

**DISPUTE RESOLUTION SERVICE**

**D00015029**

**Decision of Independent Expert**

Heald Solicitors LLP

and

Mr Philip Martin

**1. The Parties**

Complainant: Heald Solicitors LLP  
Ashton House  
471 Silbury Boulevard  
Milton Keynes  
Buckinghamshire  
MK 9 2AH  
United Kingdom

Respondent: Mr Philip Martin  
Broadlands  
Church Lane  
Little Linford  
Milton Keynes  
Buckinghamshire  
MK19 7EE  
United Kingdom

**2. The Domain Name**

<healdsolicitors.co.uk> ("the Disputed Domain Name")

**3. Procedural History**

The Complaint was filed with Nominet on 11 November 2014. The next day Nominet notified the Respondent by post and by email, and the Response was received the same day. Nominet notified the Complainant that a Reply had to be received on or before 19 November 2014 and the Reply was filed on 18 November 2014. The mediator was appointed on the same day.

The Informal Mediation procedure failed to produce an acceptable solution for the parties and so on 9 December 2014 Nominet informed the Complainant that it had until 23 December 2014 to pay the fee for the decision of an Expert pursuant to paragraph 7 of the Nominet Dispute Resolution Service Policy ("the Policy"). On 18 December 2014 the Complainant paid Nominet the required fee.

On 23 December 2014 the undersigned, Jane Seager ("the Expert"), confirmed to Nominet that she was independent of each of the parties and that, to the best of her knowledge and belief, there were no facts or circumstances, past or present (or that could arise in the foreseeable future) that needed to be disclosed as they might be of a such a nature as to call in to question her independence in the eyes of one or both of the parties.

#### **4. Factual Background**

The Complainant is a law firm based in Milton Keynes. Its website is available at [www.healdlaw.com](http://www.healdlaw.com).

The Respondent is Mr Philip Martin. He previously used the Complainant's conveyancing services but was not satisfied with them.

The Respondent registered the Disputed Domain Name on 29 September 2014. It is currently pointing to a website headed "*Review of Heald Solicitors Milton Keynes*" which contains the following text:

*"5th November 2014*

*This website exists to highlight a shocking set of experiences which a Professional Property Investor was subjected to, when he instructed Heald solicitors in Milton Keynes.*

*Breaches of Client Confidentiality, Deliberate Delays, Unprofessionalism, Deliberate Lies, Over-billing and Failure to Communicate are just some of the allegations being researched for merit before publication*

*Full information is being compiled and will be posted here once legal advice is finalised."*

Underneath there is a link that reads "*Are Heald the Worst Ever Conveyancing Solicitors?*" which directs users to a discussion forum for landlords (although when the Expert reviewed this forum no mention appeared to be made of the Complainant).

The website also invites internet users to submit comments if they have experienced problems with the Complainant, and also offers to publish any comments the Complainant would like to make in reply. However at the time of writing no comments had been published on the website (although there is a section which is password protected).

At the bottom of all three currently available pages the website also contains the following disclaimer:

*"This Site is not affiliated to Heald Solicitors in anyway and is an independent review site. Heald Solicitors can be contacted via [www.healdlaw.com](http://www.healdlaw.com)."*

On 30 September 2014 the Complainant notified the Respondent of his right to complain to the Legal Ombudsman about the services supplied, and the Respondent's reply the next day included the following statements:

*"I have just registered www.healdsolicitors.co.uk and I intend to make my very public thoughts known on a dedicated website as soon as my complaint goes to the legal ombudsman.*

*This is not a threat.*

*To be entirely clear, by advising you of my next steps, I am not soliciting a response or a variation of your stance.*

*I am just alerting you to how aggrieved I am."*

On 7 November 2014 the Complainant asked the Respondent to transfer the Disputed Domain Name to it. On the same day the Respondent refused and stated *"I will be using the domain name as an information gathering and opinion sharing review site about Heald Solicitors which is an entirely legitimate purpose and so I have neither the intention nor the obligation to transfer the domain name to you."*

## **5. Parties' Contentions**

### **Complaint**

#### Complainant's Rights

The Complainant asserts its rights in the name HEALD SOLICITORS. The Complainant states that it has traded as a firm of solicitors under the name Heald for over 30 years and thus has unregistered trade mark rights in this name for the provision of regulated legal services in England & Wales. The Complainant asserts that HEALD SOLICITORS is the name used on the Complainant's correspondence, email and letterhead, and attaches evidence in support of this. It is also the name used by the Complainant when entering into contracts with its clients and suppliers.

