

DISPUTE RESOLUTION SERVICE

D00010532

Decision of Independent Expert

Driveshaft Services Ltd

and

WWW Support Services

1. The Parties:

Complainant: Driveshaft Services Ltd
Plot 1A, Heol Mostyn
Village Farm Industrial Estate
Pyle
Bridgend
CF33 6BJ
United Kingdom

Respondent: WWW Support Services
Tipyn o Gymru, Northway Lane
TEWKESBURY
Gloucestershire
GL20 8HA
United Kingdom

2. The Domain Names:

driveshaftservices.co.uk
propshaftservices.co.uk

3. Procedural History:

21 November 2011 14:22 Dispute received
22 November 2011 11:22 Complaint validated
22 November 2011 11:39 Notification of complaint sent to parties
09 December 2011 01:30 Response reminder sent
14 December 2011 10:06 Response received
14 December 2011 10:06 Notification of response sent to parties
15 December 2011 08:41 Reply received
15 December 2011 08:43 Notification of reply sent to parties
15 December 2011 08:43 Mediator appointed
15 December 2011 15:21 Mediation started
13 January 2012 15:56 Mediation failed
13 January 2012 16:18 Close of mediation documents sent
16 January 2012 11:23 Expert decision payment received
16 January 2012 non standard submission from the Complainant under 13b of the Procedure
20 January 2012 James Bridgeman was appointed Expert and confirmed to Nominet that he was independent of the parties and knew of no facts or circumstances that might call into question his independence in the eyes of the parties.
30 January 2012 non standard submission from the Respondent under 13b of the Procedure

4. Factual Background

The Complainant is a supplier of drive shafts and prop shafts for motor vehicles.

Both disputed domain names were registered by the Respondent on 8 August 2000.

On an unspecified date at about the same time, the Complainant engaged the Respondent to design and maintain a website for it to which the disputed domain names resolve. The Complainant states that this arrangement has continued for approximately 11 years but it is not clear when the arrangement came into being.

In or about 2011, the Complainant became unhappy with the services provided by the Respondent and engaged a third party website provider.

The Complainant claims to be entitled to ownership of the disputed domain names. However the Respondent claims that it has at all times been the owner of the disputed domain names and rented the use of the domain names to the Complainant for an annual fee.

5. Parties' Contentions

The Complainant's Case

The Complainant has furnished evidence in the form of a blank letterhead showing the use of the Complainant's company name DRIVE SHAFT SERVICES LIMITED in combination with a device or logo. The Complainant has also provided

evidence of its use of the word PROPSHAFT in combination with a logo or device on its website.

The Complainant states that the disputed domain names were registered to the Respondent as a result of “previous dealings” between the Parties. The Complainant claims that it has been using the disputed domain names over the past 11 years during which time it has been paying the Respondent a monthly fee for “[m]aintaining the website” and an annual fee for the “[e]xclusive use of the domain names”.

During 2011 the Complainant engaged a third party to re-design and maintain its website which it believed had become out-dated. On 3 November 2011, the third party contacted the Respondent to ask for the disputed domain names to be transferred to the Complainant’s principal: Mr Steven Richards.

The Respondent refused.

The Complainant acknowledges that the disputed domain names driveshaftservices.co.uk and propshaftservices.co.uk are registered to the Respondent but submits that the disputed domain names are the very names which the Complainant uses in trade and argues that neither of these domain names reflect any arm of the Respondent’s business. The Complainant submits that the Respondent can gain no benefit by refusing to transfer the disputed domain names to the Complainant.

A further point of concern for the Complainant is that on 7 November 2011 the Complainant was notified by Nominet that in Nominet’s view, the disputed domain name driveshaftservices.co.uk is not registered to a legally identifiable person and that it would be necessary to update the registrant’s name. Nominet further stated that if the registrant’s details were not updated by 7 December the disputed domain name registration would be suspended.

