

DISPUTE RESOLUTION SERVICE

D00008663

Decision of Independent Expert

BIFM (The British Institute of Facilities Management Limited)

and

Mr James P Hurson

1. The Parties

Lead Complainant: BIFM (The British Institute of Facilities Management Limited)
Address: Number One Building
The Causeway
Bishop's Stortford
Hertfordshire
Postcode: CM23 2ER
Country: United Kingdom

Respondent: Mr James P Hurson
Address: Park House
Watford Business Park
Watford
Postcode: WD18 8PH
Country: United Kingdom

2. The Domain Name(s)

bifm.co.uk (the "Domain Name")

3. Procedural History

1 June 2010	Dispute received, validated and notification sent to parties
21 June 2010	Response received and notification sent to parties
28 June 2010	Reply received
1 July 2010	Notification of reply sent to parties
1 July 2010	Mediator appointed

8 July 2010	Mediation started
21 January 2011	Mediation failed
17 March 2011	Nick Gardner appointed as Expert Reviewer
17 March 2011	Steve Ormand appointed as Expert
18 March 2011	Expert part 13a requests sent to parties
24 March 2011	Complainant response to part 13a requests received
24 March 2011	No reply by Respondent to part 13a requests

Definitions used in this decision have the same meaning as set out in the Nominet UK Dispute Resolution Service Policy Version 3, July 2008 (the “Policy”) and/or the Nominet UK Dispute Resolution Service Procedure Version 3, July 2008 (the “Procedure”) unless the context or use indicates otherwise.

4. Factual Background

The Complainant was formed in September 1993, as a company limited by guarantee, taking over the activities of the Association of Facilities Managers and the Institute of Facilities Management. The Complainant changed its name to the British Institute of Facilities Management in December 1993 and has operated under this name, and that of BIFM, since that date.

The Complainant is a professional body for facilities managers having around 12,000 members. Members include individuals, companies and other entities.

The Complainant registered UK trade marks in the name BIFM in February and December 2009.

The Domain Name was registered to the Respondent on 5 December 2003.

5. Parties’ Contentions

The Complaint

The Complainant contends that it has Rights in the name BIFM because:

1. The Complainant is a company incorporated under the laws of England and Wales and has carried on business as a provider of facilities management services in the United Kingdom, since 1993.
2. The Complainant has common law rights in the name BIFM enforceable under English law. The Complainant is, and has since it was founded in 1993 been, known and referred to as BIFM, as well as its full name, both in its own website at <http://www.bifm.org.uk/bifm/>, and in its advertising and promotional literature. In addition third parties making reference to the Complainant usually refer to it as ‘BIFM’.
3. The Complainant is the largest facilities management membership organisation in the United Kingdom and has approximately 12,000 members, which include individuals, companies and other entities. Its function is to provide information, education, training and networking services for its members, and it does this via its website at www.bifm.org.uk and through special interest groups, publications, training and the provision of exams for accreditation. Its reputation in the UK is such that any use of its initials ‘BIFM’ by others in relation to the same or any similar services will inevitably be taken to be a reference to the Complainant. Accordingly it has a longstanding and substantial goodwill and reputation in the

name BIFM, when used in this way in the United Kingdom, and use by others of the name BIFM in relation to the same or any similar services would amount to a false representation to customers or potential customers of the Complainant that the user is or is connected in some way to the Complainant, and amount to passing off.

4. The Complainant is the owner of registered trade marks rights enforceable under English law which include:
 - a. UK Trade Mark number 2517320 for 'BIFM' dated 14 December 2009 registered in classes 09, 16, 35, 37,41 and 42;
 - b. UK Trade Mark number 2517317 for 'BIFM' (in stylised lettering) dated 4 December 2009 for BIFM registered in classes 09, 16, 35, 37, 41 and 42;
 - c. UK Trade Mark number 2476147 for 'British Institute of Facilities Management BIFM' dated 20 February 2009 registered in classes 09, 16, 35, 37, 41 and 42..
5. The Complainant owns and operates its business from the website at bifm.org.uk.

