

DISPUTE RESOLUTION SERVICE

D00017299

Decision of Independent Expert

EG Hockey Academy LLP

and

Guy Workman

The Parties

Lead Complainant: EG Hockey Academy LLP
St. Margarets, Church Road
Uckfield
East Sussex
TN22 4LT
United Kingdom

Additional Complainant: Matthew Jones
Feltons Farm Cottage, Old School Lane,
Brockham
Surrey
RH3 7AU
United Kingdom

Respondent: Guy Workman
62 West Hill
East Grinstead
West Sussex
RH19 4EP
United Kingdom

The Domain Name

eghockeyacademy.co.uk

Procedural History

1. 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 into question my independence in the eyes of one or both of the parties.
2. The following is a brief summary of the procedural steps in this case.

06 May 2016	Complaint received by Nominet.
09 May 2016	Complaint validated and notification of Complaint sent to the parties.
27 May 2016	Response reminder sent.
1 June 2016	Response received and notification of Response sent to the parties.
6 June 2016	Reply reminder sent.
9 June 2016	No reply received and mediator appointed.
14 June 2016	Mediation started.
7 July 2016	Mediation failed.
19 July 2016	Complainant full fee reminder sent.
22 July 2016	No expert decision payment received.
3 August 2016	Respondent full fee reminder sent.
8 August 2016	Expert decision payment received.

Factual Background

3. EG Hockey Academy LLP ('EGHALLP'), the Lead Complainant, operates a business from a website at www.eghockeyacademy.com in the field of academy services for hockey in the East Grinstead area and elsewhere in the south of England. The business is run by Ms. Wendy Masters ('Ms Masters') and Mr Matthew Jones ('Mr Jones'), the Additional Complainant. The Complaint relates to the registration on 4 August 2015 and subsequent use of the Domain Name for what the Complainants say is a

'copy-cat' business, which also provides hockey academy services in the East Grinstead area, passing off its activities as those of EGHALLP.

4. The Respondent is an Honorary Vice President of East Grinstead Hockey Club ('the Club'), which was founded in 1897. He says that the registration and use of the Domain Name have been entirely proper, lawfully promoting the Club's academy services.

Parties' Contentions

The Complaint

5. The Complainants allege, -
 - 5.1 The business known as EG Hockey Academy started in April 2009, when the domain name eghockeyacademy.com was first registered. EG Hockey Academy was registered as a business partnership in 2010. EGHALLP was incorporated as a limited liability partnership on 5 July 2011. The Complaint puts it thus, 'EG Hockey Academy (our business name) ... started business in April 2009 and first registered the domain name <http://www.eghockeyacademy.com>.'
 - 5.2 A copy certificate of UK trade mark registration accompanying the Complaint shows that a device mark containing the name EGHA Hockey Academy was filed on 6 April 2015 and registered as UK trade mark No: 00003102661 on 3 July 2015 in Class 41; sports tuition, coaching and instruction, production of course material, entertainment in the nature of hockey games and related matters.
 - 5.3 The Domain Name was acquired by a copy-cat company running hockey courses close to the Complainants' area of business. The copy-cat business acquired the Complainants' business / domain name with the co.uk suffix and pointed it at a different domain,

knowing that it would dupe unsuspecting customers familiar with the Complainants' business name into being unwittingly directed to another web site, providing a similar service in hockey courses in the same geographical area to the business of EGHALLP.

- 5.4 The Complainants became aware that the Domain Name was not available in August 2015 and it was not until April 2016 that they first became aware that it was being used to redirect online traffic to another web site, www.eghockey.co.uk/academy. That web site promotes the 'EGHC Academy', a hockey academy of East Grinstead Hockey Club.
- 5.5 The business now run by EGHALLP has grown significantly during the past seven years. By acquiring and using the Domain Name in the manner complained of, this other hockey academy has piggy-backed off the reputation and good name of EGHALLP by passing itself off as EG Hockey Academy, the business of EGHALLP.
- 5.6 Many of the bookings for the business of EGHALLP are made online and the Complainants are aware of occasions when clients have inadvertently booked onto a course run by the copy-cat business.

