

DISPUTE RESOLUTION SERVICE

D00019664

Decision of Independent Expert

Oak Floors Online

and

Identity Protect Limited

1. The Parties

Complainant: Oak Floors Online

Unit 56

23 Stockwell Road

Pembroke Dock

Pembrokeshire

SA72 6TQ

United Kingdom

Respondent: Identity Protect Limited
PO Box 786
Hayes
Middlesex
UB3 9TR
United Kingdom

2. The Domain Name

oakfloorsonline.co.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 a such a nature as to call in to question my independence in the eyes of one or both of the parties. The following procedural steps have taken place in the case: -

12 December 2017 09:14	Complaint received by Nominet;
12 December 2017 14:50	Complaint validated by Nominet;
12 December 2017 14:52	Notification of Complaint sent to parties by Nominet;
02 January 2018	Response reminder sent to oakfloorsonline.co.uk@identity-protect.org;
09 January 2018 08:36	No Response received;
09 January 2018 08:36	Notification of No Response sent to the parties;
17 January 2018 11:56	Expert decision payment received.

4. Factual Background

The Complainant seeks the transfer of the Domain Name, the registration of which, it alleges, was and is controlled by one of its former employees, who has refused to

transfer control of the Domain Name, despite having agreed to do so in a legally binding contract.

5. Parties' Contentions

The Complaint alleges as follows, -

- The Complainant's website (oakflooronline.com) was run on the oakflooronline.co.uk domain name for a number of years, the domain name was in a 123-reg account under the control of a company employee named William Morris, who left the Complainant on bad terms.
- There was an arbitration following the termination of Mr Morris' employment, which resulted in a written agreement ('the Agreement') by which he assigned the Domain Name to Simon Kiff of Oak Floors Online and Talbot Timber Limited. This has not been done.
- The 123-reg account controlling the registration of the Domain Name is owned by Talbot Timber, Simon Kiff and Oak Floors Online. It has 123-reg's identity protection paid for on it.
- The person who used to administer the website for the Complainant up until June 2017 was Stuart Robinson. He informed the Complainant of the following matters. He had only had access to the 123-reg account for a short time in 2016 to re-point the oakflooronline.co.uk domain at the oakflooronline.com domain and was 'made' by Mr Morris to promise to destroy any record of the 123-reg account password 'after the change had been made under data protection protocols,' which he did.
- The Complainant wishes to regain control of the Domain Name within the Talbot Timber Ltd 123-reg account with the username simon@talbottimber.co.uk because it is losing web traffic.

- The Complainant telephoned Mr Morris about the Domain Name but he said that he did not want to talk about it and put the phone down.

Nominet validated the Complaint within the time specified in r. 6.1 of the DRS Policy. The Response was due on 4 January 2018. On 3 January 2018 Nominet received an email from Mr Morris in the following terms, -

'.. have responded via letter because the online form refers to me as the 'owner' of the domain and also that I am in 'dispute' of the domain, neither of which are accurate.

My letter was posted 1st class on Saturday, so should arrive with you tomorrow latest.'

No posted letter was received by Nominet. On 11 January 2018, Mr Morris emailed a letter to Nominet in which he asserted that (among other things), -

- He has had nothing to do with the Domain Name since 2016.
- He had no access to the Domain Name since it was transferred from his control in 2016, and it was impossible to assign the domain to Simon Kiff after the arbitration because he did not have access to it as he had already transferred access over to the company who were then working with Simon and Joseph Kiff with regards the promotion and marketing of the website and domain.
- In relation to the telephone call, Mr Morris was at liberty to decline the opportunity to discuss the Complainant's issues and problems in view of the way he has been treated in the past as an employee.

On 23 January 2018, Nominet issued a request to the parties at my invitation, stating –

‘In accordance with paragraph 17.1 of the DRS Policy the appointed expert has requested that the complainant provide the following further information:

1.The Complaint is made in the name of Oak Floors Online. The case advanced is that Mr Morris agreed to assign the domain name to Talbot Timber Limited (TTL) and Simon Kiff (SK). Have TTL and SK agreed that the domain name be transferred into the name of Oak Floors Online?

2.If so, please provide a document or documents establishing that TTL and SK have so agreed.

3.Please give full details as to why Identity Protect Limited is the appropriate respondent to the Complaint.

Please respond to this email with the information required by the expert by 26 January 2018.

The respondent will then have until 01 February 2018 to comment on the further information provided.’

The Complainant made no response to the r. 17 request and provided no further information. There has been no further correspondence from the Registrant or Mr Morris.

6. Discussion and Findings

A Complainant is required under paragraph 2.1 of the Policy to prove on the balance of probabilities that the following two elements are present, namely: -

- he has Rights in respect of a name or mark which is identical or similar to the Domain Name; and
- the Domain Name, in the hands of the Respondent, is an Abusive Registration.

