

DISPUTE RESOLUTION SERVICE

D00012672

Decision of Independent Expert

Steve Plant and Karen Spiers t/a Elite Specialist Glazing

and

Sharon Blackmore

1. The Parties:

Lead Complainant: Steve Plant and Karen Spiers
t/a Elite Specialist Glazing
29 Durkar Rise
Crigglestone
Wakefield
West Yorkshire
WF4 3QB
United Kingdom

Respondent: Sharon Blackmore
Upper Hoyle Ing Farm
Ingfield
Bradford
England
BD13 3DU
United Kingdom

2. The Domain Name:

<elitespecialistglazing.co.uk> (the Domain Name)

3. Procedural History:

The Complaint was filed with Nominet on 4 April 2013. Nominet validated the Complaint the same day and notified the Respondent by post and by email stating that the Response had to be received on or before 25 April 2013. The Respondent filed a Response on 25 April 2013 and Nominet notified the Complainant that a Reply had to be received on or before 3 May 2013. The Complainant submitted a Reply on 30 April 2013.

The informal Mediation procedure failed to produce an acceptable solution for the parties and so on 28 May 2013 Nominet informed the Complainant that it had until 11 June 2013 to pay the fee for the decision of an Expert pursuant to paragraph 7 of the Nominet Dispute Resolution Service Policy ("the Policy"). On 29 May 2013 the Complainant paid Nominet the required fee.

On 31 May 2013, the undersigned, David Taylor ("the Expert") confirmed to Nominet that he knew of no reason why he could not properly accept the invitation to act as an Expert in this case and further confirmed that he knew of no matters which ought to be drawn to the attention of the parties which might appear to call into question his independence and/or impartiality. The Expert was appointed on 6 June 2013.

On 31 May 2013 the Complainant submitted a non standard submission and so did the Respondent. The Complainant submitted a second, third and fourth non standard submission on 31 May, 12 and 14 June, respectively. On 14 June 2013 the Expert agreed to view the Complainant's non standard submissions in accordance with paragraph 13(b) of the Procedure. On 17 June 2013, the Expert invited the Respondent to submit a further statement in relation to the Complainant's non standard submissions and so on 25 June 2013 the Respondent submitted a further statement in accordance with paragraph 13(a) of the Procedure. In view of the number of non-standard submissions reviewed by the Expert, the Expert found that it was not necessary to examine any further submissions by the parties, in particular the non standard submissions filed by the Complainant on 19 and 25 June.

4. Factual Background

The Complainant is a partnership between Mr. Steve Plant and his wife, Mrs. Karen Spiers, trading as Elite Specialist Glazing since December 2012. The Complainant repairs and replaces windows in vehicles, including coaches and buses, on a mobile basis by visiting customers in its van at their own premises.

The Complainant holds a figurative trade mark (Number 2651869) for Elite Specialist Glazing (and Device), for goods and services in Class 37 with the United Kingdom Intellectual Property Office, which was registered on 7 June 2013.

The Respondent is Mrs. Sharon Blackmore, the wife of the owner of Reglaze Specialist Coach & Bus Glazing Ltd (hereinafter Reglaze), a company specialized in supplying and installing the replacement of coach and bus glass throughout the UK and Europe.

Mr. Steve Plant was an employee at Reglaze Specialist Coach & Bus Glazing Ltd from 31 January 2005 until 14 December 2012.

The Domain Name was registered by the Respondent on 16 January 2013.

The Domain Name does not resolve to any website.

The Complainant has made a claim for unfair and wrongful dismissal against the Respondent before an Employment Tribunal which appears to be ongoing.

5. Parties' Contentions

The Complainant

The Complainant's Rights

The Complainant states that it decided to set up its own business using the name Elite Specialist Glazing in December 2012 after Mr. Steve Plant was dismissed from his employment at the Respondent's company. The Complainant explains that initially it spent time buying tools and equipment and sorting out the branding of its new business. The Complainant further explains that it completed its first job on 7 January 2013 and had a gross turnover of £22,000 by April 2013. The Complainant considers that it should soon be in a position to repay all of its set up costs and begin to generate profit.

