

# **DISPUTE RESOLUTION SERVICE**

**D00020949**

## **Decision of Independent Expert**

**Tom Hartley Jnr Limited**

and

**Identity Protect Limited/Mr Jonathan Foxx**

### **1. The Parties:**

Lead Complainant: Tom Hartley Jnr Limited  
Address: Barratt Mill  
Swadlincote  
Derbyshire  
DE12 6BL  
United Kingdom

Complainant: Mr Thomas Hartley  
Address: Barratt Mill  
Swadlincote  
Derbyshire  
DE12 6BL  
United Kingdom

Respondent: Identity Protect Limited/  
Mr Jonathan Foxx  
Address: PO Box 786  
Hayes  
Middlesex  
UB3 9TR  
United Kingdom

### **2. The Domain Name:**

tomhartleyjnr.co.uk (the “Domain Name”)

### **3. Procedural History:**

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

Definitions used in this decision have the same meaning as set out in the Nominet UK Dispute Resolution Service Policy Version 4, October 2016 (the “Policy”) unless the context or use indicates otherwise.

7 March 2019	Dispute received
8 March 2019	Complaint validated and notification of complaint sent to the parties
27 March 2019	Response reminder sent
28 March 2019	Response received and notification of response sent to the parties
2 April 2019	Reply reminder sent
3 April 2019	Reply received and notification of reply sent to the parties
8 April 2019	Mediator appointed
10 April 2019	Mediation started
9 July 2019	Mediation failed
9 July 2019	Close of mediation documents sent
19 July 2019	Expert decision payment received

### **4. Factual Background**

The Lead Complainant was incorporated in England on 1 October 2008 with registration number 06712857. The Lead Complainant has been trading as Tom Hartley Jnr since May 2014 specialising in the classic car market and modern luxury and exotic vehicles. The Complainant has since 1 October 2008 been the sole director and owner of 100% of the share capital of the Lead Complainant.

The Complainant, born in 1983, is the son of Thomas Hartley (senior). The Complainant was a director of Thomas Hartley Cars Limited between 29 October 2009 and 31 October 2014, a company incorporated in England with registration number 07061171. This business, started by Thomas Hartley senior, engaged in the sale of high class vehicles.

The Respondent registered the Domain Name on 1 June 2014. The Domain Name is registered in the name of Identity Protect Limited but the Response was filed by Mr Jonathan Foxx who appears to be the underlying registrant of the Domain Name. Mr Jonathan Foxx is therefore treated as the Respondent in this Complaint.

### **5. Parties’ Contentions**

#### **The Complaint**

#### ***Complainant’s Rights***

The Complainants’ assertions of rights in the name TOMHARTLEYJNR is that:

1. The annual turnover value of cars and other vehicles sold by the Lead Complainant since commencing trading on 30 May 2014 is as follows:

Year	Turnover (£ GBP)
2014/15	£42,081,057.00
2015/16	£66,674,935.00
2016/17	£80,124,747.00
2017/18	£103,521,178.00

