

DISPUTE RESOLUTION SERVICE

D00021171

Decision of Independent Expert

R. M Williams Pty Ltd

and

iSurveyor

1. The Parties:

Complainant: R. M. Williams Pty Ltd
121 Frost Road
Salisbury
South Australia
5108
Australia

Respondent: iSurveyor
7 West Close
Farnham
GU9 0RF
United Kingdom

2. The Domain Name(s):

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

04 March 2019 09:29 Dispute received
04 March 2019 11:59 Complaint validated
04 March 2019 12:07 Notification of complaint sent to parties
19 March 2019 13:49 Response received
19 March 2019 13:50 Notification of response sent to parties
22 March 2019 01:30 Reply reminder sent
25 March 2019 15:09 Reply received
25 March 2019 15:09 Notification of reply sent to parties
25 March 2019 15:13 Mediator appointed
27 March 2019 09:48 Mediation started
28 March 2019 15:43 Mediation failed
28 March 2019 15:45 Close of mediation documents sent
09 April 2019 02:30 Complainant full fee reminder sent
09 April 2019 12:37 Expert decision payment received

4. Factual Background

The following are the facts and matters that I find proved by the documents produced by the parties and which form the basis for my Decision in this matter:

- i. The Complainant's predecessor in business was established in Australia in 1932 while the Complainant itself was incorporated in 1948.
- ii. The Complainant's business is that of manufacturing and selling clothing and footwear with an outdoor theme.
- iii. While the Complainant is based in Australia, it trades through its website www.rmwilliams.com.au and ships its merchandise around the world, including to the UK.
- iv. The Complainant also sells its merchandise by means of three retail stores in London as well as through a large number of other retail outlets located in the UK.
- v. The Complainant owns or has owned a number of trade marks including a UK Device mark incorporating the name "R. M. Williams" (see Annexure C to the Complaint, which states that its renewal date was 12 May 2015 and that its current status is "Dead") and also EU trade marks for "R M. WILLIAMS", "R. M. WILLIAMS EST. 1932. AUSTRALIA" and "R. M. R. M. WILLIAMS" (see Annexure K to the Complaint).
- vi. The Complainant was the original owner of the Domain Name, which it registered in 1999, but it accidentally allowed the registration to lapse in

- 2017 because of the departure from its employment of the individual charged with the renewal of the registration.
- vii. The Respondent, while a company, is represented by one Mr Jonathan Gregory, who describes himself as a “part time dropcatcher” who regularly reviews domain names which have lapsed for any reason and who is then able to register them in his own name.
 - viii. The Respondent registered the Domain Name using an automated system and has since then received various offers from third parties for the purchase of it.
 - ix. The Complainant decided in 2018 to commence use of the Domain Name for the purpose of setting up an online shop, and only then discovered the failure to secure a renewal of the registration in 2017.
 - x. The Complainant has communicated with the Respondent in an attempt to purchase the Domain Name from him, but he originally requested £45,000 plus fees/costs, subsequently reducing his offer to £40,000, whereas the highest offer from the Complainant was £10,000 (made on 23 January 2019).
 - xi. The Respondent has used the website at the Domain Name as a holding page which simply indicates that it is for sale and invites potential purchasers to provide their details so that the Respondent could conduct negotiations with that potential purchaser.

5. Parties’ Contentions

The Complainant makes the following submissions:

- i. Its business of making and selling clothing with an outdoor theme was established in 1932 in Australia but it has since become a global business exporting to 56 countries including the UK, where it has three retail outlets in London as well as other outlets in other stores around the UK.
- ii. It has registered UK and EU trade marks and owns a UK subsidiary.
- iii. It was the original owner of the Domain Name, which it registered in 1999 and used for the purpose of its business, before its registration lapsed in 2017 as a result of the employee responsible for renewal leaving the Complainant’s employment.
- iv. It became aware of this when it decided to renew its selling activities using the Domain Name, but found that it had been registered by the Respondent.
- v. It has negotiated with the Respondent, offering £5,000, but the Respondent has counter-offered £40,000.
- vi. The Complainant is the only person with a legitimate interest in operating a website using the Domain Name.
- vii. The Domain Name is confusingly similar to the Complainant’s trade marks.
- viii. The Respondent registration of the Domain Name is abusive because
 - a. The Respondent has no legitimate right to it;
 - b. The Respondent has no licence from the Complainant to use it;

- c. The Respondent is not commonly known by the Domain Name and indeed makes no use of it and is not making any preparations to use it;
- d. The Complainant has never supplied its merchandise to the Respondent;
- e. The Domain Name is an exact match for the Complainant's Rights and the Respondent has no reasonable justification for acquiring the Domain Name;
- f. The Respondent acquired the Domain Name
 - i. primarily for the purpose of selling it to the Complainant at a price greater than the costs of its registration; and
 - ii. in order to stop the Complainant registering it;
- g. The Respondent's use of the Domain Name would be likely to confuse people or businesses into believing that it is somehow authorised by or connected with the Complainant.
- ix. There is no logical explanation for why the Respondent has acquired the Domain Name and it apparently has no need to use it legitimately.

