

DISPUTE RESOLUTION SERVICE

D00014121

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

Plantation Shutters Limited

and

Ms Kirsteen MacDonald

1. The Parties:

Lead Complainant: Plantation Shutters Limited
Plantation Shutters Limited
Unit 10 River Reach
Gartons Way
London
SW11 3SX
United Kingdom

Respondent: Ms Kirsteen MacDonald
121 Fotheringay
Glasgow
G41 4LG
United Kingdom

2. The Domain Name(s):

plantationshutters.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 paragraphs 2 and 4 of the Procedure.

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 **plantationshutters.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. Comments (optional)

No timely Response was received by Nominet (even after the Response reminder of 23 May 2014) prior to appointment of the Expert in this case, which was expected to be a simple Summary Decision on that basis.

However, the Respondent subsequently made a late submission under Rule 13b of the Procedure. The Expert then invited the Complainant to submit a reply under Rule 13a, which was also submitted late, but which has also been considered by the Expert as a matter of equity.

The Complainant has asserted that it has rights and goodwill in Plantation Shutters as the name of its business. It has submitted evidence of apparent misrepresentations by the Respondent arising from use of the disputed Domain Name.

The Domain Name was registered as of 27 January, 2006 with the public WhoIs record identifying the registrant only as "MurdochMac" and purporting to be "a non-trading individual", when registering the Domain Name.

For the Complainant to succeed, it must prove to the Expert, on the balance of probabilities, both that it has Rights in respect of a name or mark, which is identical or similar to the Domain Name; and that the Domain Name, in the hands of the Respondent, is an Abusive Registration as defined in Paragraph 1 of the Policy.

The problem for the Complainant with respect to a claim to Rights is that it admits that “plantation shutters” has become a recognised descriptive term for a type of window shutter with adjustable slats, even though it says that term was first introduced by the Complainant itself in the 1990s. The Complainant seems to have failed to understand the impact that this descriptive use would have on any potential trade mark rights. Effectively the Complainant appears to have allowed the term “plantation shutters” to become generic in the trade for this particular type of shutter. (This is NOT like VELUX, as the Complainant erroneously suggests in its Reply. That VELUX is a trade mark may be misunderstood by ordinary consumers (like HOOVER), but it is a widely registered and enforced trade mark, which the Danish proprietors certainly would not permit other businesses to misuse descriptively for another firm’s products.)

The Complainant’s claim to have Rights is therefore potentially weak.

It does have a Company Name Registration 3070306 for Plantation Shutters Limited, dating from 1995.

As noted in the current Experts’ Overview, paragraph 1.7 though: “The consensus view of recent Experts’ meetings has been that mere registration of a company name at the Companies Registry does not of itself give rise to any rights for this purpose.”

However, from the Complainant’s evidence it does appear that the Complainant’s business has established some reputation and, more importantly, some recognisable goodwill with customers, who clearly do understand the difference between “Plantation Shutters” as a business name rather than “plantation shutters” as just the generic product description.

While the extent of this goodwill is arguably very limited, it would be unreasonable to consider it to be non-existent. It would seem to extend at least to the services of supply and fitting of shutters under the business name of Plantation Shutters. On balance, the Expert is prepared to accept that the Complainant also had such goodwill in 2006 before the Domain Name was registered – goodwill in the original business was certainly recognised in the 1995 Purchase Agreement.

In the Expert’s view, this would give the Complainant some minimal rights at least against use of the identical business name and trading style, and perhaps enough to support a Companies Name Tribunal complaint against a very similar Company Name.

The disputed Domain Name, plantationshutters.co.uk, adopts the identical format to the Complainant's business name, with no additional elements whatever.

Thus, for the purposes of the Policy, the Expert is prepared to find that the Complainant has more than a mere company name registration and that it does have some, albeit narrow, Rights under the Policy in respect of a name which is essentially identical to the Domain Name. (Even though those Rights might indeed be so narrow as to be inapplicable against use of "plantation shutters" with additional distinguishing elements, the Domain Name here has none.)

The evidence also shows that the Domain Name has been used unfairly for commercial purposes adverse to the Complainant's Rights. In the Expert's view, the fact that the Respondent's true identity was concealed at the time of registration with a claim to be for a non-trading individual, and that the business which has used it subsequently, has used it commercially to attract business, and has misrepresented itself as trading as "Plantation Shutters" to customers of the original Plantation Shutters business, suggests strongly that the Domain Name was registered and has been used in a manner which was intended to take, and which has taken, unfair advantage of, and has been unfairly detrimental to, the Complainant's Rights.

Consequently, the Expert finds that the Domain Name, in the hands of the Respondent, is an Abusive Registration for the purposes of the Policy.

8. Decision

Transfer	<input checked="" type="checkbox"/>	No action	<input type="checkbox"/>
Cancellation	<input type="checkbox"/>	Suspension	<input type="checkbox"/>
Other (please state)	<input type="checkbox"/>		

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Signed:
Keith GYMER

Dated: 18 June, 2014