

DISPUTE RESOLUTION SERVICE

D00021280

Decision of Independent Expert

Glasseco Holdings LLC

and

Mick Pickup

1. The Parties:

Complainant: Glasseco Holdings LLC
Southpac Trust Nevis Limited, Hunkins Plaza
Charlestown
Nevis
Saint Kitts and Nevis

Respondent: Mick Pickup
Aneal Business Centre
Cross Green Approach
Leeds
West Yorkshire
LS9 0SG
United Kingdom

2. The Domain Name:

urbnrok.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 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.

03 April 2019 14:02 Dispute received
03 April 2019 14:55 Complaint validated
03 April 2019 15:41 Notification of complaint sent to parties
24 April 2019 02:30 Response reminder sent
26 April 2019 10:42 Response received
26 April 2019 10:42 Notification of response sent to parties
02 May 2019 02:30 Reply reminder sent
07 May 2019 10:11 No reply received
07 May 2019 10:11 Mediator appointed
08 May 2019 16:39 Mediation started
14 June 2019 16:42 Mediation failed
14 June 2019 16:42 Close of mediation documents sent
26 June 2019 02:30 Complainant full fee reminder sent
03 July 2019 13:53 No expert decision payment received
04 July 2019 09:21 Expert decision payment received

4. Factual Background

The Complainant is the owner of the trade mark URBNROK registered, inter alia, in the UK since 2011 in relation to recycled glass surfaces, and the accompanying common law rights due to eight years' use by the Complainant and its predecessors in title.

The Domain Name registered in January 2017 was assigned to the Complainant in March 2017, but the Nominet register was not updated. It was in September 2018 transferred by Nick Harper, a former director of the Complainant's predecessor, to himself. Mr Harper then purported to sell the Domain Name to the Respondent in March 2019.

5. Parties' Contentions

The Complainant's contentions can be summarised as follows:

The Complainant is the owner of the trade mark URBNROK registered, inter alia, in the UK since 2011 in relation to recycled glass surfaces and the accompanying common law rights due to eight years' use by the Complainant and its predecessors in title.

The Domain Name consisting of the Complainant's trade mark was registered in January 2017 and remains in the equitable and beneficial ownership of the Complainant having been assigned to the Complainant in March 2017 albeit that the Respondent is currently named as the registrant and the Nominet register was not updated.

Nick Harper became a director of the Complainant's predecessor USP Designs Limited ('USP') on May 1, 2017 after the Domain Name had been assigned to the Complainant, but since the Nominet register had not been updated properly put the Domain Name in his own name on September 23, 2018 just prior to USP entering into administration. This was an abusive registration which took unfair advantage of and/or was unfairly detrimental to the Complainant's rights. The registration was both a blocking registration to disrupt the Complainant's business and made in bad faith to extract money or commercial advantage from the Complainant.

Further evidence of Nick Harper's abusive registration is that Nick Harper acted to improperly transfer shares to himself and remove other directors. This was later remedied at Companies House.

Nick Harper took down the website associated with the Domain Name and the e mail server, disrupting the Complainant's business. The administrator of USP acted to give operational control of the web site and e mails back to USP but the registration remained wrongly registered to Nick Harper and he had erased valuable business e mails.

Nick Harper applied for a trade mark registration for URBNROK which was successfully opposed by the Complainant.

Nick Harper is using URBNROK on his LinkedIn page which is confusing.

Nick Harper alleged he obtained ownership of the Domain Name in February 2018 as part of the assets of USP, but this was after the Domain Name had already been assigned to the Complainant in March 2017.

Any use made by the Domain Name not associated with the Complainant would lead to a significant level of confusion amongst consumers.

The Respondent's contentions can be summarised as follows:

The Respondent purchased the Domain Name from Nick Harper on March 1, 2019 satisfied that the Complainant was the rightful owner. The Complainant's claims are disputed and 'appears to be an asset strip'.

6. Discussions and Findings

Identical or Similar

The URBNROK trade mark is registered in the name of the Complainant, inter alia, in the UK for recycled glass products since 2011.

The suffix .co.uk in the Domain Name does not prevent it from being identical to the Complainant's URBNROK trade mark for the purposes of the Policy as .co.uk is a functional part of a domain name and not a part of any trade mark involved in these proceedings.

The Domain Name is therefore identical to a mark in which the Complainant has rights under the Policy.

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. has been used in a manner, which took unfair advantage of or was unfairly detrimental to the Complainant's Rights."

A non-exhaustive list of factors, which may be evidence that the Domain Name is an Abusive Registration is set out in paragraph 5 of the Policy. The only relevant factor would appear to be:

"5.1.6 The Domain Name is an exact match .. 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."

Since the Respondent has simply stated that he acquired the Domain Name from Nick Harper in March 2019, he has not put forward any justification for having registered the Domain Name other than that he paid money for it and was satisfied the Respondent owned it. The Expert finds it strange that he has made no comments on the extent to which he was aware or unaware as the case may be of the background facts as contended by the parties.

However, the Expert finds it unnecessary to issue an Order to ask the Respondent to what extent he was aware of the background facts. Bearing in mind the factual background as set out above the Expert finds that the Complainant was the person truly entitled to the Domain Name. Accordingly, the transfer to the Respondent was clearly acquired in a manner which was unfairly detrimental to the Complainant's rights and the Expert finds that the registration by the Respondent is an Abusive Registration within Paragraph 1 of the Policy.

7. Decision

The Expert determines that the Domain Name shall be transferred to the Complainant.

Signed

Dated12-7-2019.....