The Complainant asks this Expert to further note that since the Respondent was contacted regarding transfer of the disputed domain names the Respondent has produced several invoices from previous years which the Respondent claims not to have been paid by the Complainant. Furthermore the Respondent has written to the Complainant requesting the following monies: Original name Registration Fees 2 x £80, Outstanding invoices discounted value £ 205.10, Outstanding invoices Part 2 (refused discount) £205.10, Credit budget approx £714.00, Current additional unexpected work (approx) £350.

In the letter dated 14 November 2011 this “additional unexpected work” is explained by the Respondent in the following terms: “Over the last 8 days we’ve seen an explosion in work for our service to you amounting to some 10 premium hours displacing other work”.

The Complainant states that it is very concerned about this “Explosion” of work that has suddenly occurred since the Respondent was asked to transfer the disputed domain names. Prior to the recent contact the Complainant had no knowledge of any monies outstanding because the Respondent takes a direct debit each month. The Complainant has never authorised the Respondent to carry

out extra work and the Complainant submits that when the Respondent was asked for proof of signed client approval, the Respondent could not provide any. The Complainant states that this is an example of how it feels totally at the mercy of the Respondent when dealing with its own domain names and why a transfer to the Complainant is necessary and fair.

On 16 January 2012, in a non standard submission under 13b of the Procedure the Complainant alleges that on 22 November 2011 the Respondent set up a fake website Driveshaft–Services.co.uk and submitted a 301 request to Google to redirect all traffic from the websites in dispute to this newly created website. The Complainant further alleges that it signed an agreement with the Respondent through Nominet on 4 January 2012 agreeing to pay them £705.10 for the transfer of both of the disputed domain names, but since then the Respondent has delayed signing. The Complainant further complains that it has also cancelled its main e-mail account that was linked to the website and alleges that because of the new website, the 301 request and the loss of email, the Respondent has not acted in good faith, and now time is of the essence to the Complainant.

The Respondent's Case

In the Response, the Respondent submits that it provided services to the Complainant's principal, Mr Steve Richards and not to the Complainant company. The Respondent states that in or about the year 2000 the Respondent commenced providing Internet related promotional services to Mr Richards as the Internet was an up and coming new medium. Prior to that time the Respondent had been providing non-Internet services to Mr Richards.

The Respondent states that it registered the generic phrases driveshaftservices.co.uk and propshaftservices.co.uk as Internet domain names because of their suitability for phrase-search responses.

At no time were registration fees offered or paid by Steve Richards. It was only after the Respondent had established and demonstrated a promotional system that provided some results that Steve Richards agreed to pay fees in return for the benefit of the promotional system offered.

The Respondent states that it normally retains rights in all of its work. This was known to the Complainant from the outset. In 2002 the Respondent began to issue invoices to Steve Richards for the use of the disputed domain names. The invoice stated “[t]he names will be provided for your exclusive sole use while you continue to pay the annual name fee in advance.”

The Respondent made a point of clearly providing name services distinctly separate from content and other promotional services, thus offering a more flexible range of services.

The Respondent states that Steve Richards paid the Respondent each year from 2002 until 7 August 2009 after which time he fell into arrears. Invoices dated 9 August 2009, 30 July 2010 and 27 July 2011 amounting to £153.68 in total were unpaid and remained unpaid as of 9 December 2011 despite demand for payment.

The Respondent states that on 17 November 2011, the Complainant cancelled all services from the Respondent. On 22 November 2011, without warning the Complainant refused to accept email communications from the Respondent. The Respondent complains that on 22 November 2011 the present Complaint was made without reference to the Respondent. As the Respondent was not paid for its services in advance under its contractual terms it was not obliged to continue to provide the services and under Nominet's terms the disputed domain names would have been cancelled in late 2009 for failure to pay renewal fees.

The Respondent argues that even if the disputed domain names had been registered to Steve Richards, which they were not, due to the long established debt the Respondent would be entitled to take possession of them at the Respondent's option without obstruction because clause 7 of the Respondent's terms states "[u]pon delayed payment for more than 28 days, the Buyer automatically grants Legal Title to any of the Buyers Assets, upon which possession may be taken without obstruction... to recover any outstanding charge(s)".

