

DISPUTE RESOLUTION SERVICE

D00013657

Decision of Independent Expert

WH Ireland Limited

and

Mr David Smith

1. The Parties:

Complainant: WH Ireland Limited
11 St James's Square
Manchester
Lancashire
M2 6WH
United Kingdom

Respondent: Mr David Smith
10 Chelsea Close
Edgware
HA8 5TG
United Kingdom

2. The Domain Name:

whireland.co.uk (“the Domain Name”)

3. Procedural History:

I can confirm that I am independent of each of the parties. To the best of my knowledge and belief, there are no facts or circumstances, past or present, or that could arise in the foreseeable future, that need be disclosed as they might be

of such a nature as to call in to question my independence in the eyes of one or both of the parties.

Here is the formal procedural history of this case:

19 December 2013 11:21 Dispute received
19 December 2013 11:30 Complaint validated
19 December 2013 11:52 Notification of complaint sent to parties
10 January 2014 01:30 Response reminder sent
15 January 2014 08:33 No Response Received
15 January 2014 08:33 Notification of no response sent to parties
22 January 2014 17:08 Expert decision payment received

4. Factual Background

The Complainant is a financial services company.

The Respondent registered the Domain Name on 18 November 2013.

On 29 November 2013, the Complainant emailed the registrar of the Domain Name claiming that the website at the Domain Name was “fraudulent” and a plagiarised version of the Complainant’s own website. The registrar responded on 13 December 2013 confirming that it had disabled all services associated with the Domain Name.

5. Parties’ Contentions

Complaint

The Complainant claims to have been established in 1872. It says that it is part of WH Ireland Group plc and that it is a financial services company offering many services including private wealth management, wealth planning, research, market making, corporate finance and corporate broking.

The Complainant claims to have funds under management of £1.7 billion with turnover in excess of £25m. These services are provided “to all UK citizens and businesses”. The Complainant says it has 12 offices across the UK.

The Complainant says that its “current domain name” is wh-ireland.co.uk, registered in 1999.

The Complainant says that it never authorised the Respondent to register the Domain Name and that it became aware of a plagiarised version of its website at the Domain Name on 29 November 2013.

The Complainant says it cannot supply a screenshot of the plagiarised website because the services associated with the Domain Name have been disabled, as explained in section 4 above. The Complainant explains that the website used identical branding, images, fonts and colours to those used on the Complainant's own website. The website purported to represent the Complainant, when it had no authority to do so. This was a clear breach of copyright.

The Complainant expresses grave concern that this copy of our website directed new and/or existing clients to persons unconnected with the Complainant, thereby threatening the Complainant's reputation, its brand, and its client relationships. The Complainant asserts that the Financial Conduct Authority will expect the Complainant, whom it regulates, to take every reasonable step to ensure this does not happen.

Response

The Respondent did not file a Response.

6. Discussions and Findings

General

To succeed, the Complainant has to prove in accordance with paragraph 2 of the DRS Policy on the balance of probabilities, first, that it has rights (as defined in paragraph 1 of the DRS Policy) in respect of a name or mark identical or similar to the Domain Name and, second, that the Domain Name, in the hands of the Respondent, is an abusive registration (as defined in paragraph 1 of the DRS Policy).

Complainant's rights

The meaning of "rights" is clarified and defined in the DRS Policy in the following terms:

"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"

The Complainant does not invoke any registered trade mark. Instead it bases its case on unregistered rights in the name "WH Ireland".

Paragraph 2.2 of the DRS "Expert's Overview" on Nominet's website states that, in the case of an unregistered trade mark right, evidence needs to be put before the Expert to demonstrate the existence of the right:

“This will ordinarily include evidence to show that (a) the complainant has used the name or mark in question for a not insignificant period and to a not insignificant degree (e.g. by way of sales figures, company accounts etc) and (b) the name or mark in question is recognised by the purchasing trade/public as indicating the goods or services of the complainant (e.g. by way of advertisements and advertising and promotional expenditure, correspondence/orders/invoices from third parties and third party editorial matter such as press cuttings and search engine results).”

Despite this, and despite the extensive guidance on Nominet’s website warning of the need for evidence to back up parties’ assertions, the Complainant has not provided a single piece of evidence in support of its assertions as to rights.

The second sentence of paragraph 16(a) of the DRS Procedure enables experts to view websites mentioned in parties’ submissions although paragraph 5.10 of the Expert’s Overview cautions that no party should assume that an expert will necessarily do so and that, if the content of a website is considered important, the safest course is to exhibit website printouts.

I have in fact decided to view the Complainant’s website. This decision was not taken without some hesitation, as a passing reference to the Complainant’s own website is not really a substitute for the actual provision of supporting evidence as to rights.

However, having viewed the website, it is plain that the Complainant is part of a substantial, indeed publicly-quoted, group which has been trading under the name “WH Ireland” to a substantial degree for many years.

In view of this information, as well as the distinctiveness of the name, the lack of a Response from the Respondent and the fact that the establishment of rights is regarded as a low threshold test, I conclude that the Respondent has – very narrowly – established rights in the name “WH Ireland” and that this is identical to the Domain Name.

Abusive registration

Is the Domain Name an abusive registration in the hands of the Respondent? Paragraph 1 of the DRS 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 took unfair advantage of or was unfairly detrimental to the Complainant’s Rights.”***

The gist of the Complainant’s case is that the Domain Name was used for a website which was a plagiarised version of the Complainant’s own website and

which effectively claimed to represent the Complainant. Unfortunately the Complainant omitted to take a screenshot and the website has now been removed.

The Complainant does, however, provide a small degree of corroboration in the form of a complaint by it to the registrar of the Domain Name in which the Complainant makes the same assertion of plagiarism as it does here.

In any case, the Domain Name reflects exactly the Complainant's distinctive name and it is difficult to conceive of any genuine purpose for which a third party might wish to select and use such a domain name. The Respondent has not seen fit to defend the proceedings and provide an explanation.

In these circumstances, I conclude that, on the balance of probabilities, the Domain Name is an abusive registration in that it has been registered and/or used in a manner which took unfair advantage of or was unfairly detrimental to the Complainant's rights.

7. Decision

I find that the Complainant has rights in a mark which is identical to the Domain Name and that the Domain Name is, in the hands of the Respondent, an abusive registration. I therefore direct that the Domain Name, whireland.co.uk, be transferred to the Complainant.

Signed: Adam Taylor

Dated: 12 February 2014