2. An article published by Automotive Management (AmOnline) on 4 June 2018 shows the Lead Complainant to be one of the largest independent used car dealerships in the UK based on turnover (ranked 7<sup>th</sup>) and annual profit (ranked 6<sup>th</sup>) with an overall ranking of 12<sup>th</sup> in the independent dealer top 50.
3. The Lead Complainant currently advertises and promotes its business using the domain name [www.tomhartleyjnr.com](http://www.tomhartleyjnr.com), registered on 2 October 2008. The Lead complainant exhibits evidence of regular advertising and promotion in articles online and in print and the use of social media such as Twitter, Facebook and Instagram to advertise and promote its business.
4. As a result of the Lead Complainant's reputation it was a winner of the Queen's Award for International Trade in 2018.
5. The Lead Complainant is the owner of European Union trade mark No. 016176489 TOM HARTLEY JNR, registered on 15 May 2017.
6. The Lead Complainant claims rights in the company name Tom Hartley Jnr Limited and unregistered rights in the name and trade mark TOM HARTLEY JNR.
7. As a director and equal shareholder with his father and brother of Tom Hartley Cars Limited, the Complainant is well known and has always been known in the car business as Thomas Hartley Jnr or Tom Hartley Jnr.
8. Copies of online articles from 2001 until 2018 are exhibited to show that the Complainant is and has been known as Tom Hartley Jnr and as evidence of his personal reputation acquired since the late 1990s in connection with the selling of classic cars and modern luxury and exotic vehicles.
9. The Complainants cite *Pomeroy v Scale* (1907) 24 RPC 177 that, for the purposes of passing off, the name sued upon need not be the personal name of the claimant.
10. The Complainants cite DRS 05718 ([constancebriscoe.co.uk](http://constancebriscoe.co.uk)) in which the complainant (Constance Briscoe) did not have any registered trade mark rights protecting her name, but rights in her name were established based on her birth certificate and passport and as the author of a best-selling book.
11. The Complainant contends that from the use of his personal name and the name by which he is always known in business he has acquired unregistered rights in the names Thomas Hartley and Tom Hartley Jnr and in the goodwill that exists in these names. Therefore the use of the Domain Name by the Respondent amounts

to a misrepresentation likely to result in damage by the tort of passing off. Furthermore, the names Thomas Hartley and Tom Hartley Jnr. are not common names.

12. The Complainants cite further DRS cases:
  - a. In DRS 00693 (tahirmohsan.co.uk) the expert decided that the Complainant's name, and the fact that it is uncommon in the United Kingdom, are sufficient to establish Rights in that name. On this basis the Complainant contends that he has rights in the names Thomas Hartley and Tom Hartley Jnr and that Tom Hartley Jnr. is important to his identity. As far as the Complainant is aware there is no other person anywhere worldwide known by this name.
  - b. In DRS 12276 (hvidbro-mitchell.co.uk) the appeal Panel said that for a right to be relevant it must be an enforceable right under some system of law. The complainant, an individual, claimed rights under the Data Protection Act 1998 and the Human Rights Act 1998. The Panel concluded that an individual would have actionable rights to object to certain types of conduct by others where the provisions of these statutes were breached, and it is clear that the conduct in question could involve the use of that individual's name. The Panel decided that such rights would be "rights enforceable by the complainant, whether under English law or otherwise" sufficient to establish Rights under the Policy since the test is a relatively low threshold that is simply to demonstrate a *bona fide* basis for making the complaint. The Panel also noted that there is nothing in the Policy to restrict its application to persons engaged in business. A distinction whereby persons in business who can show a low threshold in terms of goodwill and can thus establish Rights, but individuals who do not trade could not do so, was to the Panel anomalous.
13. Having regard to DRS 12276 the Complainant claims that under Section 84 of the Copyright Designs and Patents Act 1988 he has the right to prevent false attribution of a work to him. The content of any website using the Domain Name is likely to contain work which is a literary work (original written text) or an artistic work (logo, drawings etc) which may be falsely attributed to the Complainants. The Complainants quote Section 84(1), (2) and (4) (which are not repeated here).
14. The Domain Name may also constitute a literary work in which the Complainant has rights. Under Section 3(1) of the Copyright Designs & Patents Act 1988 a "literary work" means any work, other than a dramatic or musical work, which is written, ...".
15. Another possible right exists under the Fraud Act 2006 wherein a false representation is made by a person to make a gain or to cause loss to another or to expose another to a risk of loss, and such a representation is false if it is untrue or misleading and the person making it knows that it is, or might be, untrue or misleading.