The Respondent makes the following submissions:

- i. He is engaged part-time in reviewing and registering domain names whose registrations have lapsed for any reason.
- ii. When reviewing possible domain names for purchase, he can review thousands in a day, but he has no knowledge of the ownership of the domain name or why it expired: it was on this basis that he registered the Domain Name.
- iii. After registering it, he was contacted by interested purchasers, who gave no background as to their interest in the Domain Name.
- iv. In this way, the Complainant appears to have offered first £5,000 and then £10,000, whereas the Respondent counter-offered with £45,000, which he reduced to £40,000.
- v. At that time, the Respondent had no knowledge of who he was dealing with, as it could have been an accounting firm in Romford called RM Williams or a building company in Wales called R and M Williams.
- vi. The Complainant is therefore not the only person with a legitimate interest in the Domain Name.
- vii. Moreover, the Domain Name has only resolved to a holding page and has never been used for the sale of products or services and has never carried any advertising.
- viii. In fact, the Complainant's reputation in the UK is slender and is more in the nature of a niche brand.
- ix. The UK trade mark registration in Annexure C to the Complaint is "Dead", while the trade marks in Annexure K shows that trade mark protection was partially refused, albeit that the Complainant is able to show trade mark rights.

- x. The Respondent registered the Domain Name lawfully and has at no time threatened to use the Domain Name so as to impact negatively the Complainant or offered to sell it to a competitor of the Complainant.
- xi. It is possible that the Complainant deliberately allowed the registration in the Domain Name to lapse as they had no use for it.
- xii. The Complainant is not the only business with a name similar to or identical with the Domain Name.
- xiii. The Respondent has simply acquired the Domain Name and used it as a holding page inviting offers for it, none of which is unfairly detrimental to the Complainant.
- xiv. The Complainant's activities amount to reverse domain name hijacking:
 - a. The Complainant had no intention of using the Domain Name until some months after the Respondent had lawfully registered it;
 - b. The Complainant has raised this Complaint in the course of negotiations; and
 - c. The Complainant has failed to disclose some relevant information as it has hidden behind NovelBrands.org to conduct negotiations.

The Complainant replies with the following submissions:

- i. The Respondent says that he is a part-time "dropcatcher" but the Domain Name is registered to a company called "iSurveyor" and there is no evidence that the Respondent has owned thousands of domain names.
- ii. Offering to sell a domain name for well above its costs of registration is evidence of bad faith.
- iii. The correspondence shows that the Domain Name was acquired for the purpose of selling it at a profit.
- iv. It is not necessary for the Complainant to show that it is the only party with Rights similar to the Domain Name.
- v. The Complainant's brand is not a niche brand in the UK.
- vi. The Complainant allowed the UK trade mark at Annexure C to the Complaint to lapse but has other Rights as shown by Annexure K to the Complaint.
- vii. There is no bad faith on the Complainant's part and there is no case of reverse domain name hijacking: the Complainant unsuccessfully tried to negotiate a deal with the Respondent.
- viii. The offer of £10,000 was made in an attempt to avert this Complaint.

6. Discussion and Findings

Rights

The Complainant must show that it has Rights, which are defined 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"*.

The Complainant has included a UK trade mark at Annexure C to the Complaint, which the Respondent rightly observes has lapsed and I take no account of it.

However, the Complainant has also included a number of EU trade marks at Annexure K to the Complainant and, while the Respondent has pointed out some limitations in the grant of those rights, there is no doubt that the Complainant has acquired trade marks rights in “R. M. WILLIAMS” as well as in other similar formulations of the name. I have no doubt that the Complainant has Rights for the purposes of the DRS Policy.

Those Rights must, by virtue of paragraph 2.1 of the DRS Policy, be *“in respect of a name or mark which is identical or similar to the Domain Name”*. I discount the .co.uk suffix and, while noting that the Domain Name does not have the full stops in the Complainant’s trade marks, conclude that the Rights are sufficiently similar to the Domain Name for the purposes of the DRS Policy.