The Complainant contends that the Respondent's registration and use of the Domain Name is an Abusive Registration because:

1. The Domain Name has been used in a manner which has taken unfair advantage of or been unfairly detrimental to the Complainant's rights.
2. The Respondent is using the Domain Name in a way which has confused people or businesses into believing that the Domain Name is registered to, operated or authorised by, or otherwise connected with the Complainant and/or as a blocking registration against a name or mark in which the Complainant has Rights; and/or for the purpose of unfairly disrupting the business of the Complainant.
3. The Respondent is also the owner of the domain name bifm.org.
4. The Respondent has registered the Domain Name (and bifm.org) for the purposes of selling, renting or otherwise transferring the Domain Name to the Complainant or to a competitor of the Complainant, for valuable consideration in excess of the Respondent's documented out-of-pocket costs directly associated with acquiring or using the Domain Name.
5. The Domain Name (and bifm.org) is used to re-direct traffic to the Respondent's website, at www.selfrecruit.com, where the Respondent describes itself as offering the service of an 'original and leading job board specifically for employers ONLY to advertise their jobs direct to interested individuals'. When the Respondent receives emails to either of the Domain Name or bifm.org, clearly intended for the Complainant, he responds to the sender in a standard form of email stating that he has offered to sell the domain name in question to the Complainant, and suggesting that the sender may "wish to reconsider being associated with [the Complainant]". This disrupts the Complainant's business and is an attempt to put pressure on the Complainant to buy the Domain Name (and bifm.org) and damage the Complainant and its relationship with its customers, potential customers and those which do business with the Respondent. Copies of emails from persons attempting to contact the Complainant at the Domain Name (and bifm.org) and of the responses from the Respondent are provided in evidence.
6. The Respondent offered to sell bifm.org to the Complainant for £2,500 on 14 April 2009. In his email the Respondent referenced an earlier offer to sell the same domain name of USD \$2,000 in 2008. By emails of 16 April 2009, 11 May 2009 and 17 September 2009 the Complainant indicated its willingness to pay the administrative costs of transfer but refused to pay £2,500 for the transfer of the domain name. By email dated 6 April 2010 the Respondent again offered to sell domain names to the Complainant (without specifying which ones, but presumably intending to refer to the .Domain Name and bifm.org). Copies of these emails are provided in evidence.

7. On 24 November 2009 the Complainant by its solicitors demanded that the Respondent (amongst other things) assign the Domain Name (and bifm.org) to the Complainant but the Respondent has not done so, and has not answered the letter.
8. The Respondent was not commonly known by the name or legitimately connected with a mark that it is identical or similar to the Domain Name.
9. The Respondent has not made legitimate non-commercial or fair use of the Domain Name. The only use the Respondent has made of the Domain Name is to provide links to his website <http://www.selfrecruit.com/>.

The Response

The Respondent contends that its registration and use of the Domain Name is not an Abusive Registration because:

1. The Complainant is clearly confused as Nominet UK only has jurisdiction in respect of UK domains. The Respondent thus requests that Nominet ensures that the Complainant's documentation only refers to the Domain Name and that all references to bifm.org is completely deleted before being considered by the Expert so that the Respondent is not unfairly prejudiced.
2. He has already offered the Domain Name to the Complainant and advised that they obtain professional advice regarding the importance of redirecting the same to their site to obtain the natural search traffic and ensure emails, often confidential, do not go astray or to non intended parties.
3. He has in no way interfered with the Complainant's business. Indeed the opposite is the case as he has often taken the trouble to inform people that their emails are going to third parties and offered BIFM the Domain Name so that it is not purchased by someone else, possibly a competitor for ulterior purposes.
4. In order to conclude this matter quickly the Respondent offers to transfer the Domain Name for the non-negotiable sum of £2,500 + VAT (half the amount recommended by domain experts www.Sedo.com) if cleared funds are received by him by 30 June 2010 [*sic*]. This will ensure that the Complainant is guaranteed to obtain the Domain Name immediately rather than taking the gamble of losing it forever and costing it the Nominet UK costs as well as mitigating its excessive legal costs which will obviously come from members' subscriptions.

