

DISPUTE RESOLUTION SERVICE

D00017180

Decision of Independent Expert

Really Good Domains Ltd

and

Contract Hire and Leasing Ltd

1. The Parties:

Lead Complainant: Really Good Domains Ltd
Domain House, 4 Watchgate Newby Road
Hazel Grove
Stockport
Cheshire
SK7 5DB
United Kingdom

Respondent: Contract Hire and Leasing Ltd
Unit 5 Burgh Business Centre
75 King Street
Rutherglen
Glasgow
South Lanarkshire
G73 1JS
United Kingdom

2. The Domain Names:

contracthireandleasing.me.uk
contracthireandleasing.org.uk

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 into question my independence in the eyes of one or both of the parties.

The dispute was received by the Dispute Resolution Service on March 3, 2016. The Complaint was validated on March 4, 2016 and notification of the Complaint was sent to the Parties on the same date.

The Response was received on March 7, 2016 and notified to the Parties on the same date. A Reply to the Response was received on March 15, 2016 and notified to the parties on the same date. Mediation failed on March 22, 2016 and the Expert decision payment was received on April 1, 2016.

4. Factual Background

The Complainant, having the registered company name Really Good Domains Ltd, has traded under the name "Contract Hire And Leasing" since about July 2000, principally through its own domain name and website "contracthireandleasing.com". The Complainant has acquired 17 other broadly similar domain names (such as contracthireandleasing.me) over the periods 2004-2009 and 2014-2016. The Complainant has not registered "Contract Hire And Leasing" as a company name or trade mark.

The Complainant's business is the provision of a marketplace website on which advertisers place their offers of vehicle contract hire and leasing rates, and broadly related goods and services, with links that viewers may then follow. The website in 2015 received more than 2.9 million visitors and more than 27 million page views.

The Complainant, under the names "contracthireandleasing.com" or "Contract Hire And Leasing", has received wide endorsement in newspapers, trade journals and YouTube testimonial videos. Its advertising spend is over £500,000 per year and its sponsorships have included Motor Trader Industry Awards. The Complainant's advertising presence has included magazines, radio, Premier League football, and a partnership with the Telegraph newspaper.

Ace Vehicle Leasing Ltd ("Ace") is a vehicle leasing company of which the sole director is also the sole director of the Respondent. Ace was a customer of the Complainant for some months in 2012-2013, following which a business dispute arose between Ace and the Complainant. On June 19, 2013, shortly after the business dispute was settled, the disputed Domain Name contracthireandleasing.org.uk was registered. On August 29, 2014, the Respondent registered the disputed Domain Name contracthireandleasing.me.uk. On the same date the Respondent was granted registration of the company name "Contract Hire and Leasing Limited" at Companies House, which the Complainant has since contested.

5. Parties' Contentions

A. Complainant

The Complainant's contentions include the following.

The Complainant asserts prior common law rights in the names "Contract Hire And Leasing" and "contracthireandleasing.com", which have been used interchangeably as the Complainant's trading names since about 2000. The Domain Names are effectively identical to "Contract Hire And Leasing" and "contracthireandleasing.com".

The Complainant suggests that the common guiding mind of both the Respondent and Ace was aware of the Complainant's name because Ace was a client of the Complainant for some seven months from June 29, 2012 to January 24, 2013. Furthermore in emails on April 19, 2013 and May 8, 2013, concerning the business dispute, the Respondent referred to the Complainant in the terms "Dear Contract Hire And Leasing" and "Contract Hire And Leasing invoice".

The Complainant says it was on June 19, 2013, soon after the business dispute was settled, that the first disputed Domain Name, contracthireandleasing.org.uk, was registered. The grant of registration of the company name "Contract Hire and Leasing Limited" to the Respondent was on August 29, 2014 and the Domain Name contracthireandleasing.me.uk was registered on the same date. The next day, on August 30, 2014, the Respondent emailed the Complainant and wrote: "Please note that I have registered the company contract hire and leasing and would be grateful if you would refrain from using this name as it will conflict with my company and affect my business". The Complainant says this shows the Respondent intended to cause detriment to the Complainant's rights and business.