As evidence of commencement of trading, the Complainant has submitted a VAT registration certificate with an effective registration date of 14 December 2012.

The Complainant also applied to have its business name and logo registered as a trade mark on 11 February 2013 and has submitted the corresponding evidence from the United Kingdom Intellectual Property Office.

In addition, the Complainant has submitted its business card and stationary, a photograph of its business van and a copy of its business bank account containing the name Elite Specialist Glazing and logo.

Abusive Registration

The Complainant asserts that ever since the Complainant set up its own business in competition with the Respondent, there has been a lot of animosity between the Complainant and the Respondent. The Complainant further states that it has secured jobs from some of the Respondent's previous customers but that it won these jobs "fair and square by offering more competitive prices".

According to the Complainant, the Respondent became aware of its business activity on or around 7 January 2013 and its business name following an appeal letter dated 14 January, which the Complainant's son, who was also employed by the Respondent and was dismissed for assisting the Complainant in a job for an ex-customer of the Respondent, sent to the Respondent which referred to the name of the Complainant's business. The Complainant submitted a copy of the appeal letter sent to the Respondent.

The Complainant further states that since then, the Respondent and her husband have been trying to sabotage the Complainant's business by, among other things, registering the Domain Name as well as other domain names consisting of "elitespecialistglazing", including:

- elitespecialistglazing.com
- elitespecialistglazing.info
- elitespecialistglazing.net

These domain names were also registered on 16 January 2013.

The Complainant asserts that the Domain Name does not point to any website and that the Respondent registered it maliciously to prevent the Complainant from acquiring it.

The Complainant states that it has sent communications by email and by post to the Respondent on two occasions, in February and March 2013, seeking to obtain the transfer of the Domain Name but has not received any response.

The Complainant refers to paragraph 3 of the Policy and asserts that the registration of the Domain Name is abusive as the Respondent registered the Domain Name as a blocking registration against a name in which the Complainant has rights and in which the Respondent has no rights.

The Complainant further argues that the Respondent registered the Domain Name purely out of spite against the Complainant because the Complainant has set up a business in direct competition with the Respondent's business.

The Complainant further states that it is fearful that the Respondent may use the Domain Name to point to the website of the Respondent's husband's company at www.reglaze.co.uk, thereby damaging the branding and reputation of the Complainant's new business.

The Respondent

The Respondent states that Reglaze Specialist Coach and Bus Glazing Ltd, a company specialized in supplying and installing the replacement of coach and bus glass, was established over 10 years ago by the Respondent's husband.

The Respondent states that although she does not hold a position in her husband's company, she frequently helps him out with administrative tasks and staffing. The Respondent further asserts that although the Respondent's husband's company is a relatively small company, she and her husband have worked hard over the past 10 years to build their business.

The Respondent explains that the Mr. Steve Plant worked for the Respondent's company for approximately 8 years in the position of Manager but that Mr. Plant was dismissed for gross misconduct in December 2012.

The Respondent states that the registration of the Domain Name is not abusive for the following reasons:

The Respondent asserts that her company has purchased numerous domain names over the years, including the Domain Name.

The Respondent asserts that in September 2012, the Respondent, her husband and Mr. Steve Plant held a meeting to come up with ideas to increase profit and discussed various names for a new subsidiary company, including the name "Elite", for glass balconies and office glass dividers. As evidence, the Respondent provides scanned hand-written notes and a PDF file of a power point presentation that was used during said meeting.

The Respondent asserts that the Complainant is using a name which the Complainant knew was discussed as a potential name for the Respondent's subsidiary company. The Respondent further states that although the Respondent and her husband have not set up their subsidiary company yet, given that their coach and glass work picked back up, the name Elite Specialist Glazing was thought of for their subsidiary company whilst the Mr. Steve Plant was still employed by the Respondent.

Furthermore, the Respondent states that the Complainant is trying to take the Respondent's company out of the market and that the Complainant is contacting the Respondent's customers advising them how much they are being "ripped off".