### ***Abusive Registration***

The Complainant's assertions of Abusive Registration are:

1. The Domain Name was registered shortly after it had been announced in the press that Tom Hartley Jnr was leaving Tom Hartley Cars Limited to set up on his own.
2. During September and October 2014, Mr Jonathan Foxx had posted derogatory and offensive comments on Twitter concerning the Complainant and with reference to the Lead Complainant and provides evidence of the same (the comments are offensive and not repeated here).
3. The Complainants contend that the Respondent registered the Domain Name simply to prevent its registration by the Complainants contrary to §5.1.1.2 of the Policy. From DRS 05718 (constancebriscoe.co.uk) it is clear that registering the Domain Name does block the Complainant from doing so.
4. As far as the Complainants are aware for most of the time that the Domain Name has been registered it has not been in use and is not currently in use. When it has been used it has been to direct visitors to other sites such as Foxx Media.
5. A printout from the Wayback Machine dated 23 April 2017 shows that in 2017 the Domain Name was being used for a website that in some way directed visitors to Foxx Media (enquiries@foxxmedia.co.uk). Currently the Domain Name is not active. The Complainants believed, at the time of the Complaint, that a Mr Jonathan Foxx was the underlying owner behind the Domain Name.
6. The name and trade mark is distinctive and associated only with the Complainants. There is no reason why the Respondent would have registered the Domain Name other than in the knowledge of, and to take unfair advantage of, the goodwill that attaches to the Complainant's name and trade marks. The Respondent's derogatory comments on Twitter (referred to in para 2 above) evidence an interest in acting detrimentally to the Complainants.
7. The Domain Name is inherently misleading in that it constitutes an impersonation of the Complainants. The Respondent has used the Domain Name for the purpose of redirecting Internet users to an e-mail address for his business and which may prevent or may have prevented legitimate business enquiries being received by the Complainants. This has or would unfairly disrupt the Complainants' business contrary to §5.1.1.3 of the Policy.
8. For the purposes of passing off there is no length of time during which the claimant or a predecessor must have used the mark or name in question. The question is simply whether the claimant has sufficient goodwill. The Complainant cites *Global Projects Management Ltd v Citigroup Inc* [2006] FSR 39 where within one day of the announcement of the proposed merger of two US based financial companies, Citibank and Travellers Group, under the name Citigroup Inc, a third party registered the domain name 'citigroup.co.uk'. Citigroup obtained summary judgment in a passing off claim in the UK against the registrant of this domain name. Further, in *Allen v Brown Watson* [1965] RPC 191, heavy pre-publication advertising was sufficient to establish passing off.
9. The Respondent has used the Domain Name for a website to refer visitors to its own business. Although §5.1.2 of the Policy states "*is using or threatening to use the Domain Name*" it is contended that past use is also relevant in that one of the definitions of Abusive registration is that a domain name "*has been used in a*

*manner which has taken unfair advantage of or has been unfairly detrimental to the Complainant's Rights”.*

10. The Complainants rely on the concept of “initial interest confusion” as described in §3.3 of the Experts’ Overview and say that the Respondent’s use of the Domain Name would cause such confusion since:
  - a. the Domain Name is identical to the name of the Complainants in which they have Rights;
  - b. that name is the personal name of the Complainant;
  - c. it is the name and trade mark of the Complainant’s business; and
  - d. it has no meaning other than as a reference to the Complainant and the business,

and therefore the risk of the type of initial interest confusion outlined in the Experts’ Overview happening is readily apparent. Any visitor to the website to which the Domain Name resolved would have been met with a page containing information or links to the websites of a third party or parties with no connection with and who may be competitors to the Complainant. Such use of the Domain Name takes unfair advantage of and was unfairly detrimental to the Complainants’ Rights as 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 is contrary to §5.1.2 of the Policy.

11. The Domain Name is an exact match with the Complainant’s name and the name and trade mark of the Lead Complainant. The Complainants have Rights having been known as Tom Hartley Jnr personally and in business for many years prior to registration of the Domain Name. The Domain Name is distinctive and associated with the Complainants and the Respondent has no reasonable justification for having registered it contrary to §5.1.6 of the Policy.

## **The Response**

The Respondent says that the Complaint should not succeed because:

1. This is the third occasion that the Complainant has raised a complaint and all have been unsuccessful (DRS 20346 and DRS 14933 with “the latter employing an expert decision [citing] trademark which resulted in no action”).
2. The Respondent commends Tom Hartley's continued financial success, but question the validity of multiple complaints on the same topic. If the Complainant would like to offer to purchase the Domain Name he should do that that via email instead of repeated submittals of Nominet complaints.
3. The Government website <https://www.gov.uk/guidance/unacceptable-trade-marks> states that:
  - a. A domain name is a name by which a company or organisation is known on the internet. It usually incorporates the company name, or other identifier.