The website to which both disputed Domain Names ultimately resolve, being the one located at contracthireandleasing.org.uk, bears the name "Contract Hire and Leasing Limited" and offers services relating to the leasing of vehicles. The Complainant says the Respondent is using a brand the same as the Complainant's in order to offer the same services as the Complainant. Internet visitors dealing with the Respondent may be confused into believing they are dealing with the Complainant. Any substandard services provided by the Respondent would damage the Complainant's reputation.

The Complainant submits that the appearance of the Respondent's name on the publicly accessible records relating to the Domain Names is sufficient in itself to be damaging to the Complainant's goodwill, citing *British Telecommunications v One in a Million Ltd* [1999] 1 WLR 903.

The Complainant asserts that the Respondent has neither authorisation from the Complainant to use the name "Contract Hire And Leasing" nor any rights in the name whatsoever.

The Complainant further contends that the Domain Names were registered as blocking registrations against the Complainant.

The Complainant says also that the Domain Names were registered for the purposes of unfairly disrupting the business of the Complainant.

The Complainant requests the transfer of the Domain Names.

B. Respondent

The Respondent denies the Complaint. The Respondent's contentions include the following.

The Respondent owns "Contract Hire and Leasing Limited", Registration Number SC485519, incorporated on August 29, 2014. Checks with Companies House and trading standards

revealed that the name was available for registration and that an entity with that name had been dissolved in 2010.

The Complainant's representative asked the Respondent to close the company and deliver up the Domain Names. The Respondent enquired as to why the Complainant had not registered the name "Contract Hire and Leasing" and the reply was that the Respondent did not give the Complainant the chance.

The Respondent offered to place a disclaimer on its website to the effect of having no connection with the Complainant.

The Respondent offered to sell its company to the Complainant.

The Respondent asserts that the Complainant is trying to stop it from advertising that it leases vehicles. It is refuted that Internet users looking for contracthireandleasing.com would type contracthireandleasing.org.uk or contracthireandleasing.me.uk instead.

The Respondent contends that it has done nothing wrong and is running a registered legitimate company

The Respondent questioned why the Complainant had not bought up all available related domain names.

Reply to the Response

The Complainant's Reply partially reiterates the Complaint and includes the following points.

The Complainant has not disputed that the Complainant has goodwill and a significant reputation in the name "Contract Hire And Leasing". The Respondent's guiding mind knew this at the time of registration of the Domain Names through having used the Complainant's services.

It is submitted that the Respondent's registration of the company name (itself under complaint) does not give it the right to register the Domain Names.

The Complainant denies saying that the Respondent did not give it the chance to register the company name "Contract Hire And Leasing".

The Complainant rejected the offer for it to buy the Respondent's company, presumed to include the Domain Names, as it will not reward the Respondent's actions. The Complainant says the Respondent's offer to sell its company is evidence of the Respondent's bad faith intentions and that the Respondent has registered the Domain Names primarily for the purposes of selling them to the Complainant for valuable consideration in excess of registration costs.

The Complainant says that Internet users who enter the Domain Names, or see them in search results, would expect them to resolve to a website of the Complainant.

The Complainant rejects the suggestion that a business should be expected to register every anticipated potentially abusive domain name.

6. Discussion and Findings

Paragraph 2(a) of the Policy requires the Complainant to prove, on the balance of probabilities, that:

- 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

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”.

The names in which the Complainant asserts rights are “Contract Hire And Leasing” and “contracthireandleasing.com”. The Complainant does not have either a trade mark registration or a company registration in respect of either name and relies on the assertion of common law rights.

Article 2.2 of the Dispute Resolution Service Experts’ Overview, version 2, reads in part:

“If the right is 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).”

Such evidence is all the more vital in circumstances where “contract hire and leasing” is an inherently descriptive term and therefore the Complainant must prove that the term has, as paragraph 1 of the Policy puts it, “acquired a secondary meaning”. This requires evidence that consumers have been educated to perceive the term as an indication of trade origin.