The Complainant states that its client base extends outside the UK, and that it is known to both local and international clients and contacts as Heald Solicitors. The name in question is recognised by the public and the Complainant's clients as indicating services provided by Heald Solicitors. So far as the Complainant is aware, the Respondent has no registered rights in any trade marks which comprise all or part of the Disputed Domain Name. According to the Complainant, a substantial amount of time, effort and cost has been invested by the Complainant in order to generate goodwill in the Complainant's name, to build up clientele and to acquire an established and well-regarded reputation in the legal world.

#### Abusive Registration

The Complainant states that it relies on two of the factors set out at paragraph 3 of the Policy, as follows:

3(a)(i) the Disputed Domain Name was registered primarily for the purpose of unfairly disrupting the business of the Complainant and as a blocking registration against a name or mark in which the Complainant has Rights; and

3(a)(ii) the Respondent is using the Disputed Domain Name in a way which is likely to confuse people or businesses into believing that the Domain Name is registered to, operated or authorised by, or otherwise connected with the Complainant.

The Complainant argues that the Disputed Domain Name has been registered (having regard to the Respondent's stated intention to seek redress from the Legal Ombudsman) in bad faith, and will be unfairly detrimental to the character and reputation of the Complainant. The Complainant points out that there is no variation between the Disputed Domain Name and the domain name used by the Complainant to point to its website (disregarding the .CO.UK suffix) except that the Respondent has refrained from using the word "law" following Heald and has added the word "solicitors", the use of which to describe a person or business qualified to provide legal services is restricted under the law of England and Wales.

The Complainant argues that bad faith is illustrated by the fact that not only does the Respondent have the benefit of a complaints procedure in accordance with the statutory regulatory requirements under which the Complainant is required to operate, but also has the benefit of an independent Legal Ombudsman to whom unresolved disputes about quality of services may be referred. In the Complainant's opinion, the existence of both of these procedures means that the Respondent has mechanisms to obtain independently assessed redress, if appropriate. The Complainant therefore concludes that there is nothing but bad faith that can lie behind the actions of the Respondent.

The Complainant affirms that it does not contest the Respondent's freedom to criticise the Complainant. Instead, it contests the right of the Respondent to appropriate the Complainant's name and trade mark in the Disputed Domain Name. In the Complainant's opinion, it is the Respondent's use of a Domain Name that is identical to the Complainant's trade mark that leads to Abusive Registration. The Complainant cites DRS 3161 (<clydesdaleconservatories.co.uk>), a case involving a criticism site, where the Expert reached the conclusion that:

*"It is the Respondent's choice of Domain Name which is identical to the Complainant's trading name that falls foul of the Policy, not the Respondent expressing his views about the Complainant."*

The Complainant also makes reference to the following paragraph in DRS 12643 (<compairsystems.co.uk>):

*"In most circumstances where a Respondent has registered a domain name that is identical or similar to a name or mark in which the Complainant has rights, the name or mark is well known, and the Complainant and marks were known to the Respondent, one would be unlikely to have a great deal of difficulty in concluding, as many Experts have previously, that the relevant domain name would be an abusive registration."*

The Complainant argues that there is no legitimate reason for the Respondent's registration of the Disputed Domain Name. The Respondent has stated his intention to make a complaint to the Legal Ombudsman and so, in the Complainant's opinion, dedicating a site to the criticism of the Complainant can bring no resolution to this matter. The Complainant points out that previous decisions under the Policy have found that, in cases where a domain name is used for a criticism site, an important factor in determining whether it is abusive is whether the trade mark and domain name are identical, as they are in this case. The Complainant asserts that the Disputed Domain

Name is not generic or descriptive because the words "Heald" and "solicitors" have no meaning other than to identify the Complainant's business. In DRS 00048 (<pharmacia.org.uk>), the Complainant points out that the expert found that the respondent had unfairly diverted users seeking information on the complainant and its products to a criticism site by use of a domain name that was identical to the trade mark, thereby taking unfair advantage of that trade mark. In the Complainant's opinion, the Respondent has used the conjoined words "Heald" and "solicitors" likewise in the Disputed Domain Name.

The Complainant underlines that the Respondent was aware of the Complainant's brand and business at the time of registration of the Disputed Domain Name. The Complainant states that the Respondent has selected the Disputed Domain Name for its association with the Complainant's business for the sole purpose of criticism. The Complainant refers to the expert's commentary in DRS 04198 (<mossandcoleman.co.uk>):

*"the choice of a Domain Name identical to the Complainant's name appears to have been made to achieve maximum impact for the Respondent's criticism site. It is clear that the primary purpose for which the Respondent chose the Domain Name identical to the Complainant's name, has been to divert as many Internet users as possible seeking information about the Complainant to the Respondent's criticism website. It is well-understood that the technology of Internet navigation results in this outcome, if the domain name chosen is identical to the name of a targeted business."*

In addition, the Complainant asserts that the Respondent has chosen the Disputed Domain Name, identical to the Complainant's trade mark, to achieve maximum damage to the Complainant's efforts to establish a presence on the internet for the purposes of offering its services.