The Response

6. In the Response it is alleged, -
 - 6.1 The Club was formed in 1897 as a men's hockey club. Since 1999 it has been a hockey club for men and ladies, following a merger with the ladies' club. The Club has been providing hockey services continuously for nearly 120 years in the East Grinstead area and has achieved success in international, national and regional competitions.
 - 6.2 The Club has a substantial reputation and goodwill in the names EG Hockey, EG Hockey Club and EGHC in connection with hockey training, coaching and related academy services offered and provided

by the Club. All three of these names were used by the Club in connection with the hockey academy services it launched in April 2009 as an extension to its other hockey services.

- 6.3 Mr Jones and Ms Masters are the individuals behind the business of EHHALLP. In 2009 the domain name <http://www.eghockeyacademy.com> was registered by Mr Jones at a time when he was manager of the Club's 1st teams and while serving the Club to develop its web presence and market its activities. The purpose of the registration was to promote the Club's new academy services and that is what it did, initially. The Club's academy was launched as part of a strategic ten-year plan, created in 2005.
- 6.4 In 2009, Mr Jones and Ms Masters were both involved in the provision and promotion of the services of the Club, which they knew was widely known as EG Hockey and they used the term 'EG Hockey Academy' and the domain at <http://www.eghockeyacademy.com> to promote the academy services of the Club.
- 6.5 In 2010, they began to promote another hockey academy service under the names 'EGHA' and 'EGHA Hockey Academy' and linked the domain <http://www.eghockeyacademy.com> to the promotion of those services.
- 6.6 The Club made several unsuccessful attempts to resolve amicably the confusion caused by the actions of Mr Jones and Ms Masters. However, the confusion was exacerbated by their registration of EGHALLP, a name that they must have known would be associated with the activities of the Club.
- 6.7 The Respondent registered the Domain Name with the approval, and on behalf of, the Club and for the sole purpose of promoting the Club's academy services.
- 6.8 The Complainants have no Rights in the Domain Name, having produced no evidence at all to support their claim that the use of the

Domain Name would amount to passing off. To the contrary, the operations of the Complainants' business under the name 'EG Hockey Academy' and 'EGHA' amounts to passing off their services as those of, or connected to, the services of the Club.

- 6.9 The registration of the Domain Name was not abusive, because it was registered for the benefit of the Club in the promotion of its academy services and has only ever been used to promote those services and none other. The Domain Name incorporates the Club's trading name, with the addition of the word 'academy', which is descriptive of the Club's academy services.
 - 6.10 The Club also registered and uses other domain names. These include <http://www.eghockey.org.uk> and <http://eghockey.co.uk> which have been used continuously since their registration in 2009 and 2010 respectively, during the time that Mr Jones was responsible for the web presence of the Club.
 - 6.11 Either Mr Jones and Ms Masters established their business by passing it off as a service offered by the Club, in which case they are in no position to complain about the continued activities of the Club under the names they have used; or irrespective of their actions, the Domain Name is very similar to EGHC and is therefore associated with the services of the Club and the use complained of is unlikely to mislead the public. The Club is not operating a copy-cat business but a natural extension of its services.
 - 6.12 In all the circumstances, the Domain Name was registered and is being used for the legitimate purpose of promoting the services of East Grinstead Hockey Club, which enjoys the right to use it and the Complainants have no right to prevent its use.
7. As appears from the summary of the procedural steps set out in paragraph 1 above, no Reply was served. The certificate of trade mark registration referred to in paragraph 5.2 was incomplete, the first page only being provided,

therefore omitting the identity of the trade mark owner. On 22 August 2016, the following directions were issued pursuant to paragraph 13a of the DRS Procedure ('the Procedure'), -

- '(1) The Complainants to provide by Thursday 25 August 2016 a complete copy of the certificate of trade mark registration which accompanied the Complaint (the first page only was provided), identifying the owner of that trade mark.
- (2) The Respondent may by Thursday 1 September 2016 make a supplementary statement in response to the matters contained in the certificate of registration so provided.'

