

DISPUTE RESOLUTION SERVICE

D00019718

Decision of Independent Expert

Denise McKenzie-Grieg

and

Angela Gibson

1. The Parties

Complainant: Denise McKenzie-Grieg
57 Lightfoot Drive
Carlisle
Cumbria
CA1 3BP
United Kingdom

Respondent: Angela Gibson
63 Lightfoot Drive
Carlisle
Cumbria
CA1 3BP
United Kingdom

2. The Domain Name

<caldbeckjack.co.uk>

3. Procedural History

04 January 2018 14:56 Dispute received
09 January 2018 09:34 Complaint validated
09 January 2018 09:43 Notification of complaint sent to parties

15 January 2018 16:30 Response received
15 January 2018 16:30 Notification of response sent to parties
18 January 2018 01:30 Reply reminder sent
23 January 2018 10:41 No reply received
29 January 2018 15:08 Mediator appointed
08 February 2018 16:25 Mediation started
12 February 2018 17:42 Mediation failed
12 February 2018 17:42 Close of mediation documents sent
13 February 2018 11:41 Expert decision payment received

The Expert has confirmed that he is independent of each of the parties. To the best of his 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 his independence in the eyes of one or both of the parties.

The Expert determines that the proper Complainant in this case is Denise McKenzie-Grieg. While the Complaint was submitted in the name of “Caldbeckjack” the Expert finds this to have been a trading name used by one or both of the parties at various times.

4. Factual Background

The Complainant is a breeder of Jack Russell terriers. She holds a certificate from The Kennel Club dated 20 October 2015, which states that she is entitled to use the kennel name “Caldbeckjack”.

The Domain Name was registered on 13 December 2017.

The Domain Name has been used to resolve to a website at “www.cumbreck.com” which promotes a business named “Cumbreck Jack Russells”.

5. Parties’ Contentions

The Complaint

The Complaint in this case is extremely brief. The Complainant refers to the Kennel Club certification referred to above. She submits that the Respondent is using the Domain Name to divert traffic away from the Complainant’s website (of which no details are provided) to the website of “Cumbreck Jack Russells”, which she states is a business operating in Bulgaria. She also alleges that, by virtue of living in Bulgaria at the date of registration of the Domain Name, the Respondent provided false contact details to Nominet.

The Response

The Respondent states that the Complainant is her estranged mother and that the Complaint in this case represents part of a longstanding family feud (she provides further details of that feud that are not of relevance to this dispute). The Respondent states that she herself has used the name “Caldbeck Jack” in connection with Jack Russell terriers since 1999 and exhibits a third-party website forum posting from 2005 which refers to “Caldbeck jack Russells of Cumbreck kennels.” She states that she registered the Domain Name because, when past customers were looking for her online, they were finding the Complainant by mistake. She states that the Complainant previously used the name “Cumbrian J.R.” before adopting the name “Caldbeck” in 2015 and that the Complainant’s website has been located at “www.mjrt.co.uk” at all material times. She questions why the Complainant did not herself register the Domain Name after 2015 and suggests that the Complainant’s true reason for seeking a transfer of the Domain Name is order to divert the Respondent’s past and potential customers to herself.

The Reply

The Complainant did not file a Reply to the Response.

6. Discussions and Findings

This claim falls to be determined under the Nominet Dispute Resolution Service Policy (“the Policy”).

Under paragraph 2 of the Policy:

- “2.1 A Respondent must submit to proceedings under the DRS if a Complainant asserts to us, according to the Policy, that:*
- 2.1.1 The Complainant has Rights in respect of a name or mark which is identical or similar to the Domain Name; and*
 - 2.1.2 The Domain Name, in the hands of the Respondent, is an Abusive Registration*
- 2.2 The Complainant is required to prove to the Expert that both elements are present on the balance of probabilities.”*

Under paragraph 1 of the Policy the term “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.”

Also under paragraph 1 of the Policy, the term “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. is being or has been used in a manner which took unfair advantage of or was unfairly detrimental to the Complainant's Rights.”*

Paragraph 5 of the Policy sets out a non-exhaustive list of factors that may be evidence that a domain name is an Abusive Registration. Paragraph 8 of the Policy sets out a non-exhaustive list of factors that may be evidence that it is not an Abusive Registration. However, all such matters are subsidiary to the overriding test for an Abusive Registration as set out as in paragraph 1 of the Policy.

Rights

The Complainant has provided little assistance to the Expert in determining whether she has Rights in the name “Caldbeckjack” for the purposes of the Policy. While a complainant need not necessarily demonstrate registered trademark rights, it is necessary, in order to establish unregistered rights, to demonstrate the use of the name in commerce such that it has become associated with the complainant in the minds of consumers as the provider of the goods or services supplied under that name. In general, a complainant will provide evidence of such items as its customer numbers, the value of sales made under the name and promotional expenditure as well as evidence of market recognition.

