

DISPUTE RESOLUTION SERVICE

D00016932

Decision of Independent Expert

Nuco Technologies Ltd t/a Host-it Internet Solutions

and

1 To 1 Web Design

1. The Parties:

Lead Complainant: Nuco Technologies Ltd t/a Host-it Internet Solutions
Unit 1, Northampton Science Park
Kings Park Road
Moulton Park
Northampton
Northamptonshire
NN3 6LG
United Kingdom

Respondent: 1 To 1 Web Design
Engine House
Roundhay Road
Leeds
Yorkshire
LS8 4BU
United Kingdom

2. The Domain Name(s):

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

08 January 2016 15:07 Dispute received
11 January 2016 11:42 Complaint validated
11 January 2016 11:58 Notification of complaint sent to parties
12 January 2016 14:29 Response received
12 January 2016 14:30 Notification of response sent to parties
13 January 2016 08:27 Reply received
20 January 2016 08:15 Notification of reply sent to parties
20 January 2016 08:16 Mediator appointed
25 January 2016 15:54 Mediation started
26 January 2016 14:13 Mediation failed
26 January 2016 14:14 Close of mediation documents sent
05 February 2016 01:30 Complainant full fee reminder sent
09 February 2016 11:15 Expert decision payment received

4. Factual Background

The Complainant has offered web hosting and related services under the name “HOST IT” for over 16 years.

The Complainant operates websites at www.host-it.co.uk and www.hostit.co.uk.

The Complainant owns UK registered trade mark no. 2455092 for HOSTIT (word only) filed 10 May 2007 in classes 35, 38 and 42.

The Respondent registered the Domain Name on 22 November 2012.

The Respondent has used the Domain Name for a website branded “Host iT”, which offered “Cheap UK Website Hosting”.

5. Parties’ Contentions

Complaint

A summary of the Complaint is as follows:

The Complainant asserts that it has made a substantial investment in promoting its brand by means of both online and offline advertising and sports sponsorship. It says that the business has grown into a multimillion pound company over this period. The Complainant claims to provide services for thousands of customers and to own or

operate four data centres. The Complainant alleges that its business is one of the market leaders in its field.

The Complainant contends that its name has acquired distinctiveness through use and that sufficient goodwill has accrued in association with the mark as to be protectable under the law of passing off.

The Complainant submits that it has therefore acquired both registered and common law rights in the mark "HOSTIT".

The Respondent registered the Domain Name long after the Complainant says that its mark became established and after its trade mark was registered.

The Complainant says that the Domain Name is being used abusively. Such use is said to infringe the Complainant's registered trade mark and pass off the Respondent as a local outlet of the Complainant. The Respondent has no commercial connection or affiliation with the Complainant.

By using the "HOSTIT" name/branding, it is suggested that the Respondent is clearly implying a link between the respective businesses, which are in the same market sector.

The Respondent is said to be endeavouring to take advantage of the confusion that is likely to arise between the respective marks, particularly given the Respondent's use thereof in respect of identical services. This is also alleged to constitute passing off.

It is claimed that the Respondent has used branding on its website which is similar to that of the Complainant and which will inevitably lead to a likelihood of confusion.

The Complainant suggests that it is highly unlikely that the Respondent would have searched for the less common .org.uk domain extension without having first encountered the many variations registered by the Complainant and directed to the Complainant's site. In which case it is likely that the Respondent would have viewed the Complainant's website, at which point it would have become clear that the Complainant's mark was registered as a trade mark as well being an established brand. However, neither statutory trade mark infringement nor passing off requires intention or even awareness on the part of the offender.

Response

The Response is short and is reproduced in full below:

"I will remove the site. However, we will not transfer the domain. Their trade marks only cover from the name being used as a web hosting based business.

I now consider this to be an end of the matter.

The website has been taken down therefore it is not breaching their trade mark and their claim is invalid. The website will be replaced with a review website where hostit.co.uk customers who have had a negative experience will write negative

reviews. Under trade mark laws we are allowed to use their trade mark etc. if we are writing a review.

There are no ground, according to your policies and their complaint, for you to uphold their complaint as we do not step on their trade mark as we are not running a hosting business for that domain.”

Reply

A summary of the Reply is as follows:

The Response further illustrates the current, and also intended abusive use, of the Domain Name and has no foundation in law, nor in DRS guidelines/policies or case precedents.

The Response also reveals a threat to publish negligent misstatements as a result of the Complainant’s attempts to recover this and associated domain names.

A screen capture shows that, despite the Respondent’s statement, the site linked to the Domain Name has not been removed.

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”

On the evidence before me it is clear that the Complainant has established Rights in the term “HOSTIT” arising from its registered trade mark.

Moreover the trade mark is identical to the Domain Name, disregarding the domain name suffix.

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 first question to consider is whether the Respondent was aware of the Complainant at the time of registration of the Domain Name in 2012.

On the one hand, the Complainant has produced no evidence in support of its claims to have made a substantial investment in promoting its brand and to have grown into a “multimillion pound company”.

On the other hand, the Respondent does not contest such assertions nor specifically deny knowledge of the Complainant on registration of the Domain Name. The Respondent does not put forward any positive suggestion that the Domain Name was selected independently of the Complainant. Indeed, despite having the opportunity to set out its case in the Response, it has elected to give no explanation at all for its choice of the Domain Name. In those circumstances, I infer that, on the balance of probabilities, the Respondent was aware of the Complainant when it acquired the Domain Name.

Furthermore, the Respondent does not attempt to justify, or even directly mention, its use of the Domain Name to offer a hosting service competing directly with the Complainant. Instead, the Respondent simply asserts that its website has been removed and is “therefore” not infringing the Complainant’s trade mark.

In any case, the issue here is not trade mark infringement but, rather, Abusive Registration. See, for example, the Foreword to the DRS Experts’ Overview (“the Overview”) on Nominet’s website at http://www.nominet.uk/wp-content/uploads/2015/08/Expert_Overview.pdf, explaining that trade mark infringement does not necessarily equate to Abusive Registration.

Paragraph 3a(ii) of the Policy identifies the following as one of the non-exhaustive factors which may be evidence that a domain name is an Abusive Registration:

- “ii. [c]ircumstances 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”*

In my view, on the balance of probabilities, the Respondent’s use of the Domain Name for a website branded with the same name as the Complainant, for identical services to those offered by the Complainant, gave rise to a likelihood of confusion for the purposes of paragraph 3a(ii). It makes no difference if the Respondent later ceased such use.

For the reasons stated above I find that the Domain Name is an Abusive Registration in that it has been registered and 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, host-it.org.uk, be transferred to the Complainant.

Signed Adam Taylor

Dated 11 March 2016