- b. Being the owner of a registered trade mark, does not automatically entitle you to use that mark as a domain name. The main reason being, that the same trade mark can be registered for different goods or services and by different proprietors. Also, someone may have already, and quite legitimately, registered the domain name, perhaps with its use being connected with unregistered goods or services.
4. The Respondent sets out the full text of the classes under which the trademark Tom Hartley Jnr (EU016176489) is registered (being Class 12, Class 35, Class 36, Class 37) which is not repeated here.
5. The intended use for the Domain Name falls outside of any of these classes.
6. The Respondent maintains the right to use the Domain Name and will respect and ensure there will be no confusion or likeness between its domain and those of the Complainants.

## **The Reply**

The Complainant replies to the Response as follows:

1. The Respondent claims that the Domain Name is intended to be used for activities not covered by the goods and services specified for EU trade mark registration No. 016176489 but provides no information on the nature of the activity or activities for which it intends to use the Domain Name.
2. The Respondent provides no evidence of the circumstances set out in §8.1 of the DRS Policy by which a Respondent may demonstrate that the registration and/or use of the Domain Name is not an Abusive Registration.
3. The Domain Name is not generic or descriptive. On the contrary, it is the full name of the Lead Complainant and the trade mark registered and used by the Lead Complainant. It is also the name by whom the Complainant is known.
4. There is no written agreement between the parties and the Domain Name is not of a significantly different type or character to the other domain names registered by the Respondent. The Lead Complainant owns the corresponding domain name [www.tomhartleyjnr.com](http://www.tomhartleyjnr.com).
5. In view of the evidence and arguments already submitted and having regard to the above it is submitted that when the Domain Name was registered it took unfair advantage of or was unfairly detrimental to the Complainants' Rights. Further, as shown in the evidence the Domain Name has been used to potentially divert customers of the Complainants' business to the website of the Respondent. It is, therefore, also submitted that the Domain Name has been used in a manner which has taken unfair advantage of or been unfairly detrimental to the Complainants' Rights. The fact that the Domain Name has been and may be intended to be used for activities not covered by the goods and services of the Lead Complainant's EU trade mark registration does not mean that these circumstances do not arise. Its use by the Respondent for other activities is, having regard to the nature of her Domain Name, likely to falsely imply a commercial connection with the Complainants. There is likely to be "initial interest confusion" which is not only directed by the content of the website. The goods or services may be competitive notwithstanding they are not covered by

the EU trade mark registration. The use of a domain name for competing goods and/or services can be the finding of Abusive Registration (see *Toshiba Corporation v Power Battery Inc* (DRS 07991) <toshiba-laptop-battery.co.uk>).

6. It is noted that the Respondent offers to sell the Domain Name to the Lead Complainant or Complainant. In the circumstances of this case it is submitted that this, in combination with the intention to use the Domain Name, is a threat to unfairly disrupt the business of the Complainants and thus it is an Abusive Registration.
7. The Policy discourages but does not make an absolute prohibition on the filing of second or subsequent complaints. Complaints DRS 20346 and DRS 14933 were complaints filed only by the Lead Complainant without representation. The Complainant was not a party to these proceedings. The earlier complaint was filed and determined at a time when evidence submitted in the current Complaint was either not in existence or not known to the Lead Complainant (eg the use made of the Domain Name). The second complaint was not determined and refiled as the current complaint after the Complainant became aware of deficiencies in its grounds and evidence and wished to join a second complainant. It is submitted that there are no good reasons why the current Complaint should not be determined with the Domain Name being held an Abusive Registration and transfer to the Lead Complainant.

## **6. Discussions and Findings**

### **Previous Complaints**

The Lead Complainant raised two previous complaints against the Respondent: DRS 14933 and DRS 20346.