A copy of the certificate was provided to Nominet on 22 August 2016 and forwarded to the Respondent on 23 August 2016. The certificate showed EGHALLP to be the registered owner of the trade mark. In a further statement dated 31 August 2016 provided on his behalf, the Respondent argued that the trade mark was descriptive and not distinctive, was dissimilar to the Domain Name, EGHALLP is not a Complainant and even if it is, the mark has not been properly specified in the Complaint. It was not necessary to give the Complainants an opportunity to respond to the supplementary statement, in view of the findings on the issue of Rights, as set out in paragraph 12 below.

Discussion and Findings

8. A Complainant is required under subparagraphs 2a. and 2b. of the DRS Policy ("the Policy") to prove on the balance of probabilities that: -
 - 8.1 he has Rights in respect of a name or mark which is identical or similar to the Domain Name; and
 - 8.2 the Domain Name, in the hands of the Respondent, is an Abusive Registration.

The requirement under the DRS that a Complainant has to establish Rights is in substance a threshold which must be crossed in order to establish Abusive Registration, and no more. In addition, the principles of passing off and trade

mark infringement in particular are materially different to the concept of Abusive Registration under Nominet's DRS, even though some of those principles may be relevant in certain respects.

9. I have taken into account all the facts and matters relied on by each party, but have limited the findings in this decision to those necessary to dispose of the dispute in accordance with the Policy and Procedure. Therefore, it is not necessary to resolve all the issues raised by the parties.

Rights

10. By paragraph 1 of the Policy, -

'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.'

11. EGHALLP has established that it is the owner of a registered UK trade mark, being a device mark containing the name EGHA Hockey Academy, no: 00003102661 registered on 3 July 2015 in Class 41; sports tuition, coaching and instruction, production of course material, entertainment in the nature of hockey games and related matters. I reject the arguments advanced in the supplementary statement. The registration is a subsisting one, notwithstanding the Respondent's arguments about lack of distinctiveness. Although the registered mark is a device mark, there is sufficient similarity for the purposes of the DRS between the mark, containing the words 'EGHA Hockey Academy' and the Domain Name, i.e. 'eghockeyacademy' (the 'co.uk' suffix to be ignored for these purposes). The mark was also sufficiently specified for the purposes of the Complaint by or on behalf of EGHALLP, the Lead Complainant.
12. Therefore, I find that the Lead Complainant has Rights in a name or mark, namely 'EGHA Hockey Academy', which is similar to the Domain Name. Accordingly, the Lead Complainant has established that it has Rights.

Abusive Registration

13. By paragraph 1 of the Policy, -

'Abusive Registration means 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 has taken unfair advantage of or has been unfairly detrimental to the Complainant's Rights.'*

By paragraph 3 of the Policy, -

'3. Evidence of Abusive Registration

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;

.....'

By paragraph 4 of the Policy, -

'4. How the Respondent may demonstrate in its response that the Domain Name is not an Abusive Registration

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;

.....'

14. The Complainants' case is set out in a Complaint of just over one page, accompanied by a copy of the certificate of incorporation of EGHALLP and the incomplete certificate of registration of the trade mark. The Respondent's evidence consists of two witness statements, each dated 27 May 2016, made by the Respondent and by Simon Longhurst ('Mr Longhurst'). Numerous documents have been exhibited to Mr Longhurst's statement relating to material events occurring since 2005. In addition to now being a Vice President of the Club, the Respondent has been a Club member since 1999 and was Club Captain from 2011 until May 2015. Mr Longhurst served on the Club's Committee between April 2009 and April 2016.