The Complainant has produced evidence of its websites in the form of screen shots of Wayback Machine archives captured twice in 2001 and then in every year from 2003 to 2015. The 2001 websites carry headlines such as “Welcome to contracthireandleasing.com” or capitalised as “ContractHireAndLeasing.com”, and by 2004 the name was sometimes written with the words separated as “Contract Hire And Leasing .com”. Throughout this period of some 15 years the subject matter of the websites has been consistently related to motor vehicle contract hire, leasing and related material.

The Complainant has produced evidence in the form of a Google analytics table and graph in support of its claim that from 2007 to 2015, “page views more than doubled from 10,355,997 to 27,514,347, visits to the Website increased from 1,955,280 to 5,432,217 and the number of individual visitors increased from 1,057,346 to 2,973,880”.

In support of the Complainant's claim that it is publicly well known, it has produced, for example, a screen shot from the Peugeot website of February 24, 2015, which under the headline "Peugeot 308 SW wins 'Best Estate Car to Lease' award", reads "Peugeot wins again, this time it's the 308 SW taking Best Estate Car to Lease in the inaugural ContractHireAndLeasing.com Car of the Year Awards which recognises the achievements of vehicle manufacturers and their products by ContractHireAndLeasing.com, the UK's number one leasing website ..."

The Complainant has produced evidence of other high profile appearances of its names including the sponsorship of Motor Trader Industry Awards in 2014 and 2015. Evidence shows that the Complainant has been the recipient of awards including the Car Dealer Power Awards in 2012 and 2013. The Complainant has been mentioned by name in the Sunday Mirror as "contracthireandleasing.com", and three customers have provided YouTube videos referenced by the Complainant. It has a partnership with the Telegraph newspaper, which names the Complainant as "ContractHireAndLeasing.com" and describes it as "the market leader in this sector", and enables seamless searching through the Telegraph's website. A number of other press endorsements and advertising appearances have been cited by the Complainant.

On the basis of the foregoing, the Expert finds that the Complainant has used the names and *de facto* trade marks "Contract Hire And Leasing" (usually with ".com" appended) and "contracthireandleasing.com" for about 15 years; that they have been used to a significant degree, having received more than a million website visitors as long ago as in 2007; and that they are associated by the public with the Complainant, as exemplified by the reference by Peugeot to "the UK's number one leasing website". The term has acquired a secondary meaning. Solely for the purposes of this proceeding, the Expert finds the Complainant to have sufficient rights in the names and trade marks "Contract Hire And Leasing" (with or without ".com" appended) and "contracthireandleasing.com" to satisfy the requirement of paragraph 2(a)(i) of the Policy.

Identity or Similarity

The question of whether the *Respondent* may claim to have rights in a name or trade mark similar to the Complainant's or similar to the Domain Names is not a relevant consideration under Paragraph 2(a)(i) of the Policy (though see below in relation to Abusive Registration). The Domain Names contracthireandleasing.me.uk and contracthireandleasing.org.uk, of which the top level and second level directories need not be taken into consideration, are found to be confusingly similar to the Complainant's names and trade marks in the terms of paragraph 2(a)(i) of the Policy.

Abusive Registration

Under paragraph 1 of the Policy, Abusive Registration means a Domain Name that 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."

Paragraph 3 of the Policy, Evidence of Abusive Registration, reads in part:

“a. A non-exhaustive list of factors which may be evidence that the Domain Name is an Abusive Registration is as follows:

i. Circumstances indicating that the Respondent has registered or otherwise acquired the Domain Name primarily:

A. 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;

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 of the Policy outlines how the Respondent may demonstrate that the Domain Name is not an Abusive Registration, and reads in part:

“a. A non-exhaustive list of factors which may be evidence that the Domain Name is not an Abusive Registration is as follows:

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; or

ii. The Domain Name is generic or descriptive and the Respondent is making fair use of it;

(.....)”

The Complainant has outlined a history of business dealings with Ace, whose sole director is also that of the Respondent. Apparently Ace advertised on the Complainant's website from June 29, 2012 to January 24, 2013, and expressed dissatisfaction to the Complainant. A dispute about payment followed, which was eventually settled.

Apparently in the course of the payment dispute, on April 19, 2013 and May 8, 2013, the Respondent emailed the Complainant attaching statements and requesting some payment.