In DRS 14933 (*Tom Hartley Jnr Ltd –v- Identity Protect Limited*) the expert provided a summary decision dated 1 December 2014 in which he stated in the “Comments (optional)” section:

*“The Complaint in this case is short (approximately 300 words). Although it has some supporting evidence, that is not referred to in the text of the Complaint, and in any event it appears to be related solely to showing that the Respondent has registered the Domain Name, and that the Complainant has asked the ISP involved to take action. The Complaint fails entirely to address the question of what Rights the Complainant has under paragraph 2.a.i of the Policy. There is no reference to a registered trade mark, and no attempt to explain the nature and extent of any unregistered rights, such as the degree of use of the name Tom Hartley Junior, or recognition by the Complainant’s customers. Although this case is undefended, the Complainant still needs to prove its case on the balance of probabilities, which it has not done in respect of its Rights. The problems which arise from an inadequate Complaint are made clear to the Complainant in the Chairman’s letter which this Complainant will have seen when lodging the Complaint. However, the Complainant apparently decided to proceed notwithstanding that. The Complainant very belatedly (after paying the fee for the case to be referred to an Expert) sought to add what its covering explanation describes as “additional*



*research/further investigations” to “strengthen” its case. The Expert has decided not to view that further material in view of its lateness, and the failure to explain why it could not have been made available earlier. In any event, its description suggest that it would not be material to the issue of the Complainant’s own Rights, which would hardly need investigation/research by the Complainant, and which should have been addressed in the original Complaint. The Complaint fails therefore because the Complainant has not established that it has Rights under the Policy.”*

DRS 20346 is not listed in the DRS decision database because it never reached a decision for a reason that is not disclosed to me in the Nominet papers. The Complainant says that it was withdrawn and re-submitted as this Complaint whilst the Respondent says it was “unsuccessful”.

In respect of repeat complaints the Policy states at §21.1:

*“If a complaint has reached the Decision stage on a previous occasion it may not be reconsidered (but it may be appealed, see paragraph 20) by an Expert. If the Expert finds that a complaint is a resubmission of an earlier complaint that had reached the Decision stage, he or she shall reject the complaint without examining it.”*

I have not considered DRS 20346 any further since it clearly does not fall within §21 of the Policy as it did not reach the Decision stage.

In respect DRS 14933, the Expert is required under §21.2 of the Policy to determine whether this Complaint *“is a resubmission of [that] earlier complaint, or contains a material difference that justifies a re-hearing”* and in doing so the Expert is required to answer the following questions:

*“21.2.1 Are the Complainant, the Respondent and the domain name in issue the same as in the earlier case?”*

The Lead Complainant, the Respondent and Domain Name in this Complaint are the same as DRS 14933. However, the Complainant has been added to this Complaint.

*“21.2.2 Does the substance of the complaint relate to acts that occurred prior to or subsequent to the close of submissions in the earlier case?”*

In respect of the Lead Complainant there is evidence presented of registered and unregistered rights in the name TOMHARTLEYJNR which in the main came into existence after the closure of submissions in DRS 14933 and which postdate the registration of the Domain Name. The assertion of Rights by the Complainant pre date the closure of submissions in DRS 14933 but the Complainant was not a party to DRS 14933. The inclusion of the Complainant here introduces substance to the Complaint that is unlikely to have been included in the submissions for DRS 14933.

*“21.2.3 If the substance of the complaint relates to acts that occurred prior to the close of submissions in the earlier case, are there any exceptional grounds for the rehearing or reconsideration, bearing in mind the need to protect the integrity and smooth operation of the DRS;”*

§21.3 of the Policy sets out a non-exhaustive list of examples which may be exceptional enough to justify a rehearing under §21.2.3 above. Of this non exhaustive list, the following are apposite:

*21.3.3 the discovery of credible and material evidence which could not have been reasonably foreseen or known for the Complainant to have included it in the evidence in support of the earlier complaint;*

