

DISPUTE RESOLUTION SERVICE

D00021664

Decision of Independent Expert

Sanctuary Personnel Ltd

and

Mr Alexis McKenzie

1. The Parties:

Lead Complainant: Sanctuary Personnel Ltd
Willis Building
15 Friars Street
Ipswich
Suffolk
IP1 1TD
United Kingdom

Respondent: Mr Alexis McKenzie
1 Olympic way
London
HA1 0NP
United Kingdom

2. The Domain Name:

<sanctuaryrecruitment.co.uk>

3. Procedural History:

The Complaint was filed with Nominet on 23 July 2019. Nominet validated the Complaint on 24 July 2019 and notified the Respondent of the Complaint by post and by email the same day, informing the Respondent that the due date for submission of a Response was 14 August 2019.

The Response was filed on 13 August 2019. Nominet informed the Complainant that the due date for submission of a Reply was 20 August 2019. The Complainant did not file a Reply, and the Respondent did not submit any further statements. The mediator was appointed on 21 August 2019.

The informal mediation procedure started on 28 August 2019 and failed to produce an acceptable solution for the Parties and so on 23 October 2019 Nominet informed the Complainant that it had until 6 November 2019 to pay the fee for the decision of an Expert pursuant to paragraph 7 of the Nominet Dispute Resolution Policy (the "Policy"). On 5 November 2019, the Complainant paid Nominet the required fee.

On 8 November 2019 the undersigned, Jane Seager ("the Expert"), confirmed to Nominet that she was independent of each of the parties and that, to the best of her knowledge and belief, there were no facts or circumstances, past or present (or that could arise in the foreseeable future) that needed to be disclosed which might be of such a nature as to call in to question her independence in the eyes of one or both of the Parties.

4. Factual Background

The Complainant is a recruitment company incorporated in England and Wales on 20 October 2006. The Complainant offers recruitment services in the areas of social care, health care, criminal justice roles, and executive jobs.

For use in connection with its offering of recruitment services, the Complainant has registered the following trade marks:

- United Kingdom Trade Mark Registration No. UK00003356822, SANCTUARY (and design) registered on 29 March 2019 for services in classes 35 and 41; and
- United Kingdom Trade Mark Registration No. UK00003356805, SANCTUARY, registered on 29 March 2019 for services in classes 35 and 41.

The Respondent is the managing director of the company Sanctuary Recruitment Ltd, incorporated in the United Kingdom on 25 October 2016. Sanctuary Recruitment Ltd purports to be a supplier of medical, nursing and education staff across the United Kingdom and globally.

The Domain Name was registered on 29 September 2017. The Domain Name resolves to a website offering recruitment services (the "Respondent's website").

5. Parties' Contentions

Noting the brevity of both Parties' submissions, the Parties' contentions are quoted directly below.

The Complainant contends as follows:

"Sanctuary Personnel Ltd has been operating for 16 years and is a market leader with a UK registered trademark (SANCTUARY word mark with registration number UK 3356805 in classes 35 and 41 with an effective date of 28 November 2018). Our website is www.sanctuarypersonnel.com. We have been an approved supplier to the NHS since 2005.

The domain name www.sanctuaryrecruitment.co.uk has been registered to confuse internet users searching for Sanctuary Personnel Ltd, the approved supplier to the NHS.

The company name "Sanctuary Recruitment Ltd" was registered on 25/10/16 and was dormant until very recently when this website went live, which we believe was earlier this year. The company is also abusive and is likely to deceive the public into a mistaken belief that the business is associated or connected with that of Sanctuary Personnel Ltd."

In support of the above allegations, the Complainant has supplied a screen capture of the "Who we are" page of the Respondent's website, a historic screen capture of the Complainant's website dating from 5 December 2006, and copies of the Complainant's trade mark certificates, the details of which are provided in the factual background section above. The Complainant requests transfer of the Domain Name.

The Respondent contends as follows:

"Sanctuary recruitment refute each and every allegation made by sanctuary personnel.

The company might sound similar but significantly different therefore no confusion will arise.

Sanctuary recruitment is put strict proof of the contrary."

The Respondent provides no evidence in support of its allegations.

6. Discussions and Findings

Under paragraph 2.1 of the Policy, for the Expert to order transfer of the Domain Name, the Complainant is required to demonstrate, on the balance of probabilities, both of the following elements:

"2.1.1 The Complainant has Rights in respect of a name or mark which is identical or similar to the Domain Name; and

2.1.2 The Domain Name, in the hands of the Respondent, is an Abusive Registration."

Paragraph 18.1 of the Policy provides:

"The Expert will decide a complaint on the basis of the Parties' submissions and this Policy. It is the Parties' responsibility to explain all the relevant background facts and other circumstances applicable to the dispute in their submissions, and to support those submissions with appropriate evidence. In the ordinary course an Expert will not perform any research into a dispute or check the parties' assertions, however an Expert may (in their entire discretion) check any material which is generally available in the public domain."