The Respondent asserts that she has not maliciously purchased the Domain Name but that she purchased it *"to protect Reglaze and Reglaze's subsidiary company should we decide to use these names further to our meeting in September 2012"*.

The Complainant's Reply

In its Reply, the Complainant denies that a brainstorming meeting where potential names for a new subsidiary company were discussed ever took place. According to the Complainant, this story has been fabricated by the Respondent to try to justify the registration of the Domain Name.

The Complainant argues that the handwritten notes submitted by the Respondent as evidence of such meeting are undated and could have been written by the Respondent at any time.

Furthermore, the Complainant asserts that the properties of the PDF file submitted as evidence by the Respondent demonstrate that the date of creation of said document was 25 April 2013 and therefore could have not existed when the meeting supposedly took place. In addition, the Complainant asserts that if the purpose of such meeting was to brainstorm names for a new subsidiary company, then it does not make sense that the name of Elite Specialist Glazing was already contained in the PDF document.

The Complainant asserts that the Respondent has produced false documents to try to support the registration of the Domain Name.

The Respondent's 13(b) non standard submission

The Respondent asserts in its 13(b) non standard submission that the PDF document submitted as evidence was not fabricated and that the properties of the document changed when the PowerPoint document was converted into PDF. The Respondent submitted a letter from her Solicitor restating this claim.

The Complainant's 13 (b) non standard submissions

In the Complainant's first 13(b) non standard submission, the Complainant submitted evidence consisting of a letter from one of the Respondent's ex-customers to rebut the Respondent's accusations that the Complainant is contacting Respondent's customers.

In the Complainant's second 13(b) non standard submission the Complainant insisted that the Respondent should submit evidence of the date of the original power point presentation. In addition the Complainant informed the Expert that its trade mark had been published and had not been subject to any opposition.

The Complainant's third 13(b) submission included evidence of the Complainant's son's Twitter account showing a "tweet" from 14 January 2013 which stated the following: "ELITE SPECIALIST GLAZING – family business me, dad, step mum :) woووо loving the logo design, name idea was mine" and attaching a picture of the Complainant's logo. Earlier that same day, the Complainant's son had also "tweeted" that he had been "sacked" from his job.

The Complainant's fourth 13(b) submission included the Complainant's trade mark registration certificate for ELITE SPECIALIST GLAZING, issued on 7 June 2013, after

the filing of the Complaint. The Complainant further stated that such trade mark registration was not subject to opposition by other parties, including the Respondent.

The Respondent's 13(a) submission

In the Respondent's 13(a) submission requested by the Expert the Respondent stated concerning the power point presentation that *"It was created on an old laptop at home of which we did nothing with after the meeting as Reglaze work started to pick up & at this stage we didn't need to branch out"*.

The Respondent further added that: *"I believe April time when we were aware that [the Complainant] was registering the name through the Intellectual Property Office we decided at this point that we were not going to have a required need for this name despite it been originally discussed for use whilst [the Complainant] was employed at Reglaze, so we offered the Domains to [the Complainant] at the price we paid, she declined"*.

Finally, the Respondent stated that she purchased the Domain Name because she is *"commercially aware and buy a lot of domain names and not because I am malicious - had I been malicious I would have set websites up by now and started to promote Reglaze, but as you aware this hasn't happened, I have done nothing with the domains. Surely (sic) if no one had registered the name 'Elite specialist Glazing' & it wasn't apparent anyone had at the stage I purchased them, the domains were free for anyone to purchase at that time!"*

6. Discussions and Findings

Further Submissions

Paragraph 5.9 of the Nominet Dispute Resolution Service Experts' Overview (the "Experts' Overview") provides the following:

"The Procedure is intended to provide a satisfactory basis for expeditious and cost-effective resolution of domain name disputes within the ambit of the Policy. Unsolicited further statements from the parties tend to run counter to that intention. If one party is permitted to submit a further statement, the Expert will normally, in the interests of justice, permit an answering submission from the other party. The case gets weighed down with paper and delays ensue. Experts will normally require an explanation from the party wishing to submit an additional submission, justifying a departure from the prescribed procedure.