While the Complainant has submitted no such evidence in this case, she has produced evidence that she is a breeder of Jack Russell terriers and that she holds a Kennel Club certification entitling her to use the kennel name “Caldbeckjack”. The Expert has reviewed the Complainant’s website at “www.mjrt.co.uk” and the records of that website available at “www.archive.org” and notes that the Complainant has used the name “Caldbeckjack” in connection with her website since at least January 2016, although she previously used the name “Cumbrian Miniature Jack Russells”. That website has included sections for “Available Puppies” and “Reservations” and has from time to time provided details of litters of puppies available for sale.

Based on the evidence of the Complainant’s use of the name “Caldbeckjack” in connection with her business, although scant, the Expert finds on balance that the Complainant has Rights in that name, in the nature of unregistered trademark rights, for the purposes of paragraph 1 of the Policy. The Expert notes, however, that while the Complainant has established the necessary threshold interest in a name corresponding to the Domain Name, this does not of itself imply any right of exclusivity in that name, nor any finding about the potential rights of any other party in relation to that name.

The name “Caldbeckjack” is identical to the Domain Name but for the formal suffix “.co.uk” and the Expert therefore finds that the Complainant has Rights in respect of a name or mark which is identical or similar to the Domain Name.

Abusive Registration

It appears to the Expert on the available evidence that, while the Complainant has used the name “Caldbeckjack” in connection with Jack Russell terriers since 2015, the Respondent used a similar name at some point in the past and that the Complainant herself used the name “Cumbrian Miniature Jack Russells” until 2015. The Respondent argues in these circumstances that the Complainant’s adoption of the name “Caldbeckjack” in 2015 was misleading, just as the Complaint argues that the Respondent’s registration of the Domain Name in December 2017 is misleading.

Under paragraph 8.1.1 of the Policy, a Respondent may be able to show that a domain name registration is *not* an Abusive Registration where the Respondent has:

“8.1.1.1 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; [or]

8.1.1.2 been commonly known by the name or legitimately connected with a mark which is identical or similar to the Domain Name...”

In this regard, it is not sufficient for a Respondent merely to show some past use of the name in question where there is evidence nevertheless of an abusive intent in registering the disputed domain name (see *e.g.* paragraph 4.5 of the Nominet Dispute Resolution Service Experts’ Overview, Version 3 (“the Experts’ Overview”)). On the other hand, a registration may be legitimate, even if the domain name is causing confusion, where for example (as discussed in paragraph 4.7 of the Expert Overview):

“... the Respondent’s registration and use of the domain name predates the Complainant’s rights, the Respondent has not changed his use of the domain name to take advantage of the Complainant’s rights and the Respondent’s behaviour has been unobjectionable.”

In this case, the Respondent’s registration of the Domain Name did not predate the Complainant’s use of the name “Caldbeckjack” and the Expert accepts that the Respondent’s motivation in registering the Domain Name appears questionable, particularly in the context of the unfortunate family dispute of which this Complaint forms part. The Expert also comments that the Complainant’s failure herself to register the Domain Name after 2015 would not provide a justification for another party to register the name in bad faith. However, importantly in this case, the Expert finds that the Respondent did use the name “Caldbeck Jack Russells” in connection with the sale of Jack Russell terriers prior to the Complainant’s use of the name “Caldbeckjack” and at a time when the Complainant was trading as “Cumbrian Miniature Jack Russells”. In these circumstances, it appears to the Expert that there is a genuine dispute between the parties over the rights in the name “Caldbeckjack”, in which potential claims of passing off have been intimated by each party against the other. That dispute itself is not within the remit of the Expert to resolve, nor would it appear straightforward to determine in the absence of significant further evidence, including the oral testimony of the parties.

However, even in a case of a genuine dispute, a complainant may still succeed in showing that a domain name was registered abusively if one of the grounds set out in paragraph 5.1 of the Policy can be established. While in this case the Complainant fails to set out the specific grounds on which she relies, it appears to the Expert that she alleges either that the Respondent registered the Domain Name primarily for the purpose of unfairly disrupting the Complainant's business (paragraph 5.1.1.3 of the Policy) or for the purpose of deceiving Internet users into believing that the Domain Name is owned or operated by the Complainant (paragraph 5.1.2 of the Policy).

In this case, the Complainant seeks to deprive the Respondent of the Domain Name and to have it transferred to herself. In order to succeed in this, she must meet the onus of proving, on the balance of probabilities, that the Domain Name was registered abusively. While the Complainant argues that the Respondent registered the Domain Name to take unfair advantage of her current business activities, the Respondent puts the case that she legitimately registered the Domain Name, having been the first to use the name "Caldbeck Jack", and that it was the Complainant who misappropriated this name from her in 2015. The Complainant has not assisted her case by the sketchy nature of the Complainant and her failure to file any Reply in answer to the matters raised by the Respondent in her Response, and considering the opposing submissions and the evidence in the round, the Expert does not consider that the Complainant has succeeded in proving on the balance of probabilities that the Respondent's registration of the Domain Name was unfair and therefore abusive.

7. Decision

The Complainant has established for the purposes of the Policy that she has Rights in respect of a name or mark which is identical or similar to the Domain Name. However, she has failed to demonstrate to the satisfaction of the Expert that the Domain Name, in the hands of the Respondent, is an Abusive Registration. The Complaint is therefore dismissed.

[Signed]

Steven A. Maier
Independent Expert

Dated 1 March 2018