*21.3.4 a breach of natural justice; and*

*21.3.5 the avoidance of an unconscionable result.”*

It is clear from the Expert’s optional comments in DRS 14933 that the Lead Complainant submitted an inadequate complaint and despite the issue of a Chairman’s letter proceeded with a complaint that was likely to fail from a lack of substance. The Expert rightly refused to accept a late submission of evidence that was already known prior to the original submission and consequently decided that no action be taken. There is now submitted credible and material evidence which was not known at the time of the submission of DRS 14933 (in respect of the Lead Complainant) but I am not able to determine on the papers before me whether there is also evidence included in this Complaint that was also submitted in DRS 14933 and/or that was known to the Lead Complainant prior to those submissions. The inclusion of the Complainant in this Complaint brings in new rights and assertions of Abusive Registration.

I also consider that it is pertinent to the submissions in DRS 14933 that the complainant in that case was not represented and may not have been in a position to present that complaint in the manner in which this Complaint is presented, despite the Chairman’s letter.

Whilst I am not able to set the substance of this Complaint fairly and squarely within §21.3.3, there is sufficient evidence and substance in this Complaint (taking into consideration the answer to §21.2.4 below) to persuade me that to reject it and refuse to examine it would potentially result in a breach of natural justice and/or an unconscionable result. In my view, the risk of the latter outweighs any misgivings in relation to whether the substance of this Complaint is sufficient to justify a potential reconsideration of DRS 14933.

*“21.2.4 If the substance of the complaint relates to acts that occurred subsequent to the close of submissions in the earlier decision, acts on which the re-filed complaint is based should not be, in substance, the same as the acts on which the previous complaint was based.”*

There is evidence of acts that occurred subsequent to the close of submissions in DRS 14933. However, it is not possible for me to determine on the papers before me whether there were submissions in DRS 14933 upon which this Complaint is now based.

In light of the foregoing, I will proceed to examine the submissions in this Complaint and to make my decision without further reference to DRS 14933.

## **General**

To succeed in this Complaint, the Complainant has to prove to the Expert on the balance of probabilities, pursuant to §2.1 and 2.2 of the Policy, both limbs of the test 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.*

## **Complainant's Rights**

Rights is defined in §1 of the Policy as “*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 wholly generic suffix “.co.uk” may be discounted for the purposes of establishing whether a complainant has Rights in a name or mark which is identical or similar to a domain name.

I have not considered the Complainants’ assertions relating to the tort of passing off; the Nominet DRS is meant to be a relatively straight forward procedure to determine whether the registration of a domain name is Abusive under the rules of the Policy and on the written submissions of the parties. It is not a forum for the examination of evidence of passing off nor does it provide for the cross-examination of such evidence that may be necessary to establish whether the tort has been committed.

I accept that, given the low threshold that is required to establish Rights, that there may be circumstances arising where the use of a name as a domain name would result in rights enforceable under the Copyright Designs and Patents Act 1988 or the Fraud Act 2006 and, therefore, this might be sufficient to establish Rights in the way considered by the appeal panel in DRS 12276. In this Complaint, however, such rights are presented on a theoretical basis without any evidence that such circumstances have arisen. I am not prepared to conclude on the papers before me that the Complainants’ have established such rights.

I am, however, satisfied on the papers before me that the Complainants have evidenced registered and unregistered rights and goodwill in the name TOM HARTLEY and the name TOMHARTLEYJNR. The rights evidenced by the Lead Complainant in the name TOMHARTLEYJNR postdate the registration of the Domain Name; the rights evidenced by the Complainant in the name TOM HARTLEY and the name TOMHARTLEYJNR predate the registration of the Domain Name. Furthermore, I accept the Complainant’s

assertion that the definition of Rights is wide enough to encompass rights in personal names and that TOMHARTLEYJNR is sufficiently distinctive to conclude that the Expert's decision in DRS 00693 (tahirmohsan.co.uk) applies here.

Accordingly, I find that the Complainants have Rights in the name TOM HARTLEY which is similar to, and the name TOMHARTLEYJNR which is identical to, the Domain Name.