The Reply

The Complainant replied to the Response as follows:

1. The Complaint clearly states that it is made only in relation to the Domain Name. The purpose of the Complainant referring to the fact that the Respondent has also registered bifm.org is to illustrate that the Respondent is engaged in a pattern of behaviour consisting of registering domain names (including the Domain Name) for the purposes of selling, renting or otherwise transferring the Domain Name to the Complainant or to a competitor of the Complainant, for valuable consideration in excess of the Respondent's documented out-of-pocket costs directly associated with acquiring or using the Domain Name. The Complainant refers to paragraph 5 of the Nominet guidance for complainants which states:

"State the reasons why you consider the registration of the disputed domain names to be Abusive, in particular you should view paragraph 3 of the DRS Policy, for example:

...
Does the Respondent have a history of registering domain names which relate to trade marks in which they have no apparent rights, and if so, is this part of that trend? This does not necessarily have to be restricted to .uk domain names: generic endings such as .com and .org may be relevant too."

2. The Complainant relies on the fact that the Respondent has previously approached the Complainant with offers to sell the Domain Name for significantly more than the cost to the Respondent of acquiring or using the Domain Name.
3. In relation to paragraph 3 of the Response, clearly the Domain Name could not be purchased without the Respondent offering to sell it and, as such, the Complainant relies on this as a further threat to sell the Domain Name to one of its competitors if the Complainant does not agree to purchase it for the sum demanded by the Respondent.
4. Further in relation to paragraph 3 of the Response, it is misleading for the Respondent to represent that his replies to emails erroneously addressed to him have somehow rendered a service to the Complainant. The Respondent interferes with the Complainant's business and/or seeks to embarrass the Complainant by intercepting these emails. Rather than just forwarding the e-mails to the Complainant, the Respondent replies to the sender, frequently copying the e-mail and his response to numerous members of the Complainant and others, apparently for the purpose of exerting pressure on the Complainant to purchase the Domain Name for an extortionate price from him. The Claimant relies on comments such as *"Therefore you may wish to reconsider being associated with this kind of "organisation" such as in the email sent on 28 October 2009 from the Respondent to Katie Miles (Avanta Managed Offices Limited), and copied to numerous other BIFM addresses, provided as evidence of such interference in the Complaint.*
5. The Complainant relies on the Respondent's offer to transfer the Domain Name for the sum of £2,500 + VAT as evidence that the Domain Name is an Abusive Registration on the basis that this is a circumstance indicating that the Respondent has registered or otherwise acquired the Domain Name (as well as bifm.org) primarily for the purposes of selling, renting or otherwise transferring the Domain Name to the Complainant or to a competitor of the Complainant, for valuable consideration in excess of the Respondent's documented out-of-pocket costs directly associated with acquiring or using the Domain Name.

Part 13a Requests

Following a review of the above submissions, and the lack of evidence provided in support of parties' assertions, I concluded that I required further information from the parties in order for me to come to a just decision.

Accordingly, under §13a of the Procedure I requested that Nominet ask the Complainant to:

"... provide evidence of [its] use of the name BIFM between 1993 and 2003 which demonstrates the goodwill and reputation that it refers to in the Complaint."

Further, I requested that Nominet ask the Respondent to:

"... provide evidence of the statement he makes in the Response that he has not interfered with the Complainant's business, for example by demonstrating his use of the Domain Name."

Without prolonging the proceedings, each party was given time to answer the request and the opportunity to respond to the other party's response. The Complainant answered the request. The Respondent did not comment on the Complainant's answer nor did he respond to the request put to him.

The Respondent did, however, change his use of the Domain Name after the §13a requests to the parties. Prior to the §13a requests, the Domain Name resolved to a webpage that purported some relationship and/or involvement with facilities management and a link to the www.selfrecruit.com website. It now resolves to www.skillsdirect.co.uk which appears to be a resource site for e-learning with no purported link to or mention of BIFM.

6. Discussions and Findings

General

To succeed in this Complaint, the Complainant has to prove to the Expert on the balance of probabilities, pursuant to §2 of the Policy, both limbs of the test that:

- 1. The Complainant has Rights in respect of a name or mark which is identical or similar to the Domain Name; and*
- 2. The Domain Name, in the hands of the Respondent, is an Abusive Registration.*

Complainant's Rights

Rights is defined in §1 of the Policy 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 wholly generic suffix ".co.uk" is discounted for the purposes of establishing whether a complainant has Rights in a name or mark which is identical or similar to a domain name.

