

DISPUTE RESOLUTION SERVICE**D00020868****Decision of Independent Expert****Lancashire Plant Limited****and****A1 Supa Skips Ltd****1. The Parties**

Complainant: Lancashire Plant Limited
80 Lancaster Road, Overton
Morecambe
Lancashire
LA3 3EZ
United Kingdom

Respondent: A1 Supa Skips Ltd
The Old Power Station
Lancaster
Lancashire
LA1 5QP
United Kingdom

2. The Domain Name

<lancasterconcrete.co.uk> (the "Disputed Domain Name")

3. Procedural History

The Complaint was filed with Nominet on 26 November 2018. Nominet validated the Complaint the same day and notified the Respondent by post and by email, stating that the Response had to be received on or before 17 December 2018.

The Response was filed on 14 December 2018. On the same day Nominet notified the Complainant that a Reply had to be received on or before 21 December 2018. A Reply was received on 17 December 2018 and the mediator was appointed on the same day.

The Informal Mediation procedure failed to produce an acceptable solution for the parties and so on 9 January 2019 Nominet informed the Complainant that it had until 23 January 2019 to pay the fee for the decision of an Expert pursuant to paragraph 13 of the Nominet Dispute Resolution Service Policy ("the Policy"). On 23 January 2019 the Complainant paid Nominet the required fee.

On 28 January 2019 the undersigned, Jane Seager ("the Expert"), confirmed to Nominet that she was independent of each of the parties and that, to the best of her knowledge and belief, there were no facts or circumstances, past or present (or that could arise in the foreseeable future) that needed to be disclosed which might be of such a nature as to call in to question her independence in the eyes of one or both of the parties.

4. Factual Background

The Complainant, Lancashire Plant Limited, is a company based in Morecambe, Lancashire, offering a wide range of services to industry and householders, including demolition services, haulage, waste management and plant hire. The Complainant recently expanded its activities to provide additional concrete products and building supplies.

The Respondent, A1 Supa Skips Ltd, is connected to a group of companies based in Lancaster, Lancashire that offers various services such as waste management and recycling. One of its branches, Quay Concrete, specialises in providing concrete.

The Disputed Domain Name was registered on 31 August 2018 and is currently redirecting to one of the Respondent's official websites at <https://quayconcrete.co.uk/>.

5. Parties' Contentions

Complaint

Complainant's Rights

The Complainant submits that on 30 August 2018 it advertised, via Facebook, that it had purchased a volumetric concrete mixer and would be providing concrete using the name Lancaster Concrete. The Complainant states that its new business required a stand-alone website and that it wanted to register the Disputed Domain Name since it corresponded to its trading name. The Complainant asserts that it learnt that the Disputed Domain Name had been registered on 31 August 2018, one day after the Facebook post mentioned above, by one of its main rivals in the concrete supply business, Quay Concrete.

Abusive Registration

The Complainant believes that the Respondent registered the Disputed Domain Name deliberately to stop the Complainant from using that Disputed Domain Name and to cause confusion or harm to the Complainant's business. Moreover, the Complainant asserts that the Respondent is now directing traffic from the Disputed Domain Name to its own website. As a consequence, internet users may become confused and such confusion may result in customers believing that Lancaster Concrete is a trading name of Quay Concrete when it is not.

Furthermore, the Complainant argues that the Respondent does not use the trading name Lancaster Concrete. According to the Complainant, there appears to be no legitimate reason why the Respondent registered the Disputed Domain Name the day after the Complainant's announcement of the launch of its activities in the concrete industry under the name Lancaster Concrete.

Response

The Respondent argues that the Disputed Domain Name is not abusive, and does not infringe the Complainant's Rights. First of all, the Respondent underlines that the Complainant's Facebook post advertises its company as Lancaster Concrete Ltd, and argues that the Complainant cannot do that as it has not registered this name with Companies House, unlike the Respondent. The Respondent submits that it has the right to use the Disputed Domain Name as it is the owner of Lancaster Concrete Ltd and the Disputed Domain Name has been registered by the Director of Lancaster Concrete Ltd. The Respondent also states that it has, for many years, purchased domain names that are appropriate to its operations, and redirected them to its websites – these are historical in nature, and have never been purchased maliciously.