Introduction

I am not satisfied that it would be appropriate to extend the time for filing the Response or to treat the letter in particular as a ‘non-standard submission’ under r. 17. However, in reaching the conclusions set out below I have taken into account the matters identified by Mr Morris in the two items of his correspondence with Nominet. Where his assertions of fact differ to those of the Complainant on the issues decided in this Decision, I have preferred those of the Complainant. I have only made findings on those issues necessary to deciding the case advanced by the Complainant.

In *Bennison v Nominet Ltd* [2017] EWHC 2572 (QB) Lavender J. gave the following explanation of the activities of Identity Protect Ltd, which is the registrant of the Domain Name and the Respondent to this Complaint. In his judgment he stated at [2]

–

‘123-Reg Limited (‘123’) is a company in the GoDaddy EMEA group of companies. 123 operates as a registrar of .uk domain names. It also offers its customers a privacy service, whereby a person such as Mr X can ... have his details on the whois database replaced by those of a company called Identity Protect Limited.’

Rights

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.’

No trade mark Rights or unregistered rights in the nature of passing off appear from the Complaint. I have considered the contents of the website at <http://www.oakfloorsonline.com> but the various items of information on it do not establish unregistered rights. The website identifies the name of the business as ‘Oak Floors Online’, which is highly descriptive as a name and furthermore, the evidence goes nowhere near establishing that that name is distinctive of the business to which it

refers and of none other, even on the basis of a goodwill local to the address in Wales identified on the .com website.

Contractual rights may amount to 'Rights' within the Policy. An agreement to assign the right to own and control a domain name is capable of establishing Rights. Clause 2 of the Agreement made on 27 October 2016 provides, -

'Within one day of receiving cleared funds of the settlement sum into his bank account, the Claimant confirms that he will use all reasonable endeavours to facilitate the transfer to the Respondents of all control, access and ownership, together with all other legal rights arising under common law, statute law, EU law or otherwise of the domain name www.oakflooronline.co.uk. For the avoidance of doubt, the Claimant shall not be responsible for any delay by a third party in transferring the domain name.'

Who or what is the Complainant: a limited company, the trading alias of a limited company or a trading alias of one or more of the individuals behind the business? And is the Complainant a person who 'has' the contractual right? I was hoping that the r. 17 request would assist in resolving the issue of Rights, but that was not the case in view of the lack of response from the Complainant. However, further investigation shows the position to be sufficiently clear, as follows.

Talbot Timber Limited ('TTL') is the sole owner of the contractual rights, as appears from the terms of the Agreement. Contrary to what is suggested in the Complaint, Mr Simon Kiff is not a party to the Agreement and he is not named in it as a person entitled to the benefit of the rights.

The Complaint indicates that the Complainant, Oak Floors Online, is a company; e.g. with references to Mr Morris as a 'company employee'. The Agreement refers in its provisions to the termination of the employment of Mr Morris, to the claims made by him and to the obligation placed on TTL to pay him a sum of £8,000 in settlement of his claims. The draft employee's reference in Schedule 1 also makes clear that TTL was the employing company. That sum of money was paid to Mr Morris on the day

that the Agreement was made, as evidenced by the solicitors' letter dated 7 December 2017, a copy of which accompanied the Complaint.

Therefore, I conclude that the Complainant, Oak Floors Online, is an alias of TTL. TTL owns the sole benefit of the contractual right, which is a valid and subsisting right.

The name 'Oak Floors Online' is identical or similar to 'oakfloorsonline', being the relevant part of the domain name for the purposes of the DRS.

Therefore, I find that the Complainant has Rights in respect of a name or mark, which is identical or similar to the Domain Name. Accordingly, the Complainant has established Rights.

Abusive Registration

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;”*

Paragraph 3 of the Policy states –

‘3. Evidence of Abusive Registration

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

.....
5.1.5 The Domain Name was registered as a result of a relationship between the Complainant and the Respondent, and the Complainant:

5.1.5.1 has been using the Domain Name registration exclusively; and

5.1.5.2 paid for the registration and/or renewal of the Domain Name registration.'

It is clear that the person behind the registration is Mr Morris in view of his responses to the communications sent to him by Nominet during the progress of this case. The Domain Name is held by Identity Protect Ltd, the Respondent, on his behalf. Although the circumstances of the case may not establish the matters in paragraph 5.1.5 of the Policy, paragraph 5 itself states that the factors in it are non-exclusive factors which may evidence Abusive Registration. The key is the definition of Abusive Registration in paragraph 1 of the Policy. I find that Mr Morris made a binding promise to TTL that he would use all reasonable endeavours to transfer the Domain Name to it once he had been paid the settlement sum. Even though he was paid that sum on 27 December 2016, Mr Morris has not done so. To the contrary, he has used to the services of the Respondent to prevent the transfer of the Domain Name to TTL, the Complainant. In those circumstances, the registration is an abusive registration.

7. Decision

Therefore, the Complainant has Rights in a name or mark, which is identical or similar to the Domain Name, and the Domain Name in the hands of the Respondent is an Abusive Registration. The Expert therefore determines that the Domain Name oakfloorsonline.co.uk be transferred to the Complainant.

Signed

STEPHEN BATE

Dated 05.02.18