I am satisfied that the Complainant has evidenced unregistered rights in respect of the name BIFM which pre-date the Respondent's registration of the Domain Name. The Complainant has also demonstrated registered rights in the name BIFM arising in 2009.

Accordingly, the Complainant has satisfied the first limb of the test by demonstrating that it has Rights in the name BIFM, a name which is identical to the Domain Name save for the addition of the generic suffix.

Abusive Registration

Abusive Registration is defined in §1 of the Policy as a Domain Name which either:

- 1. 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*
- 2. has been used in a manner which has taken unfair advantage of or has been unfairly detrimental to the Complainant's Rights.*

A non-exhaustive list of factors which may be evidence that a domain name is an Abusive Registration is set out in §3 of the Policy.

The Complainant contends that the registration and/or use of the Domain Name is Abusive because the Respondent's use of the name BIFM is a false representation to the Complainant's customers or potential customers that the Respondent is or is in some way connected to the Complainant and amounts to passing off. Further, that the Respondent's use of the Domain Name is confusing people or businesses that the Domain Name is registered to or operated by or somehow connected to the Complainant, is damaging to the Complainant, disrupts its business and is an attempt to put pressure in the Complainant to buy the Domain Name. The Complainant provides copies of 15 emails sent by the Respondent to the Complainant and/or its customers between May 2009 and March 2010 ("**Emails**") in support of its assertions. The Complainant cites the Respondent's offers to sell the Domain Name to the Complainant as evidence of Abusive Registration.

The Respondent does not answer the Complaint save to make a bald statement that he has not interfered with the Complainant's business but that he has often taken the trouble to inform the Complainant's customers that their emails to the Complainant are going to third parties.

There is no evidence before me to demonstrate the Respondent's purpose in registering the Domain Name and/or whether the Respondent was aware of the Complainant's Rights at the time of registration. The Respondent, for his part, has not offered any explanation.

The Respondent's offer to sell the Domain Name to the Complainant is not of itself abusive. There is no evidence before me to show that the Respondent's intent at the time of registration was to sell the Domain Name to the Complainant or a competitor for a sum in excess of his costs of acquiring the Domain Name.

Since the Respondent has changed his use of the Domain Name to resolve to www.skillsdirect.co.uk following the §13a request, it is now difficult to rely on his previous use of the Domain Name with any degree of certainty as there are no hard copies of such use in the Complaint or the Response. There was some mention of facilities management but the webpage is no longer available for inspection even using tools such as the Wayback machine. By using the Wayback machine, however, it is possible to establish that the Domain Name has in the past redirected to the selfrecruit.com website. Going directly to the selfrecruit.com website via Google takes the visitor to a recruitment website with no reference to BIFM.

Whether the Respondent was aware of the Complainant's Rights at the time of registration or not, he has clearly become aware of those Rights at some point prior to his offer to sell the Domain Name and/or his sending of the Emails. The Respondent's use of the Domain Name in relation to the Emails, where the sender has mistyped emails intended for the Complainant (at bifm.org.uk) and instead typed bifm.co.uk or bifm.org, is a change of use. I am satisfied on the papers before me that the Respondent's Emails were disruptive to the Complainant's business and evidence of Abusive Registration, both in relation to the content of his replies and his distribution of those replies to other parties particularly where the content of the original email was clearly intended by the sender to be confidential between the sender and the Complainant. I am also satisfied on the papers before me that the Respondent sent the Emails for the purpose of applying pressure to the Complainant to purchase the Domain Name.

Accordingly I find that the Respondent has used the Domain Name in a manner which has taken unfair advantage of or has been unfairly detrimental to the Complainant's Rights.

7. Decision

In light of the foregoing findings, namely that the Complainant has Rights in a name which is identical to the Domain Name, and the Domain Name, in the hands of the Respondent, is an Abusive Registration, I direct that the Domain Name, bifm.co.uk, be transferred to the Complainant.

Signed

Steve Ormand

Dated: 31st March 2011