Furthermore, the Respondent believes that the Complainant has used the Respondent's tag line ("Only pay for what you use") and designed their vehicle livery to appropriate custom from the Respondent.

The Respondent asserts that Lancaster is where the Respondent is based, and where it has been providing concrete for the last 9 years.

Moreover, the Respondent adds that the Disputed Domain Name, even if the Respondent did not own Lancaster Concrete Ltd, would be too generic a name for two local companies to dispute its use.

According to the Respondent, any other use of the Disputed Domain Name would be unfair trading, and would directly impact its relationship with the customers, and any prospective opportunities with new clients.

Finally, the Respondent asserts that the Complainant's livery, advertisement and use of "Only pay for what you use" are direct attempts to emulate the Respondent's operation, and are a malicious attempt to restrict the Respondent's trading.

Reply

The Complainant highlights the fact that the Respondent's company, Lancaster Concrete Ltd, was registered on 28 November 2018, two days after the Complaint was filed with Nominet. The Complainant also underlines that the company is listed as dormant. Therefore, the Complainant argues that the company registration was a reaction to the Complaint and that the Respondent has no intention to use Lancaster Concrete as a company name. The Complainant does not accept that the company registration was a coincidence, but argues that it was a deliberate action to legitimise registration of the Disputed Domain Name and / or to cause harm to the Complainant's business.

The Complainant asserts that Lancaster Concrete has been a trading name of its company since September 2018. Furthermore, the Complainant points out that the Respondent has been trading for 9 years under a different name.

Moreover, the Complainant relies on the list of domain names provided by the Respondent to assert that the Respondent did not register any domain names between May 2012 and August 2018. The Complainant argues that, since the filing of the Complaint, the Respondent has registered 6 further domain names, all mentioning towns which are within the local area of the Complainant's trade. The Complainant therefore asserts that the Respondent is attempting to make it potentially impossible for the Complainant to trade. Again, the Complainant argues that the Respondent's domain name registrations after its Facebook post and Complainant to Nominet simply cannot be a coincidence.

The Complainant provides evidence that its business card contains the tag line "For all your concrete needs" and not "Only pay for what you use" as suggested by the Respondent. The Complainant also supplies screenshots from various websites to show that the phrase "Only Pay For What You Use" is common to almost every single volumetric concrete business in the United Kingdom. According to the Complainant, the Respondent has no trade mark relating to the said tag line and cannot have a monopoly over it.

The Complainant points out that its volumetric concrete mixer was already blue upon purchase from Scotland. The Complainant therefore states that it was an obvious decision to keep this theme for that vehicle. The Complainant asserts that it has instructed a brand and marketing expert to design the Complainant's website and the expert helped with creating a new logo and colour scheme. The blue used was therefore a simple coincidence.

The Complainant denies the fact that using the trading name Lancaster Concrete would be unfair trading or could cause any impact to the Respondent. The Complainant points out that Lancaster Concrete is totally different from the Respondent's trading name Quay Concrete. On the contrary, the Complainant asserts that the registration of the Disputed Domain Name by the Respondent is likely to confuse the public and to have an adverse effect on the Complainant's business operations.

Finally, the Complainant states that it has no intention of attempting to restrict the Respondent's efforts to trade and asserts it has a completely different business model.

6. Discussions and Findings

General

Under paragraph 2.1 of the Policy, for the Expert to order a transfer of the Disputed Domain Name, the Complainant is required to demonstrate, on the balance of probabilities, both of the following elements:

"(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

The Policy defines Rights as "*rights enforceable by the Complainant, whether under English law or otherwise*".