The Complainant points out that, in the court case *BT v One in a Million* in 1999, the English courts clearly held that the:

*"mere registration of a domain name can constitute unfair use of a domain name for the purposes of passing off and trade mark infringement, even if nothing more is done with the domain name."*

The Complainant asserts that the Nominet Experts' Overview is consistent with this ruling. Therefore, even if the Respondent intends to use the Disputed Domain Name for the sole purpose of information gathering and opinion sharing, the Complainant argues that the simple fact that he has registered it in the knowledge that it is identical to the Complainant's business name, and done so as a reaction to a complaint that the Respondent has raised with the Complainant, is in itself abusive.

The Complainant also submits that allowing the Respondent to use the Disputed Domain Name will not only cause initial interest confusion with clients searching online for legal services but will significantly disrupt the Complainant's goodwill and reputation acquired through years of service. The Complainant states that it is highly likely that internet users visiting the Respondent's website in expectation of finding the Complainant's website will view the content thereof and as a result may be persuaded to divert from using the Complainant's services, which would be unfairly disruptive to the Complainant's business and very likely constitute an abusive use of the Disputed Domain Name (see DRS 02223 <itunes.co.uk>).

The Complainant again refers to the expert's commentary in DRS 04198 (<mossandcoleman.co.uk>):

*"the right of the Respondent to criticise does not extend to registering the Domain Name which is identical to the Complainant's trade name. The Expert has found no case decided under the DRS in which such a registration and use of an identical domain name, whether for purposes of criticism or tribute, has been considered fair use."*

The Complainant argues that the Respondent cannot assert fair use in accordance with paragraph 4(b) of the Policy and makes reference to the Appeal in DRS 00389 (<scoobydoo.co.uk>) where the Panel commented that *"Impersonation can rarely be fair."*

Finally the Complainant points out that the word "Solicitor" is a reserved word only usable in England and Wales by people supplying legal services who have a practicing certificate issued by the Solicitors Regulatory Authority. The Respondent's use of the word "Solicitor" is therefore misleading because he is not a solicitor and is not able to give legal advice. In the Complainant's opinion, this could have a negative effect on the Heald name and deter potential clients from considering the Complainant as a legitimate law firm.

The Complainant concludes that the Disputed Domain Name is an Abusive Registration and requests that it be transferred.

### **Response**

The Respondent's Response is very brief and may be reproduced in its entirety as follows:

*"The website has been established as a review site about property investors' experiences. This is an entirely legitimate purpose and is not an abusive registration.*

*The website has not been established 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;*

*Neither has the website been established to block the complainant, who was already trading under the name HealdLaw.*

*Neither has the website been established for the purpose of unfairly disrupting the business of the Complainant. There is no aim to cause confusion, the [sic] purpose of the review site is entirely clear.*

*I have made legitimate non-commercial and fair use of the Domain Name as a review site, before this process was started by Heald Law."*

### **Reply**

In Reply, the Complainant attaches an email exchange between the Complainant and the Respondent on 29 September 2014 in which the Complainant refuses to repay the Respondent on the basis that the amounts in question were correctly incurred. The

Respondent replies that he is confident that the Complainant will do so in due course and with additional motivation. The Disputed Domain Name was registered on the same day.

The Complainant therefore argues that the timing of the registration makes it apparent that the reason was not primarily to establish a review site but to apply additional motivation pursuant to the Respondent's demands for repayment. In the Complainant's view the Respondent's assertion that he made legitimate, non-commercial and fair use of the Disputed Domain Name before the process was started is therefore incorrect.

## **6. Discussion and Findings**

### **General**

Under paragraph 2(a) of the Policy, for the Expert to order a transfer of the Disputed 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**

The Policy defines Rights as "*rights enforceable by the Complainant, whether under English law or otherwise*".

The Expert is satisfied, based on the evidence presented, that the Complainant has the necessary Rights in the term HEALD SOLICITORS. Even though the Complainant has no registered trade mark rights, the Expert is satisfied that it possesses common law rights, given the evidence submitted as to the Complainant's existence and activities, and that the relevant section of the public would associate the name HEALD SOLICITORS with the services provided by it (see also DRS 04198 <mossandcoleman.co.uk>).

Furthermore, the Policy stipulates that the name or mark in which the Complainant has Rights (HEALD SOLICITORS) must be identical or similar to the Disputed Domain Name (<healdsolicitors.co.uk>).

It is accepted practice under the Policy to discount the ".CO.UK" suffix, and so as a result the Expert finds that paragraph 2(a)(i) of the Policy is satisfied and that the Complainant has Rights in respect of a name which is identical to the Disputed Domain Name.