The first of these had a subject line "Contract Hire And Leasing invoice ..." and the second had no subject but commenced "Dear contract hire and leasing ..." There can be little room to doubt that the Complainant was known to the Respondent as "Contract Hire And Leasing".

On June 19, 2013, shortly after the payment dispute was settled, the disputed Domain Name contracthireandleasing.org.uk was registered.

On August 29, 2014, Companies House granted registration of the company name "Contract Hire and Leasing Limited" to the Respondent. According to the Respondent, "Before registering this company i checked with Companies house and trading standards that it was all ok to register as it had been dissolved in 2010 and was told fine ..." Notably on the date of registration of the company name, the Respondent also registered the Domain Name contracthireandleasing.me.uk. The next day, on August 30, 2014, the Respondent emailed the Complainant to say that the Respondent had registered the company name and requesting that the Complainant refrain from using the same name.

Thus in chronological sequence, the Respondent came to know the Complainant's trading name; expressed dissatisfaction with certain services provided by the Complainant; disputed payment; registered the Domain Name contracthireandleasing.org.uk; researched relevant company names and obtained registration for "Contract Hire and Leasing Limited"; registered the Domain Name contracthireandleasing.me.uk; and told the Complainant to stop using the name under which it had traded for 15 years. In the course of the current proceeding, the Respondent acknowledged having offered to sell "Contract Hire and Leasing Limited" to the Complainant.

The list of factors under paragraph 3(a) of the Policy, which may be evidence that a Domain Name is an Abusive Registration, is non-exhaustive. Having regard to the totality of the evidence and on the balance of probabilities, the Expert finds the Respondent intentionally took unfair advantage of the Complainant's rights and that the disputed Domain Names, in the circumstances of their registration, constitute Abusive Registrations in the hands of the Respondent.

More specifically, in the terms of paragraph 3(a)(i)(A) of the Policy, the Respondent concedes that it offered to sell its company to the Complainant. In context this may reasonably be interpreted as a mechanism whereby the offer to the Complainant was to include a transfer of the Domain Names (access to the company name being of no concern in this proceeding) and, given the tone of this dispute, that the Domain Name transfer element of the transaction would have equated with a price in excess of the Respondent's out-of-pocket costs of their registration.

In terms of paragraph 3(a)(i)(B) of the Policy, on the evidence, the Expert finds on the balance of probabilities that one of the Respondent's intentions was to block the Complainant from the opportunity to express its trading name with the ".org.uk" and ".me.uk" directory extensions.

Under paragraph 3(a)(i)(C) of the Policy, the Expert finds it clear from the evidence that registration of the Domain Names was done with the intention of contributing to the unfair disruption of the Complainant's business.

Paragraph 3(a)(i) refers to the 'primary' purpose or intention behind the registration, but this does not mean that paragraphs 3(a)(i)(A), (B) and (C) cannot all apply to the same fact situation on the basis that there can only be one 'primary' purpose. In the Expert's view the 'primary' purpose of the Respondent in this case embraced aspects of all three sub-paragraphs.

The Expert finds on balance under paragraph 3(a)(ii) of the Policy that the Respondent's registration and intended use of the Domain Names, being confusingly similar to the trading name by which the Complainant had been known for 15 years, in the circumstance of this dispute, constituted a threat to cause confusion among Internet users between the Complainant and the Respondent as to the ownership of the Domain Names.

The Expert does not find any evidence that could support any assertion by the Respondent under paragraph 4 of the Policy that the registration of the Domain Names was not abusive.

Accordingly the Expert finds the disputed Domain Names, in the hands of the Respondent, to constitute Abusive Registrations within the meaning of paragraph 2(a)(ii) of the Policy.

7. Decision

The Expert finds that the Complainant has Rights in respect of the names and *de facto* trade marks "ContractHireAndLeasing" and "contracthireandleasing.com"; that the disputed Domain Names contracthireandleasing.org.uk and contracthireandleasing.me.uk are similar to the Complainant's names and trade marks; and that the disputed Domain Names, in the hands of the Respondent, are Abusive Registrations. The Expert orders that the Domain Names contracthireandleasing.org.uk and contracthireandleasing.me.uk be transferred to the Complainant.

Signed Clive Trotman

Dated April 18, 2016