The Complainant has not supplied evidence of any registered trade marks in respect of the term LANCASTER CONCRETE (or any other relevant term) and so the issue is whether the Complainant has established that it has any unregistered rights in the term, by virtue of having used it in the course of trade, which would amount to Rights for the purpose of the Policy. In this regard it should be noted that Section 2.3 of the Experts' Overview provides that the first hurdle is intended to be a relatively low-level test, and that the objective for a complainant is simply to demonstrate a *bona fide* basis for making a complaint. It is also generally established that a complainant only needs to prove Rights at the time a complaint is filed, and not that such Rights pre-date the registration of the domain name in question.

The Complainant has evidenced its trading activity under the name Lancaster Concrete by submitting the photos of its vehicle branding and its business card as well as a screen capture of its Facebook profile "Lancaster concrete ltd". Moreover, the Complainant is currently operating as Lancaster Concrete at the website www.lancasterconcreteltd.co.uk (Section 5.10 of the Experts' Overview allows Experts to check material which is generally in the public domain). The Expert is therefore satisfied that the Complainant possesses Rights in accordance with the Policy.

Furthermore, the Policy stipulates that the name or mark in which the Complainant has Rights (LANCASTER CONCRETE) must be identical or similar to the Disputed Domain Name (<lancasterconcrete.co.uk>). It is accepted practice under the Policy to discount the ".CO.UK" suffix (unless it is significant in the relevant context), and as a result the Expert finds that paragraph 2.1.1 of the Policy is satisfied and that the Complainant has Rights in respect of a name which is identical to the Disputed Domain Name.

Abusive registration

"Abusive Registration" is defined in paragraph 1 of the Policy to mean a domain name which:

- "(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."*

The Complainant and the Respondent have put forward completely conflicting assertions as to why and for what purpose the Disputed Domain Name was registered, and it is for the Expert to examine all the available evidence and decide which party's version is the most credible.

In short, the Complainant alleges that the Respondent abusively registered and used the Disputed Domain Name after noticing the Complainant's announcement posted on 30 August 2018 on its Facebook page "Lancaster concrete ltd": *"Heysham demolition and plant hire are proud to announce we will shortly have our first volumetric concrete wagon*

on the road. Only pay for what you use! Minimum 1 cube charge! We will be offering a 7 day per week service at competitive rates which will cover Lancaster and South Lakes area! For more information please call (...)". The Complainant justifies this assertion by stating that the Respondent registered the Disputed Domain Name the following day, on 31 August 2018. On the other hand, the Respondent submits that it has the right to use the Disputed Domain Name as it is the owner of the company Lancaster Concrete Ltd and that it has, for many years, purchased domain names that are appropriate to its operations, and redirected them to its websites.

On the basis of the facts and evidence presented, on the balance of probabilities the Expert finds the Complainant's version of events to be the most plausible for a number of reasons, including the following:

- It is undisputed, based on the content of websites belonging to companies connected to the parties, that the Complaint and the Respondent are competitors providing very similar services. What's more, they operate in a very narrow field and are geographically close.
- The Complaint was filed with Nominet on 26 November 2018 and Nominet notified the Respondent by post and by email on the same day. The Respondent registered the company Lancaster Concrete Ltd on 28 November 2018. The Respondent has been trading under the name "Quay Concrete" since 2009 and no evidence would suggest that any of the competing businesses that the Respondent is connected with has ever used a brand containing the term "Lancaster Concrete".
- The Respondent has registered the following domain names:
 - <lancasterskiphire.co.uk> in 2007;
 - <skipsthinkpink.co.uk> in 2008;
 - <supagrab.co.uk> in 2008;
 - <supamix.com> in 2008;
 - <kendalskiphire.co.uk> in 2008;
 - <morecambeskiphire.co.uk> in 2008;
 - <quayconcrete.co.uk> in 2009;
 - <supasweep.co.uk> in 2009;
 - <heyshamskiphire.co.uk> in 2010;
 - <heyshamskips.co.uk> in 2010;
 - <lancasterdemolition.co.uk> in 2011;
 - <keyconcrete.co.uk> in 2011;
 - <grantparkerltd.co.uk> in 2012;
 - <lancasterconcrete.co.uk> (the Disputed Domain Name) on 31 August 2018;
 - <benthamconcrete.co.uk> on 30 November 2018;
 - <carnforthconcrete.co.uk> on 30 November 2018;
 - <galgateconcrete.co.uk> on 30 November 2018;
 - <heyshamconcrete.co.uk> on 30 November 2018;
 - <kendalconcrete.co.uk> on 30 November 2018; and
 - <morecambeconcrete.co.uk> on 30 November 2018.

