as well as its similar “H” logo and, given that the advertising highlights oak framing, the Complainant’s specialist field, it is difficult to see this advertising as anything other than an attempt to target the Complainant’s trade mark and as further evidence of an intent to take unfair advantage of the Complainant’s mark, albeit that it does not specifically mention the Domain Name.

In view of the above, and also the fact that the Respondent has not denied knowledge of the Complainant, I conclude that the Respondent has used the Domain Name in a way which is likely to cause confusion with the Complainant in accordance with paragraph 5.1.2 of the Policy.

The Respondent asserts that the Complainant could itself have previously bought the Domain Name when available but, even if so, it is a matter for the Complainant whether or not to register a domain name comprising any particular version of its name. Its failure to register the Domain Name for whatever reason does not justify the Respondent doing so in the circumstances of this case.

Nor does it assist the Respondent that the Complainant's own website is located at www.ehbp.com, i.e. at a domain name does not include the full version of the Complainant's name. It is nonetheless not disputed by the Respondent that the Complainant is indeed trading under the name "English Heritage Buildings".

8. Decision

I find that the Complainant has Rights in a mark which is similar 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 englishheritageroofing.co.uk be transferred to the Complainant.

Signed: Adam Taylor

Dated: 16 February 2017