On occasion, Experts will decide that in order to come to a just decision, they need further information from one or other or both of the parties. In such circumstances a request will be issued by the Expert for further information pursuant to Paragraph 13.a. of the Procedure. However, this power will be exercised with caution. Not only does it risk prolonging the proceeding, it can also effectively allow one party to improve its case to the prejudice of the other party. If parties get the idea that they can simply improve their cases as the proceeding progresses, there will be no incentive upon them to adhere to the Procedure and put their best case forward first time around".

In the present case, the Expert considered that in order to be able to reach a just decision, further information from the parties was useful and so the Expert exercised his discretion to accept unsolicited submissions from the parties, in spite of the implications set out above. However, once the Expert gave the Respondent the opportunity to reply, the Expert considered that the evidence before him was sufficient and so the Expert decided that it was not necessary to examine any further unsolicited submissions from the Complainant.

General

Under paragraph 2(a) of the Policy, in order to obtain the transfer of the Domain Name, the Complainant is required to demonstrate, on the balance of probabilities, both of the following elements:

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

(ii) The Domain Name, in the hands of the Respondent, is an Abusive Registration."

Complainant's Rights

Concerning paragraph 2(a)(i), paragraph 1 of the Policy defines "Rights" as follows:

"Rights means rights enforceable by the Complainant, whether under English law or otherwise, and may include rights in descriptive terms which have acquired a secondary meaning."

In the present case, the Complainant's trade mark rights post-date registration of the Domain Name. However, the Policy does not require Rights that pre-date the registration of the disputed domain name but simply for the Complainant to demonstrate that it has enforceable Rights in accordance with the Policy (see paragraph 2.3 of the Experts' Overview, which states that the objective of the first hurdle of the Policy is that the Complainant demonstrates a *bona fide* basis for filing a complaint).

Thus, the fact that the Complainant's Rights post-date the registration of the Domain Name is immaterial in assessing the Complainant's Rights for the purpose of the first hurdle of the Policy. However, it should be noted that this fact may be of relevance when assessing whether the Domain Name is an Abusive Registration under paragraph 2(a)(ii), as discussed further below (see Nominet Decision DRS 9464 (<adoptaguy.co.uk>)).

Furthermore, paragraph 2(a)(i) of the Policy provides that the name or mark in which the Complainant has Rights must be identical or similar to the Domain Name. It is well-established that the .CO.UK suffix is irrelevant for the purpose of assessing identity or similarity between a trade mark and a domain name and so the only difference between the Domain Name and the Complainant's trade mark is the fact that the trade mark is a figurative mark, consisting of three slanted rectangles with the words ELITE SPECIALIST GLAZING appearing in capital letters underneath. The Expert is of the opinion that this difference is insignificant, particularly given that the verbal components are the predominant features of the sign and so the Expert finds that the Complainant's trade mark is similar to the Domain Name.

In view of the foregoing, the Expert finds that the Complainant has Rights in respect of a mark which is similar to the Domain Name, in accordance with paragraph 2(a)(i) of the Policy.

Abusive registration

Turning to the second limb, paragraph 2(a)(ii) of the Policy requires the Complainant to prove that the Domain Name is an 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 has taken unfair advantage of or has been unfairly detrimental to the Complainant's Rights".

A complainant must prove one or both of these on the balance of probabilities.

Paragraph 3(a) of the Policy sets out a non-exhaustive list of factors which may be evidence of abusive registration of a domain name. In its Complaint, the Complainant expressly relies on paragraph 3(a)(i) of the Policy, which provides that the following may be indicative of an Abusive Registration:

"(i) Circumstances indicating that the Respondent has registered or otherwise acquired the Domain Name primarily:

B. as a blocking registration against a name or mark in which the Complainant has Rights".

Concerning a blocking registration, the Expert finds helpful the *Delamar Academy v. Go-Catch Media Limited* decision, DRS 1543 (<delamaracademy.co.uk>), which provides an overview of key Nominet decisions addressing this issue, in accordance with paragraph 3(a)(i)(B). In that decision, the expert referred to *Peoplesoft UK Ltd v KL Kane*, DRS 00120 (<peoplesoft.co.uk>), which defined a blocking registration as a registration that is:

"1. designed to prevent a legitimate owner of rights in a name from registering and using the associated domain name; and

2. carried out in circumstances when the respondent is unable to demonstrate a prima-facie right in the name or valid reason to make the registration."