15. The evidence relied on by the Respondent is detailed, inherently credible and supported by the contemporaneous documents, in contrast to the largely generalised case put forward by the Complainants, which in most respects lacks supporting evidence. Further, no Reply has been served to explain or contest the detailed evidence put forward by the Respondent. Therefore, where the evidence for the Respondent has conflicted with the Complainants' case, I have preferred that evidence for those reasons. My findings on the issue of Abusive Registration are as follows.

16. The Club was formed in 1897 as a men's hockey club. For well over a century the Club (and the clubs that have merged with it including the ladies' club in 1999) were the only organisations in East Grinstead or Sussex to provide hockey services to the general public in the East Grinstead area. The Club was a founder club of East Grinstead Sports Club, which was incorporated as East Grinstead Sports Club Ltd in 2001 (also referred to in this decision as 'the Club').
17. In the Summer of 2005, the Club created a ten-year strategy to maintain it at the highest levels of club hockey. A key objective of that plan was to create the best hockey academy in the region. The idea of a hockey academy was modelled on the approach taken by many Dutch clubs. Another key objective of the strategy was the need to develop the Club's commercial activities and to improve its marketing. The Club members who defined the strategy consisted of a number of individuals, who included Mr Jones, who at that time was the Manager of the Club's 1st team, and Mr Longhurst.
18. Steps to form the academy were taken in early 2007. The matter was discussed at a committee meeting of the junior hockey club in February 2007 attended by Ms Masters and taken forward at a meeting of the Club's committee on 1 March 2007. The Club's academy was launched in early 2009 as the 'East Grinstead Hockey Academy', also with the name 'EGHC Hockey Academy'. The Club members who staffed the academy were led by Mr Jones and Ms Masters in her role as Chair of the junior section of the Club.
19. The academy was advertised in the Club's Junior Newsletter dated 1 March 2009. The first course was to take place on 6-8 April 2009 as shown by a copy of the booking form, which invited members of the public to contact Ms Masters and to send to her, 'Wendy Masters (EGHA)', cheques payable to the Club for that course. The form concluded by asking persons booking on the courses to state, 'Where did you hear about the East Grinstead Hockey Academy?', giving a number of options such as through a friend or from the press, and concluded with the words 'East Grinstead Hockey Academy, [address] contact Wendy Masters ...'

20. That first academy course took place and was successful. A group email of 1 July 2009 to interested members of the public promoted two three-day summer courses in August 2009 and they were invited to contact Ms Masters to register their interest.
21. Those academy courses took place and further courses were held. From December 2009 publicity posters and registration forms referred persons interested in the Club's academy courses to online booking forms, to be found at <http://www.eghockeyacademy.com>. They were advised that further information about the courses could be obtained from Ms Masters at wendy@eghockeyacademy.com. The posters and forms now referred to the academy within the Club's blue circle logo as 'East Grinstead Hockey Academy', the word replacing 'Academy' replacing the word 'Club'.
22. The web site at <http://www.eghockeyacademy.com> had been registered by Mr Jones earlier in 2009 as part of the work he was carrying out for the Club in developing its marketing activities. The name 'eghockey' was also used in the registration of other domain names for the Club, in particular 'http://www.eghockey.org.uk' (registered on 22 May 2009) and 'http://www.eghockey.co.uk' (registered on 12 March 2010).
23. The significance of the word 'eghockey' was that the Club was known as 'EG Hockey'. EG Hockey and also EGHC were abbreviations of East Grinstead Hockey Club in general use. As for EG Hockey, that name had become a part of the common vernacular across the Club, used by external stakeholders in the field of hockey both nationally and internationally and by members of the public in the East Grinstead area. For example, Ms Masters herself used the term in emails she wrote on 4 September 2006 and 8 April 2008. In an email dated 10 January 2010 written by Ms Masters to the England Hockey Board, the governing body of hockey in England, she identified herself as representing 'EG Hockey'.