The Respondent argues that the letterhead exhibited by the Complainant does not amount to evidence of the Complainant's trade mark rights as it claims. Furthermore a search at the Intellectual Property Office website at ipo.gov.uk does not reveal any record of a registration of DRIVESHAFT SERVICES as a trade mark. Generic terms such as "driveshaft services" are not normally permitted as registered trade marks.

The Respondent denies the Complainant's assertion that the disputed domain names do not reflect any arm of the Respondent's business. The Respondent argues that Internet domain names containing generic phrases are a key part of the Respondent's business to promote client's businesses by which the Respondent earns revenue.

The Respondent states that on 25 August 2005, the Complainant independently registered and still holds the Internet domain name driveshaftservices.net. The Respondent submits that that registration expires on 25 August 2012. The Complainant failed to disclose this information in the Complaint. The content of the website to which the driveshaftservices.net domain name resolves has been missing for some time, however the email server continues to function as the company's primary means of email communication. This information has not been disclosed by the Complainant in this Complaint.

The Respondent denies that it registered the disputed domain names with the intention of making it more difficult in the future for any new provider appointed by the Complainant to provide website services to gain access to the disputed domain names. In this regard the Respondent cites by way of an example the fact that it has purchased a domain name for a company owned by the father of the Complainant's principal and in May 2011 actively assisted the transfer of the domain records to a new system without any loss of service, customers or business.

The Respondent refers to the Complainant's allegation that when the third party appointed by the Complainant to provide website services to the Complainant contacted the Respondent to ask for the disputed domain names to be transferred

to Steven Richards, the response was unfavourable. The Respondent explains that out of the blue, it was contacted by a company that claimed to have worked on driveshaftservices.co.uk, stated that they could not find their password for direct access to the Respondent's servers and requested a replacement password from the Respondent. The Respondent took the view that this approach was highly suspicious; the Respondent believed that the third party could not have worked with the domain name as claimed. With the benefit of hindsight, the Respondent now believes that the third party was given false information and instructed to contact the Respondent.

In additional submissions filed on 30 January 2012, the Respondent denies that the Complainant's statement that he did not receive invoices for the unpaid sums claimed by the Respondent. The Respondent further denies that it set up a "fake" website on 22 January 2011. The Respondent states that it in fact set up a "generic phase system" on 20 January to improve its promotional services and this was done only after the Complainant had cancelled its services on 17 November 2011.

The Respondent further refers to the Complainant's allegation that it failed to sign an agreement reached through Nominet on 4 January 2012. The Respondent states that it signed and returned the agreement within one working day.

Finally the Respondent denies that it cancelled the Complainant's main email account. The Respondent states that it was in fact the Complainant that cancelled all services from the Respondent on 17 November 2011.

Discussions and Findings

Paragraph 2 of the DRS Policy provides that a Complainant must prove both elements of the following test:

- i. the Complainant has Rights in respect of names or marks which are identical or similar to the Domain Names; and
- ii. the Domain Names, in the hands of the Respondent, are Abusive Registrations.

The Complainant's company name is Drive Shaft Services Limited. The Complainant has submitted a letterhead which it presents as evidence of its claimed rights in the use of the words DRIVE SHAFT SERVICES LIMITED as a trade mark. The letterhead shows the Complainant's company name in combination with a device or logo.

While the Complainant's company name is highly descriptive, this Expert will nonetheless accept that the Complainant has succeeded in making a case that it has sufficient Rights to bring this Complaint in respect of the name DRIVE SHAFT SERVICES.

The Complainant also claims Rights in the word PROPSHAFT or PROPSHAFT SERVICES as a trade mark. In support of this claim the Claimant has also provided

an example of its use of the word PROPSHAFT in a logo/device format on its website which it presents as evidence of its use of the word as a trade mark.

However, this Expert finds that the Complainant has not proven that it has rights in PROPSHAFT either as a name or mark. Not only is there is very little evidence of the Complainant's use of the word, but the word is highly descriptive of the goods sold by the Complainant and there is no evidence of any secondary meaning.