Abusive Registration

The Complainant must then show that the Domain Name is an Abusive Registration in the Respondent’s hands. The DRS Policy defines an 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”*

Paragraph 5.1 of the DRS Policy sets out a non-exhaustive list of factors which may be evidence that the Domain Name is an Abusive Registration. While the Complainant could be said to have cast the net fairly wide, I can deal fairly quickly with some of the individual sub-paragraphs of paragraph 5.1:

- i. paragraph 5.1.2: I accept the Respondent’s evidence and assertions that it has not used and is not threatening to use the Domain Name in any way that might confuse people or businesses. It is being used to host a holding page which invites interested persons to submit their details so as to make an offer to purchase the Domain Name. I do not consider that anyone would be confused by this into thinking that the Domain Name was in some way connected with or authorised by the Complainant.
- ii. Paragraph 5.1.3: there is no evidence of any pattern of original registrations and the Complainant has not alleged this, although it is fair to say that Mr Jonathan Gregory, for the Respondent, describes himself as a “part time dropcatcher”, but neither party has provided evidence of patterns of registrations for the purposes of this paragraph.
- iii. Paragraph 5.1.4: there is no evidence to support this paragraph and the Complainant has not alleged this.
- iv. Paragraph 5.1.5: neither party has suggested any pre-existing relationship between the parties.

I remind myself of the terms of paragraph 5.2, to the effect that simply failing to use the Domain Name for email or a web site is not of itself evidence of Abusive Registration. This is relevant as I accept the Respondent's assertions that no use has been made of the Domain Name, either for selling products or services or for hosting advertising. I therefore will not conclude without more that the Domain Name is an Abusive Registration just because it has not been used.

At the same time, I remind myself of the terms of paragraph 8.4 of the DRS Policy, which states that trading in domain names for profit is a lawful activity and that I must review each case on its merits. This is important: I must apply the DRS Policy against the facts of this particular case and not approach it with a mindset that dealing in domain names is indicative that this particular Domain Name is an Abusive Registration.

Having considered and, for the most part, discounted the relevance of paragraph 5.1, this leaves paragraph 5.1.1, which provides, insofar as is relevant,

"5.1.1 Circumstances indicating that the Respondent has registered ... the Domain Name primarily:

5.1.1.1 for the purpose of selling ... the Domain Name to the Complainant ... for a valuable consideration in excess of the Respondent's documented out-of-pocket costs directly associated with acquiring or using the Domain Name;

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

5.1.1.3 for the purpose of unfairly disrupting the business of the Complainant;"

Let me consider this paragraph, and also paragraph 5.1.6, against what has actually happened in this case. For completeness, paragraph 5.1.6 provides,

"The Domain Name is an exact match (within the limitations of the character set permissible in domain names) for the name or mark in which the Complainant has Rights, the Complainant's mark has a reputation and the Respondent has no reasonable justification for having registered the Domain Name."

I accept that the Complainant let its registration in the Domain Name lapse inadvertently: given that the Domain Name is so nearly identical to the Rights owned by the Complainant, and noting the departure of the relevant employee from the Complainant at about the same time, I accept that the failure to renew the Domain Name's registration was an accident on the Complainant's part which it was unlikely to pick up until it decided to use the Domain Name some months later.

By that time, of course, the Respondent had registered it himself. I accept that his registration was in one sense lawful, although I have to consider whether it still amounts to an Abusive Registration under the DRS Policy. The Respondent is technically a limited company, but the Response is written in the first person by one Mr Jonathan Gregory, whom I take to be a director of the Respondent. He describes himself as a “part time dropcatcher” and gives some background to this activity: he peruses, as he puts it, sometimes thousands of lapsed domain names on a spreadsheet looking for domain names he can then register in his own name. While he does not expressly say so as such, he is on the balance of probabilities going to be selective in choosing which out of the thousands of lapsed domain names he is going to re-register. There would, after all, be no point in registering a domain name which had no value to him.

I turn to the question of the value of the Domain Name to the Respondent: I accept from the Respondent that he has not used the Domain Name for the purpose of advertising or for selling products or services, whether competitive with the Complainant’s or otherwise. All he has ever done is try to sell the Domain Name by having a holding page inviting interested persons to provide their details so that agreement could be reached on the price. Indeed, the Respondent has indicated that the Domain Name has attracted some interest from potential purchasers, allowing for the fact that the Respondent would not necessarily be able to verify those purchasers’ identities, meaning that some of those purchasers were perhaps the same people.