24. During 2009 and at the Annual General Meeting of the Club in April 2010, Ms Masters reported on the success of the academy. An internal Club review of junior hockey for 2009-2010 recorded that, 'The East Grinstead Hockey Academy has really taken off and has provided not only our own members but many from other clubs and schools the opportunity to be offered excellent coaching by our 1st XI players.'
25. In April 2010 Ms Masters stepped down from her position as Chair of the Junior section. She continued to promote the Club's academy using the same branding. For example, by email dated 30 May 2010 Ms Masters confirmed a booking on the Club's academy course for 2 and 3 June 2010 on a header 'East Grinstead Hockey Academy' with the web site 'eghockeyacademy.com' immediately below, with the header and web site address appearing in the middle of two of the blue logos incorporating the words 'East Grinstead Hockey Academy'.
26. However, by October 2010 Ms Masters had begun to promote hockey academy services under new branding, using the name 'EGHA Hockey Academy' accompanied by a new logo, consisting of the device mark that was later registered as the UK trade mark. An email from Ms Masters dated 23 October 2010 to members of the public stated that the course during the half-term in the last week of the month was full and that the booking form for December 'will be on our website in the next couple of days', at <http://www.eghockeyacademy.com>.
27. A query about the hockey academies was raised by a Ms Georgie Worsely on behalf of the Club in an email to Ms Masters of 24 October 2010 to which she replied the following day. Her email stated, -

' EGHA is run separately from the EG Hockey Club and is not run under the EG Hockey Club banner. Our advertising uses various mediums and it is only advertised in The Grinner, or via the EGHC junior database if Jane or whoever, does this.

We have built up our own database, through which you have received this email. The Hockey Club members and indeed any Sports Club

members receive a 10% discount ... Other hockey clubs also advertise our courses – Tunbridge Wells HC being an example ..

Obviously, there are quite a few EGHC members who book onto the courses, but the majority now come through their school or club, which in turn raises the profile of EGHC, as some of our coaches are 1st XI players.

The benefit to the club is I get quite a few enquiries about joining EGHC following Academy courses and the discount available to EGHC members. Additionally, the EGHA has been associated with the club and has some connections, although not official ties, nonetheless, it has donated £3,000 to the junior section.

We understand that there has been some confusion as to the identity of the EGHA and that is why the name and its branding is completely separate from the club.?’

28. In her response by email the same day, Ms Worsley stated that she found the explanation confusing, as the purpose of the academy, run by a committee of which Ms Masters had been the Chair, was to provide a service of the Club, and not to create a separate (i.e. personal) commercial venture. She noted that no payment had been shown in the Club’s accounts. The email concluded, ‘It all seems very bizarre to me.’

29. The services of EGHA Hockey Academy continued to be promoted using the domain <http://www.eghockeyacademy.com>. On 5 July 2011 EGHALLP was incorporated, which since that time has traded as a provider of hockey academy services under the EGHA Hockey Academy branding. The web site at <http://www.eghockeyacademy.com> advertises a range of hockey courses in Sussex, Surrey and Kent. Persons wishing to make enquiries about the academy services are invited to contact Ms Masters.

30. The Club has continued to provide its own academy services. On at least one occasion, a customer of EGHALLP has purchased its academy services in the belief that the services were being provided by the Club and the fees were supporting the Club. The customer was a school. If, as the Complainants allege, members of the public have booked on to courses run by the Club ‘inadvertently’, in view of the lack of any evidence provided, I am not

satisfied that these were bookings intended for EGHALLP, as opposed to bookings that those members of the public intended to make with the Club.