This view was partially rejected in *Thomas Cook UK Limited v. Whitley Bay Uncovered*, DRS 00583 (<club18-30uncovered.co.uk>) as it seemed to suggest that the Respondent has the burden of proving *prima facie* a legitimate interest in the disputed domain name. Thus, the expert in *Thomas Cook* suggested rewording the second limb of the "test" set out in *Peoplesoft* to the following:

"2. carried out in circumstances in which it is shown, on the balance of probabilities, that the Respondent has no right in the name and no valid reason to make the registration".

In addition, the expert in *Thomas Cook* held that a key element of a "blocking registration" is motivation or intent: *"Where a registration is alleged to be a 'blocking registration' a complainant, if it is to succeed, must prove on the balance of probabilities that a respondent's principal objective in registering or retaining the disputed domain name was to prevent the complainant from doing so."*

In the present circumstances, the Expert considers that, on the balance of probabilities, the Respondent registered the Domain Name primarily to block the Complainant from doing so after having discovered the Complainant's business, which is in direct competition with the Respondent's. The Expert accepts this view for the following two reasons:

First, the Expert finds that the circumstances surrounding the registration of the Domain Name, in particular the fact that the Domain Name was registered by the Respondent on 16 January 2013 shortly after the Respondent had become aware of the Complainant's business name, as evidenced by the letter dated 14 January 2013 sent to the

Respondent by the Complainant's son, is a strong indication that the Respondent's motivation behind the registration of the Domain Name was to prevent the Complainant from registering the Domain Name rather than any other reason.

Secondly, although the Respondent claims that she registered the Domain Name further to a meeting held for the purpose of brainstorming ideas for a name for a subsidiary company, which the Complainant allegedly attended, and has provided as evidence handwritten notes and a PDF document of a power point presentation, the probative value of such evidence is questionable as both pieces of evidence are undated. However, notwithstanding this evidentiary deficiency, the Expert is of the opinion that even if dated, such evidence would still be insufficient to justify the Respondent's behaviour.

Furthermore, the Respondent has not invoked any of the circumstances set out in Paragraph 4(a) of the Policy which a respondent may rely on to demonstrate that a domain name is not an Abusive Registration, in particular the following relevant circumstances:

"(i) Before being aware of the Complainant's cause for complaint (not necessarily the 'complaint' under the DRS), the Respondent has:

A. 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;

B. been commonly known by the name or legitimately connected with a mark which is identical or similar to the Domain Name;

C. made legitimate non-commercial or fair use of the Domain Name."

The Expert has carefully considered the Respondent's submissions and is of the opinion that none of the defences set out above would seem to assist the Respondent's case. In particular, the Respondent has not used the Domain Name nor is the evidence submitted by the Respondent consisting of undated handwritten notes and a power point presentation sufficient in this particular case to persuade the Expert that the Respondent has made "demonstrable preparations to use the Domain Name". Neither is the Respondent commonly known by the Domain Name nor is it making a legitimate non-commercial or fair use of the Domain Name.

In summary, the Expert has considered the admissibility, relevance, materiality and weight of the evidence as a whole and is satisfied that the Complainant has succeeded in proving, on balance of probabilities, that the Domain Name is an Abusive Registration in accordance with paragraph 2(a)(ii) of the Policy.

7. Decision

In light of the foregoing findings, namely that the Complainant has Rights in respect of a name or mark which is similar to the Domain Name and that the Domain Name, in the hands of the Respondent, is an Abusive Registration, the Expert directs that the Domain Name be transferred to the Complainant.

Signed: David Taylor

Dated: 9 July 2013