It seems to be clear to me, on the balance of probabilities, that the Respondent’s registration of the Domain Name was opportunistic, in that part of his way of earning a living is to find useful domain names which he knows he will be able to sell for a profit. While he claims not to have knowledge of the Complainant as a business at the time of registering the Domain Name, I find that to be improbable. Without some awareness that the Complainant existed, the Domain Name would be of little use to the Respondent and he would have been unlikely to choose to register it. I accept that the name is not unique to the Complainant: indeed, it sounds like an ordinary name in common usage among English speaking people. It must have struck the Respondent that he would be able to register the Domain Name and then sell it to the Complainant, or perhaps to one of the two other businesses that he names, for a profit.

I then turn to the precise terms of paragraphs 5.1.1 and 5.1.6, noting that these are part of a non-exhaustive list of factors evidencing Abusive Registration, not the precise words of a statute or regulation which have to be applied literally.

I have no doubt that the Respondent registered the Domain Name for the purpose of selling it to a similarly named business. Of course, the precise identity of the business might have been the Complainant in this Complaint, or another business going by the name of R M Williams or something similar (such as R and M Williams, which the Respondent says is a substantial building firm in Wales). That is beside the point: the Respondent registered the Domain Name for the purpose of making a profit by

selling it to one of a few specific businesses. Of the three businesses mentioned, it appears that the Complainant is by far the biggest and therefore the most likely candidate for a profitable sale looking at it on the balance of probabilities. From the emails the parties have provided, I take it that a price of £40,000 or £45,000 would show a healthy profit on the costs of registration and of using the Domain Name with a holding page advertising that it is for sale. Indeed, the Respondent has not documented any expenses in registering or using the Domain Name, but they could not have been anything like £40,000.

However, I do not find a case made out under paragraph 5.1.1.2. As the Respondent observes, he had no idea why the owner of the Domain Name would let it lapse and it could well be that it was a deliberate act. For this reason, it is not possible to say that the Respondent registered the Domain Name as a blocking registration, since he did not know that the Complainant would want to register it again.

As to paragraph 5.1.1.3, there is no evidence that there is any sort of use at all which would disrupt the Complainant's business, whether unfairly or otherwise.

Turning to paragraph 5.1.6, I note that the Domain Name is an exact match with the Complainant's Rights, with the exception of the full stops, which are not possible with domain names. I accept that the Complainant's mark has a reputation: I do not read the paragraph as requiring that the Complainant's mark should be the only reputation, or that it should be a substantial reputation similar to the national presence of B&Q, which the Respondent compares the Complainant to adversely. I also find that the Respondent has no reasonable justification for registering the Domain Name and, indeed, his doing so was opportunistic and done with the aim of earning a profit from it from a business with the same or similar name, most probably the Complainant seen on the balance of probabilities.

I now turn to paragraph 8 of the DRS Policy, which sets out a non-exhaustive list of factors which may be evidence that the Domain Name is not an Abusive Registration. Looking at those factors, again taking into account that they are non-exhaustive and not intended to be applied literally like a statute or regulation:

- i. Paragraph 8.1.1: I accept that the Respondent has not used the Domain Name at all save for having a holding page advertising that it is for sale. I can see no reason why the Respondent, known as iSurveyor and whose director is called Jonathan Gregory, should be interested in registering the Domain Name other than for the purpose of selling it at a profit, which is what the Respondent has tried to do ever since registering it.
- ii. Paragraph 8.1.2: while the name R M Williams could be a common English (or Welsh) name, I do not think the Respondent is making any use of it at all, whether fair or unfair.
- iii. Paragraph 8.1.3: there is no evidence of a prior agreement between the parties and the Respondent has not alleged that.

- iv. Paragraph 8.1.4: the Respondent has admitted that he is a “dropcatcher” i.e. someone who registers lapsed domain names in his own name, but he is not otherwise within the wording of this paragraph.

The other paragraphs, apart from paragraph 8.4, do not appear to be relevant. The Respondent is not selling traffic or advertising so as to bring himself with paragraph 8.5. Again, I remind myself that trading in domain names for profit is not of itself objectionable.

My conclusion is that the Respondent registered the Domain Name deliberately with the intent of selling it for a profit, most probably to the Complainant, and without having a legitimate justification for doing so whether under the strict words of paragraph 8 or otherwise.

My conclusion is that the Domain name is an Abusive Registration in the Respondent’s hands.

7. Decision

I therefore decide that the Complainant has Rights in a mark similar to the Domain Name and that the Domain Name in the Respondent’s hands is an Abusive Registration.

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

Signed: Richard Stephens

Dated: 9 May 2019