The Expert notes that the Respondent started registering the domain names composed of the word "concrete" and a geographical indication in 2018. All of the domain names following such pattern, apart from the Disputed Domain

Name, were registered shortly after the Complaint was filed with Nominet on 26 November 2018.

- The Disputed Domain Name is currently redirecting to the website at <https://quayconcrete.co.uk/> belonging to the Respondent.

Therefore, the Expert considers that there is compelling evidence that the Respondent abusively registered the Disputed Domain Name after noticing the Complainant's announcement on the launch of its activities under the name Lancaster Concrete, and then used it abusively to point to its competing website offering similar services to the Complainant in the hope of securing business meant for the Complainant. The Respondent's subsequent actions upon receipt of the Nominet Complaint, namely the incorporation of a company with a matching name and the registration of various domain names following the same naming pattern (place name plus "concrete"), only serve to reinforce this view and simply appear to be an attempt to justify the registration and use of the Disputed Domain Name.

Paragraph 5.1 of the Policy sets out a non-exhaustive list of factors that may be evidence of abuse, and in view of the above on the balance of probabilities the Expert finds that 5.1.1.2 and 5.1.1.3 referring to abusive registration are made out, as follows:

"5.1.1 Circumstances indicating that the Respondent has registered or otherwise acquired the Domain Name primarily:

[]

5.1.1.2 as a blocking registration against a name or mark in which the Complainant has Rights; or

5.1.1.3 for the purpose of unfairly disrupting the business of the Complainant"

The Expert also finds that, as far as abusive use is concerned, paragraph 5.1.2 is also made out, as follows:

"5.1.2 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"

In the Expert's opinion the circumstances outlined in the parties' submissions are a classic example of a situation that the Nominet Policy is intended to deal with.

For the sake of completeness, it should also be noted that paragraph 8.1 of the Policy sets out a non-exhaustive list of factors which may be evidence of non-abuse. On the face of it, paragraphs 8.1.1.1, 8.1.1.2 and 8.1.2 could appear to be potentially relevant to the Respondent, and they read as follows:

"8.1.1 Before being aware of the Complainant's cause for complaint (not necessarily the 'complaint' under the DRS), 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;

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;

(...)

8.1.2 The Domain Name is generic or descriptive and the Respondent is making fair use of it"

As far as paragraph 8.1.1.1 is concerned, in the Expert's view an offering of goods and services cannot be said to be genuine if it attempts to take unfair advantage of another company's reputation. Turning to paragraph 8.1.1.2, even though the Respondent's subsequent company name can be said to be identical to the Disputed Domain Name, the Respondent cannot be said to be "commonly known" by such a name, as the company was only recently incorporated after the filing of the Complaint. Furthermore, the obtention of a company name does not automatically legitimise the registration of a corresponding domain name, and in any case the mere registration of a company name does not mean that such a name is necessarily legitimate. As for paragraph 8.1.2, as explained above, the Respondent's use of the Disputed Domain Name at the time that the Complaint was filed could certainly not be described as fair in view of the Complainant's Rights. As a result, none of the factors at paragraph 8.1 of the Policy offer any assistance to the Respondent.

In conclusion, the Expert has considered the admissibility, relevance, materiality and weight of the evidence as a whole and is satisfied that the Complainant has succeeded in proving, on the balance of probabilities, that the Disputed Domain Name is an Abusive Registration in accordance with paragraph 2.1.2 of the Policy.

7. Decision

The Expert finds that the Complainant has Rights in a name which is similar to the Disputed Domain Name, and that the Disputed Domain Name, in the hands of the Respondent, is an Abusive Registration. The Disputed Domain Name should therefore be transferred to the Complainant.

Jane Seager
13 February 2019