### **Abusive Registration**

Abusive Registration is defined in §1 of the Policy as 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 has taken unfair advantage of or has been unfairly detrimental to the Complainant's Rights.*

A non-exhaustive list of factors which may be evidence that a domain name is an Abusive Registration is set out in §5.1 of the Policy of which the Complainant cites the following:

*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;*

*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;*

.....

*5.1.6 The Domain Name is an exact match (within the limitations of the character set permissible in domain names) for the name or mark in which the Complainant has Rights, the Complainant's mark has a reputation and the Respondent has no reasonable justification for having registered the Domain Name.*

The Complainant was a director in his father's (Tom Hartley senior) business (Tom Hartley Cars Limited) from 29 October 2009 until 31 October 2014, having worked in that business from the age of 11. The Complainant incorporated the Lead Complainant on 2 October 2008 but did not commence trading as Thomas Hartley Jnr until 30 May 2014. The Complainants evidence articles which demonstrate the press coverage around that time.

The Respondent registered the Domain Name on 1 June 2014, the day after it was announced in the press that the Complainant was leaving Tom Hartley Cars Limited and commencing trading as Tom Hartley Jnr Limited. The Complainants' say that this was a blocking registration and/or for the purposes of unfairly disrupting the Complainant's business. However, the reason for that registration remains unexplained and it is a step too far for me to conclude on the papers before me that this was the case. I note that the Respondent has not replied to this point save that, in discussing the classes in which the trade mark TOMHARTLEYJNR is registered, it says that the "*intended use for the Domain Name falls outside of any of these classes*". The Respondent has not explained the intended use of the Domain Name or the reason for registration.

The Complainants say that the Domain Name has, in the main, remained unused, implying that this indicates a blocking registration. The Policy is clear that a failure to use a domain name is not of itself Abusive.

The Complainant evidences offensive and potentially racist Tweets from <jonathan\_foxx> in September and October 2014 aimed at the Complainant, his brother and his father. In the Complaint, the Complainant says that the source of these Tweets, Jonathan Foxx, is behind Identity Protect Limited and presents evidence that in April 2017 the website to which the Domain Name resolved had redirected visitors to other sites such as Foxx Media. In fact, it transpired with the submission of the Response that Jonathan Foxx is the underlying registrant/ Respondent. I would have expected the Respondent, if he was not behind Foxx Media and/or not responsible for the offensive Tweets, to have denied one or both in the Response but he does not refer to either. On the papers before me, and the fact that the Respondent did not deny either in the Response, I accept that the Respondent is behind Foxx Media and was responsible for the offensive Tweets.

The Domain Name is distinctive and even to the casual observer suggests reference to an individual, in this case an individual who is well known in the used car industry and whose company, the Lead Complainant, is one of the largest independent used car dealerships trading under the same name, TOMHARTLEYJNR. Given the distinctive nature of the name TOMHARTLEYJNR I am satisfied that the Respondent is on the balance of probabilities likely to have known of the Complainant at the time of registration but nevertheless he chose to register that name without any adornment.

The Respondent is correct when he says that being the owner of a trade mark does not automatically entitle the owner to use that mark as a domain name. However, in a case such as this involving the unadorned use of a distinctive name in which the Complainant has Rights, it is incumbent upon the Respondent to explain why he registered the Domain Name and the proposed use.

I agree with the Complainants' assertion that the use of the Domain Name is inherently misleading in that its unadorned use would represent, certainly in the first instance, a connection to the Complainants. The Respondent has used the Domain Name for a period to redirect Internet users to an e-mail address for his business which, given the nature of the name TOMHARTLEYJNR, has the potential to unfairly disrupt the Complainants' business. The Complainants have not evidenced any such disturbance.

The Complainants' say that the Respondent's offer (in the Response) to sell the Domain Name is evidence of the purpose of its registration. The Policy is clear that an offer to sell a Domain Name is not of itself Abusive.