This Expert finds that the Complainant's case must fail in respect of the domain name propshaftservices.co.uk because the Complainant has failed to prove that it has any rights in the words PROPSHAFT or PROPSHAFT SERVICES.

Because the .co.uk ccTLD extension may be ignored for the purposes of making the comparison, this Expert finds that the disputed domain name driveshaftservices.co.uk is similar and almost identical to the Complainant's company name DRIVE SHAFT SERVICES LIMITED.

The Complainant has therefore satisfied the first element of the test in the DRS Policy with respect to the disputed domain name driveshaftservices.co.uk only.

Abusive Registration is defined in paragraph 11 of the DRS Policy as meaning "a Domain Name which either:

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

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

It is undisputed that the Complainant had engaged the Respondent to provide website services for approximately 11 years. In recent years the Complainant became unhappy with the services being supplied by the Respondent and the issues are set out in the content of a letter from the Respondent to the Complainant dated 14 November 2011.

The essence of the Respondent's case is that it is the registrant and rightful owner of both disputed domain names and that it has essentially provided the Complainant with a licence to use the domain names for a number of years.

The Respondent's position appears to be supported by a copy invoice from the Respondent to the Complainant, that has been adduced in evidence by the Complainant, dated 18 August 2003 in respect of the following: "Provide use of Domain Names on an annual fee basis from 08/08/03 to 07/08/04 (one year): www.driveshaftservices.co.uk www.propshaftservices.co.uk".

The invoice was addressed to Steven Richards as "buyer" and the contract address is "Drive Shaft Services Ltd., Plot 1A, Heol Mostyn, Village Farm Industrial Estate, Pyle, Bridgend, CF33 6BJ."

The following note appeared prominently on the face of the invoice: “NB The above name(s) will be provided for your exclusive use while you continue to pay the annual service fee(s) in advance. The fee includes Domain Name Server Services and Email Forwarding but not website content, hosting and mail server services.”

Similar invoices have been furnished in evidence, dated 9 August 2009 in respect of “Advance annual Domain Name service fees” from 8 August 2009 to 7 August 2010 and dated 30 July 2010 in respect of the period from 8 August 2010 to 7 August 2011 each of which also has the same additional wording

The Complaint is not well phrased and the Complainant does not quite state that its position is that the Respondent registered the disputed domain names for and on behalf of the Complainant and should now transfer them to the Complainant. However, it is perhaps implicit from the fact that the Complainant is bringing this Complaint. The Complainant’s position appears to be supported by the Respondent’s letter dated 14 November 2011 that sets out the Respondent’s position in respect of monies allegedly owed by the Complainant. It includes an item: “Original name registration fees: 2 X £80”. This would seem to indicate the Respondent’s intention to pass on the cost of the registration to the Complainant which in turn may indicate that the Respondent registered the domain names on behalf of the Complainant.

The issue between the Parties is therefore essentially a contract dispute and it may be for another forum to decide their respective contractual rights. The Complainant has not set out its claim in this regard with any clarity. The disputed domain names were registered in the year 2000. According to the Respondent the Complainant never paid for the registrations but paid the Respondent for the use of the disputed domain names from August 2002 until August 2009.

Furthermore the Complainant has stated that it reached an agreement with the Respondent and the Respondent has stated that it signed the agreement, so on those facts the agreement should be implemented. It is beyond the scope of the jurisdiction of this proceeding to determine these issues.

Similarly the correspondence sent by Nominet stating its view that the domain name driveshaftservices.co.uk is not registered to a legally identifiable person is not an issue for this Expert to address in the present Complaint.

This Expert finds that the Complainant’s claim with respect to the disputed domain name driveshaftservices.co.uk must fail also. The Complainant has failed to prove on the balance of probabilities that the disputed domain name in the hands of the Respondent is an Abusive Registration.

6. Decision

This Expert directs that no action should be taken in respect of the Complaint.

Signed James Bridgeman

Dated 13 February 2012