31. Between December 2014 and January 2015 discussions took place between the Club, Ms Masters and Mr Jones, to try and reach a resolution of the difficulties caused by the separate academy business. Those discussions were unsuccessful.
32. As a result, the Club re-launched its academy services in April 2015. The Respondent registered the Domain Name on 4 August 2015. The name was chosen for the purpose of identifying the hockey academy services provided by the Club. The Domain Name was one of several domain names chosen by the Respondent for that purpose, containing the words 'eghockeyacademy' and 'eghc'. These words were chosen by him, because each was a name by which the Club is known, followed by the word 'academy', describing the service concerned.
33. The web site at <http://www.eghockeyacademy.co.uk> resolves to <http://www.eghockey.co.uk/academy>, which is the page of the Club's web site that advertises and promotes the Club's academy services under the brand 'EGHC Academy'.
34. I now turn to the conclusions to be drawn from these findings. The overriding question is whether the registration is an Abusive Registration as set out in paragraph 1 of the Policy: see paragraph 13 above. Paragraph 4 of the Policy provides non-exhaustively a number of factors, which a Respondent may establish so as to show that a registration is not abusive. These include the case where, before being aware of the Complainant's cause for complaint (not necessarily the Complaint under the DRS), the Respondent has been commonly known by the name or legitimately connected with a mark which is identical or similar to the Domain Name: paragraph 4a.i.B.
35. The essence of the Complainants' case is that the Respondent's registration of the Domain Name was designed to promote a copy-cat business, which

deliberately copied the business started by Mr Jones and Ms Masters in April 2009 and became the business of EGHALLP from 5 July 2011. However, in April 2009 it was the Club that commenced the provision of hockey academy services to members of the public, pursuant to a strategy developed from 2005. The conception, creation, marketing and provision of those services were all done or carried out by the Club. The academy service was its service.

36. Ms Masters was closely involved in the provision of those services in particular, administering the courses including the bookings. The web site at <http://www.eghockeyacademy.com> was registered by Mr Jones for the benefit of the Club and that domain name was chosen because it embodied a name by which the Club was known, to identify the academy services as those offered by the Club, not by some other person or persons.
37. Therefore, I reject the case advanced in the Complaint that it was, 'EG Hockey Academy (our business name) which started business in April 2009 and first registered the domain name <http://www.eghockeyacademy.com>.'
38. Before the Complainants' business was even started, the Club's academy services were marketed and sold from April 2009 under the names 'EGHC Hockey Academy' and 'East Grinstead Hockey Academy', names with which both the Respondent and the Club were legitimately connected, in the case of the Respondent through his association with the Club. These names were similar to 'eghockeyacademy', the Domain Name (ignoring the co.uk suffix) later registered by the Respondent.
39. The Domain Name was registered for the purpose of promoting the Club's academy service and used a name, EG Hockey, which would be understood by members of the public as referring to the Club, with the addition of the word 'academy' to identify the services to which the Domain Name related. It has been used from August 2015 entirely properly and fairly, to direct members of the public to the academy services advertised on the main web site of the Club.

40. It was the Club's academy service that was itself copy-catted, by Ms Masters and Mr Jones from the second part of 2010 through the adoption of a business name and latterly a corporate name so obviously similar to the names of the academy services provided by the Club. As a result, members of the public were bound to be confused, as they were in at least one instance, into believing that the academy service in the East Grinstead area offered by EGHALLP was the academy service offered by the Club. All in all, the business of EGHALLP was created on the back of the Club's academy services, by taking unfair advantage of the Club's name, reputation and goodwill. Thus, it was the Complainants' service that piggy-backed on the Club's, not the other way around as alleged.

41. In view of the findings and conclusions set out above, the Respondent has proved the facts necessary to establish the grounds under paragraph 4a.i. B of the Policy. He has also established, in view of all the circumstances, that registration of the Domain Name neither took unfair advantage of, nor was unfairly detrimental to, the Complainants' Rights. Further and in view of those circumstances, the Domain Name has not been used in a manner which has taken unfair advantage of or has been unfairly detrimental to those Rights.

Decision

42. Accordingly, the Complaint fails and the Expert directs that no action be taken with respect to the registration of the Domain Name.

Signed: STEPHEN BATE

Dated 5 September 2016