6.1. The Complainant's Rights

The Policy defines "Rights" 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 Expert finds that the Complainant has established Rights in the trade mark SANCTUARY by virtue of its trade mark registrations in the United Kingdom, the details of which are provided in the factual background section above.

The Domain Name incorporates the Complainant's SANCTUARY trade mark in its entirety as its leading element, together with the descriptive word "recruitment" under the ".co.uk" suffix. The Expert finds that the addition of the term "recruitment" does not prevent a finding of confusing similarity between the Domain Name and the Complainant's trade mark, which is immediately recognizable in the Domain Name. The Expert notes in this regard that the Complainant's SANCTUARY trade mark is registered in respect of "[h]uman resources management and recruitment services; personnel services; personnel recruitment and placement; executive recruitment services [...]".

The Expert finds the Domain Name to be confusingly similar to the Complainant's trade mark. Accordingly, the Complainant has satisfied the requirements of paragraph 2.1.1 of the Policy.

6.2. Abusive Registration

An "Abusive Registration" is defined in the Policy 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."

The Expert notes that the Parties have submitted highly limited contentions, which are quoted in full above. The Complainant's assertions regarding the Domain Name are supported by a single screen capture of the "Who we are" page of the Respondent's website, while the Respondent has simply refuted the Complainant's allegations without providing any evidence whatsoever to the contrary.

In accordance with the discretion afforded to the Expert under paragraph 18.1 of the Policy, the Expert has undertaken limited factual research into relevant matters available in the public domain. To this end, the Expert has considered the contents of the Respondent's website, vis-à-vis the Complainant's official website available at "www.sanctuarypersonnel.com", as well as the UK Companies House records for the entity Sanctuary Recruitment Ltd, linked to the Respondent.

Paragraph 8.1 of the Policy provides a non-exhaustive list of factors which may be evidence that the domain name in question is not an Abusive Registration. The principal issue for determination in the present case is whether the Respondent can reasonably be said to have "used or made demonstrable preparations to use the Domain Name or a domain name which is similar to the Domain Name in connection with a genuine offering of goods or services", in accordance with paragraph 8.1.1.1 of the Policy.

After careful consideration of the above, the Expert notes the following: First, notwithstanding the Complainant's relatively recent registration of its trade marks, the Complainant has put forward credible evidence that it has offered recruitment services to the healthcare sector via the Internet since at least 2006. Second, the Respondent purports to be engaged in providing substantially similar services to those of the Complainant, *i.e.*, provision of recruitment services to the healthcare sector. Third, the Respondent's company was incorporated and has been operational since 2016, by which time the Complainant had been offering its recruitment services for 10 years, and had been the recipient of several industry awards. The term "sanctuary" is not inherently descriptive of the Complainant's recruitment business, and can be said to have acquired some secondary meaning in relation to the Complainant's services. The publicly-available accounts for the Respondent's company do not reveal any substantial business activity, with highly limited revenue, and with net assets in 2018 of less than GBP 200. While the Respondent's website states:

"Sanctuary Recruitment has a range of temporary and permanent jobs available for nurses in NHS trusts and private hospitals across the UK. With so many nurse jobs to choose from, you'll be spoilt for choice"

In reality the Respondent's website contains a single job listing for a teacher's position in South America, dating from 14 May 2018.

While the Respondent's website does not explicitly copy the look and feel of the Complainant's website, the Expert does not accept the Respondent's unsupported assertion that "the company might sound similar but significantly different therefore no confusion arise." Rather, noting that both Parties are located in England, the Expert concludes that the Respondent either knew or ought to have known of the Complainant at the time it registered the Domain Name some 10 years after the Complainant had commenced offering recruitment services online. The fact that the Respondent has gone on to hold itself out as a provider of nurses to the NHS leads the Expert to determine, on balance, that the Respondent is using the Domain Name in a way which is likely to confuse people or businesses into believing that the Domain Name is registered to, operated or authorized by, or otherwise connected with the Complainant. Notwithstanding the evidentiary shortcomings in the Complainant's case, the Expert further finds the Respondent's wholly-unsupported assertions to be insufficient to bring the Respondent into the safe harbour of paragraph 8.1.1.1 of the Policy.

In light of the foregoing, the Expert finds that the Respondent is using the Domain Name in a way which is likely to confuse people or business into believing that the Domain Name is registered to, operated or authorised by, or otherwise connected with the Complainant in accordance with paragraph 5.1.2 of the Policy.

The Expert therefore concludes that the Domain Name is an Abusive Registration within the meaning of paragraph 2.1.2 of the Policy.

7. Decision

The Complainant has Rights in a name or mark which is identical or similar to the Domain Name, and the Domain Name, in the hands of the Respondent, is an Abusive Registration. The Domain Name should therefore be transferred to the Complainant.

Jane Seager
29 November 2019