### **Abusive Registration**

Moving on to paragraph 2(a)(ii) of the Policy, "Abusive Registration" is defined in paragraph 1 of the Policy to mean a domain name which:

- "(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."*

Paragraph 3(a) of the Policy sets out a non-exhaustive list of factors which may be evidence of Abusive Registration. The Complainant relies in the following:

*"(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; or*

*C. for the purpose of unfairly disrupting the business of the Complainant;*

*(ii) Circumstances indicating that the Respondent is using or threatening to use the Domain Name in a way which has confused or is likely to confuse people or businesses into believing that the Domain Name is registered to, operated or authorised by, or otherwise connected with the Complainant."*

Paragraph 4(a) of the Policy sets out a non-exhaustive list of factors which may be evidence that the Disputed Domain Name is not an Abusive Registration. The Respondent appears to reply on the following:

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

*[ ]*

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

Paragraph 4(b) of the Policy also provides that *"Fair use may include sites operated solely in tribute to or in criticism of a person or business."*

The Nominet Experts' Overview provides helpful guidance on whether or not using a domain name to point to a criticism website may be seen as fair use, as follows:

*"The appeal decision in DRS 06284 (rayden-engineering.co.uk) confirmed the consensus view among experts today that the nature of the domain name is crucial to the exercise. A criticism site linked to a domain name such as <lhateComplainant.co.uk> has a much better chance of being regarded as fair use of the domain name than one connected to <Complainant.co.uk>. The former flags up clearly what the visitor is likely to find at the site, whereas the latter is likely to be believed to be a domain name of or authorised by the Complainant.*

*[ ]*

*In DRS 06284 the domain name was identical to the name in which the Complainant had rights. A modified name that made it clear that this was a protest site would presumably have been less successful in drawing the protest to the attention of customers of the Complainant. The Panel concluded there was a balance to be drawn between the right to protest (which could be effected via a modified name) and the Complainant's rights in its own name, and that in this case at least the latter outweighed the former. Note that the Panel did not rule that use of an identical name would always and automatically be unfair, but did conclude that it was only in exceptional circumstances that such use could be fair. The Panel declined to find that such exceptional circumstances existed in the case in question."*



The Experts' Overview also provides the following:

*"While there is no system of precedent under the DRS Policy, for the DRS Policy to be effective there has to be a measure of consistency in the decisions and the panel of Experts does its best in that regard, although, as will be seen below, there are a few areas where differing views prevail. If anyone involved in a dispute under the DRS Policy proposes to rely upon the rationale of any previous DRS decision, the more recent decisions (whether at first instance or appeal level) are more likely to represent current thinking."*

Taking this information into account, the Expert notes that the Disputed Domain Name simply replicates the name by which the Complainant is known and does not contain any indication that the website to which it points is not owned or operated by the Complainant. As may be seen by previous decisions under the Policy, and particularly the appeal decision in DRS 06284 (<rayden-engineering.co.uk>), in these circumstances most (if not all) Experts would order a transfer under the Policy of the domain name at issue, and the Expert in this case sees no exceptional reason to diverge from this course of action.

In the Expert's opinion, internet users will likely be confused by the Disputed Domain Name and may logically assume that it belongs to the Complainant and thus points to the Complainant's website. Even if it is abundantly clear upon arrival at the corresponding website that there is no link between the operator of the website and the Complainant, users will still have been directed there as a result of the confusing nature of the Disputed Domain Name, and this may be unfairly detrimental to the Complainant's business (in accordance with paragraph 3(a)(ii) of the Policy).

In this regard, the actual content of the website in question is irrelevant, and the Expert has not taken it into consideration in making this decision. The content of the website may or may not be detrimental to the Complainant's business, but whether or not such content is fair or unfair is not the issue. What is unfair is the use of the Disputed Domain Name, which is identical to the Complainant's trading name, to attract visitors to a website about the Complainant. In view of this then logically the use of another domain name that is not confusing to point to the same website will likely not fall foul of the Policy.

For the sake of completeness, the Respondent is of course clearly free to criticise the Complainant, provided such criticism stays within the law (for example with regard to defamation). The fact that the Respondent has other remedies open to it, such as using the Complainant's internal procedure, or making a complaint to the Legal Ombudsman, is of no consequence and has no impact on the Respondent's right to legitimately criticise the Complainant. Similarly, the Respondent's motivation in setting up a criticism website and whether or not this is linked to his desire to pressurise the Complainant is also not relevant to this case.

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 Disputed Domain Name is an Abusive Registration in accordance with paragraph 2(a)(ii) of the Policy.

## **7. Decision**

The Expert finds that the Complainant has Rights in a name which is identical to the Disputed Domain Name, and that the Disputed Domain Name, in the hands of the Respondent, is an Abusive Registration. The Disputed Domain Name should therefore be transferred to the Complainant.

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Jane Seager  
14 January 2014