

DISPUTE RESOLUTION SERVICE

D00022717

**Decision of Independent Expert
(Summary Decision)**

Vistry Group PLC

and

Ms Michelle Evans

1. The Parties:

Complainant: Vistry Group PLC
Vistry Group PLC
11 Tower View, Kings Hill
West Malling
Kent
ME19 4UY
United Kingdom

Complainant: Vistry Homes Limited
Vistry Homes Limited
11 Tower View
Kings Hill
West Malling
Kent
ME19 4UY
United Kingdom

Respondent: Ms Michelle Evans
Staffordshire
ST20 0QZ
United Kingdom

2. The Domain Name:

boviscontracts.co.uk

3. Notification of Complaint

I hereby certify that I am satisfied that Nominet has sent the complaint to the Respondent in accordance with section 3 and 6 of the Policy.

Yes No

4. Rights

The Complainant has, to my reasonable satisfaction, shown rights in respect of a name or mark which is identical or similar to the domain name.

Yes No

5. Abusive Registration

The Complainant has, to my reasonable satisfaction, shown that the domain name boviscontracts.co.uk is an abusive registration

Yes No

6. Other Factors

I am satisfied that no other factors apply which would make a summary decision unconscionable in all the circumstances

Yes No

7. Reasons for refusal of transfer

I refer herein to Vistry Group PLC as the “Lead Complainant” and to Vistry Homes Limited as the “Second Complainant.”

I am refusing to transfer the Domain Name on the basis that I am not satisfied that either the Lead or Second Complainant has Rights (within the meaning of the Nominet Dispute Resolution Policy) on which it can rely. For reasons I shall explain, I anticipate that this may come as some surprise to the Complainants. I will therefore explain the reasons for my refusal, because in my view it is important that the Complainants should understand why this Complaint has failed.

The Complainants rely on rights in the mark BOVIS, in particular because they claim to be exclusive licensees of UK registered trade mark 2120937 (UK’937). A company known as Lend Lease Construction Holdings (EMEA) Limited is the registered proprietor of UK’937. As it happens, that company changed its name on 1 July 2016, and the Register of Trade Marks has not been updated. It should be. However, nothing turns on that.

There is no exclusive licence in respect of UK’937 registered with the Registrar of Trade Marks, notwithstanding that an exclusive licence is a registrable transaction (see Section 25(2)(b) of the Trade Marks Act 1994). It is accordingly necessary to examine with care the claim to the exclusive licence(s).

The Complainants rely on the terms of a licence embodied in an agreement dated 4 December 1997 between the proprietor of UK’937 (which at that time was named Bovis Limited, but I will refer to it as the proprietor) and the Second Complainant (which at that time was named Bovis Homes Limited) (the “1997 Licence”). The 1997 Licence was expressed at least in Recital (B) and in clause 4.1 as a licence to use certain trade marks. UK’937 was not expressly identified in the licence, but the name ‘BOVIS’ was included in Schedule 1. However, pursuant to clause 3.1(c) the Second Complainant did not acquire any goodwill in the name BOVIS. Further and in any event, clause 9.3 expressed that the proprietor retained the exclusive right to enforce the trade marks licensed thereunder. Clause 9.3 is consistent with the description of the licence in Recital (B) and clause 4.1 as a licence to use. Accordingly, the 1997 Licence did not provide the Second Complainant with any Rights (within the meaning of the Nominet Dispute Resolution Policy) because all rights to enforce any licensed or unlicensed trade marks vested in the proprietor.

I should add that Clause 9.3 might have provided the Second Complainant with the contractual right to compel the proprietor to commence enforcement, but that contractual right against the proprietor is not sufficient to amount to Rights against the Respondent in this action.

On 2 February 1998 the 1997 Licence was extended to include Bovis Homes Group Plc as a licensee. Bovis Homes Group Plc is the former name of the Lead

Complainant. The Lead Complainant did not acquire any relevant right or entitlement under the 2 February 1998 extension beyond that which the Second Complainant already enjoyed under the 1997 Licence. In particular, the Lead Complainant did not acquire any goodwill or other enforcement right under the 2 February 1998 extension.

I note also that the 1997 Licence provided in clause 4.7 for additional marks to be added to the Licence, provided that certain formalities were complied with. I have not seen a document formally incorporating UK'937 into the 1997 Licence, but Schedule 5 to an agreement dated 25 March 2004 and signed by the Proprietor included a statement that UK'937 was licensed to both Complainants. Accordingly, I am satisfied that the Complainants each have a licence to use UK'937. However, the 25 March 2004 agreement did not materially alter the terms of the 1997 Licence (in particular, see the final sentence in clause 3.1 of the 25 March 2004 agreement – *“All remaining terms and conditions of the [1997 Licence] remain in force”*). Thus the Complainants did not acquire any right to enforce UK'937 under the 25 March 2004 agreement.

In all the circumstances, and despite a careful review of the agreements submitted, I am not satisfied the Complainants have the necessary Rights either in UK'937 or in the name BOVIS on which to found the Complaint. I will therefore refuse to transfer the Domain Name.

I indicated above that I believe this conclusion may come as some surprise to the Complainants, which it appears may have reason to believe that they have the necessary rights. I note the Complainants in their submissions dealt with the origin of their rights in the agreements very briefly, which rather suggests that they did not think there was any difficulty that needed overcoming. I hope my explanation is sufficiently clear to enable the Complainants to take whatever steps are necessary for them to overcome that difficulty.

I should add that, had the Complainants demonstrated Rights, I would have held that the Domain Name was an Abusive Registration and I would have directed that the Domain Name be transferred. As it is, however, I will refuse the Complaint.

8. Decision

I refuse the Complainants' application for a summary decision. The domain name registration will therefore remain with the Respondent.

Signed: Christopher Hall

Dated: 25 July 2020