The Complainant quotes extensively from §3.3 of the Experts' Overview which includes:

*“Commonly, Internet users will visit web sites either by way of search engines or by guessing the relevant URL. If the domain name in dispute is identical to the name of the Complainant and that name cannot sensibly refer to anyone else, there is bound to be a severe risk that a search engine, which is being asked for the Complainant, will produce high up on its list the URL for the web site connected to the domain name in issue. Similarly, there is bound to be a severe risk that an Internet user guessing the URL for the Complainant's web site will use the domain name for that purpose.*

*In such cases, the speculative visitor to the registrant's web site will be visiting it in the hope and expectation that the web site is a web site “operated or authorised by, or otherwise connected with the Complainant.” This is what is known as ‘initial interest confusion’ and the overwhelming majority of Experts view it as a possible basis for a finding of Abusive Registration, the vice being that even if it is immediately apparent to the visitor to the web site that the site is not in any way connected with the Complainant, the visitor has been deceived. Having drawn the visitor to the site, the visitor may well be faced with an unauthorised tribute or criticism site (usually the latter) devoted to the Complainant; or a commercial web site, which may or may not advertise goods or services similar to those produced by the Complainant. Either way, the visitor will have been sucked in/deceived by the domain name. In the High Court decision Och-Ziff Management Europe Ltd v Och Capital LLP [2010] EWHC 2599 (Ch), the court quoted the International Trade Mark Association definition of initial interest confusion as being “a doctrine which has been developing in US trademarks cases since the 1970s, which allows for a finding of liability where a plaintiff can demonstrate that a consumer was confused by a defendant's conduct at the time of interest in a product or service, even if that initial confusion is corrected by the time of purchase”. In that case the court held that initial interest confusion is legally actionable under European trade mark legislation.*

.....

*Findings of Abusive Registration in this context are most likely to be made where the domain name in issue is identical to the name or mark of the Complainant and without any adornment (other than the generic domain suffix). See for example DRS 00658 (chivasbrothers.co.uk).*

.....

*The further away the domain name is from the Complainant's name or mark, the less likely a finding of Abusive Registration.*

*Subsequent to the Och-Ziff case (supra) the Court of Appeal in Interflora v Marks and Spencer [2014] EWCA Civ 1403 criticised the use of “initial interest confusion” as a concept relevant to English trade mark law. This case was*

*discussed by the Appeal Panel in DRS 15788 (starwars.co.uk) who concluded that initial interest confusion remained an applicable principle in determining whether or not a domain name registration was abusive.”*

The Domain Name is an unadorned use of the Complainant’s name TOMHARTLEYJNR. As the appeal panel in *World Wrestling Entertainment, Inc. -v- Daniel Raad* (DRS 16416) said, this will suffice to establish the confusion required by §5.1.2 of the Policy, even if “a visitor to the website linked to the Domain Name would realise once they got there that the site itself was nothing to do with the Complainant”.

That an unadorned use of the Complainant’s name is sufficient to establish confusion was also confirmed by the appeal panel in *Toshiba Corporation -v- Power Battery Inc* (DRS 07991) who said:

*“..... So far as the name itself is concerned, the majority Panel believes that the Domain Name in this case falls into a very different category from cases involving the “unadorned” use of a trade mark (e.g. <toshiba.co.uk>), where Internet users may be presumed to believe that the name belongs to or is authorised by the complainant.”*

The Respondent’s assertion that it will “respect and ensure that there will be no confusion or likeness between its domain and those of the Complainants” is not within its power to accomplish.

Accordingly, the use of the Complainants’ name TOMHARTLEYJNR unadorned in the Domain Name does amount to an Abusive Registration and there are no circumstances presented in the papers before me that would lead me to find otherwise.

## **7. Decision**

In light of the foregoing findings, namely that the Complainants have Rights in a name which is similar to the Domain Name and in a name which is identical to the Domain Name, and that the Domain Name, in the hands of the Respondent, is an Abusive Registration, I direct that the Domain Name be transferred to the Complainant (not the Lead Complainant) as requested in the Complaint.

**Signed** .....

**Steve Ormand**

**Dated: 13<sup>th</sup> August 2019**