

DISPUTE RESOLUTION SERVICE

D00020976

Decision of Independent Expert

Multiprint Driveways Ltd

and

Mr Simon Flint

1. The Parties:

Complainant: Multiprint Driveways Ltd
50a Clifford Way
Maidstone
Kent
ME16 8GD
United Kingdom

Respondent: Mr Simon Flint
21 Dunningwood Drive
Castleford
West Yorks
WF10 5EW
United Kingdom

2. The Domain Name:

multiprintdriveways.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.

08 January 2019 16:42 Dispute received
09 January 2019 14:05 Complaint validated
09 January 2019 14:14 Notification of complaint sent to parties
11 January 2019 11:43 Response received
11 January 2019 11:43 Notification of response sent to parties
15 January 2019 09:53 Reply received
15 January 2019 09:53 Notification of reply sent to parties
17 January 2019 12:14 Mediator appointed
18 January 2019 10:36 Mediation started
31 January 2019 13:54 Mediation failed
31 January 2019 13:54 Close of mediation documents sent
12 February 2019 01:30 Complainant full fee reminder sent
12 February 2019 16:04 Expert decision payment received
15 February 2019 14.36 Expert Request for Further Information and Evidence
27 February 2019 08.34 Further information provided by Complainant
27 February 2018 21.18 Further information provided by Respondent

4. Factual Background

Ron Hay has been trading as Multiprint Driveways and has referred to a facebook page showing use of the name in trade as far back as 2009. Multiprint Driveways Limited, the Complainant, was registered as a limited company on 14 August 2017. 'Ronnie Hay' is listed as its sole director.

The Complainant contacted the Respondent on July 9, 2018 to assert its rights in the name MULTIPRINT DRIVEWAYS on the Respondent's Facebook page. The Complainant has produced evidence that one Jamie Groves is associated with the Respondent and asserts that this individual used to work for the Complainant. The Respondent admits that Jamie Groves currently works for the Respondent and has not denied that Jamie Groves used to work for the Complainant.

The Complainant asserts that it owns the UK registered trade mark for MULTIPRINT DRIVEWAYS registered as of October 10, 2018 for construction related goods and services, although this registration is actually registered in the name of Ronnie Hay its sole director. The Complainant also asserts that it owns multiprintdriveways.com registered in 2011, although the Whois search does not name the registrant and the site is currently inactive.

The Respondent states that he is associated with a registered limited company Multiprint Driveways Yorkshire Limited incorporated on 10 September 2018 (after the Complainant's

Facebook message to the Respondent in July 2018) whose sole director is Hayley Matthews. Hayley Matthews' name appears at the bottom of the Response. The Domain Name was registered on September 1, 2018.

5. Parties' Contentions

Complainant's Contentions in the Complaint can be summarised as follows:

The Complainant has been trading as Multiprint Driveways for over 20 years and registered as a limited Company on 14 August 2017. It owns multiprintdriveways.com registered in 2011 and the UK registered trade mark for MULTIPRINT DRIVEWAYS registered as of October 10, 2018 for construction related goods and services.

An ex member of staff who moved away from the area has set up his own business using the Domain Name and on Facebook has set up Multiprint Driveways Yorkshire.

The Respondent's contentions in Response can be summarised as follows:

The Respondent owns a registered limited company Multiprint Driveways Yorkshire Limited (incorporated on 10 September 2018) and MultiprintDriveways.co.uk the Domain Name. The Respondent is on Facebook.

The company is based in Yorkshire and therefore has no impact on the Complainant or Ron Hay.

The managing director of the Respondent has never worked for the Complainant or Ron Hay and has not resided in or visited Kent.

The Complainant has not contacted the managing director of the Respondent.

The Respondent has the right to use the Domain Name which corresponds with its registered company name.

The Complainant's contentions in its Reply can be summarised as follows:

The Complainant's first contact with the Respondent informing the Respondent that the Complainant had traded for 20 years was in July 2018 before the Respondent registered its registered company name and the Domain Name.

The Respondent's name is confusing for the Complainant's customers and searching on the Internet brings up both companies. Bad work on behalf of the Respondent may cause the Complainant damage.

The Managing Director of the Respondent has no connection with the Complainant. However Jamie Groves who works for the Respondent used to work for the Complainant and the Respondent knew what they were doing adopting its trading name.

The Complainant can show proof of the conversations between the Complainant and the Respondent on Facebook on July 9, 2018.

The Complainant owns a registered trade mark in the UK for Multiprint Driveways and the Respondent is infringing the Complainant's trade mark trading in the UK.

The Complainant's additional contentions is its Reply to the Expert's request for Further Information and Evidence can be summarised as follows:

The Way Back Machine confirms the Complainant has been using the website www.multiprintdriveways.com from November 4, 2012.

The Complainant has in the past also used the name Multiprint Paving as a trading name for Multiprint Driveways, but it fully switched over to the Multiprint Driveways brand from April 22, 2017.

The Complainant has no formal evidence that Jamie Groves worked for Multiprint Driveways Limited as he was employed on a casual basis only.

The Complainant has the Facebook page www.facebook.com/Multiprintdriveways posting images and engaging with customers dating back to at least 2011. It also has the Google Places page for Multiprint Driveways with reviews from customers dating back to July 20, 2017.

The Respondent's additional contentions is its Reply to the Expert's request for Further Information and Evidence can be summarised as follows:

Jamie Groves has worked as a concrete driveway installer for the company since 2018.

The Respondent cannot understand how the Complainant has not registered the web address, but as soon as someone else registers it they have an issue. The Respondent has various other website addresses also linked to Multiprint Driveways Yorkshire.

The Respondent would be willing to let the Complainant have the Domain Name if they could agree some costs to cover altering all of the Respondent's advertising and branding.

6. Discussions and Findings

Paragraph 2 of Nominet's Dispute Resolution Policy requires that the Complainant must prove, on the balance of probabilities, that:

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

Identical or Similar

The Complainant is a registered company Multiprint Driveways Limited formed by Ron Hay its sole director on August 14, 2017. Mr Hay owns a registered trade mark for MULTIPRINT DRIVEWAYS for construction services registered October 10, 2018. Mr Hay has produced evidence from social media that he has been using the MULTIPRINT DRIVEWAYS name since at least 2009 with posts, in particular, from 2016 to date. Accordingly although the Complainant does not technically own the registered trade mark because it is in the name of its sole director the Expert is prepared to hold that the Complainant has common law rights and a reputation for using the name MULTIPRINT DRIVEWAYS for construction and paving services since its incorporation in August 2017. The acceptance of MULTIPRINT DRIVEWAYS for as a trade mark suggests that it is not understood to be a generic term for imprinted paving services in the context of construction services and there is no assertion of this by the Respondent.

The suffix .co.uk in the Domain Name does not serve to distinguish the Domain Name from the Complainant's MULTIPRINT DRIVEWAYS mark as .co.uk is a functional part of a domain name and not part of any trade mark involved in these proceedings.

Accordingly the Expert finds that the Domain Name is identical to a mark in which the Complainant has rights under the Policy.

Abusive Registration

This leaves the second limb. Is the Domain Name, in the hands of the Respondent, an Abusive Registration? Paragraph 1 of the Policy defines "Abusive Registration" 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. has been used in a manner, which took unfair advantage of or was unfairly detrimental to the Complainant's Rights."

A non-exhaustive list of factors, which may be evidence that the Domain Name is an Abusive Registration is set out in paragraph 5 of the Policy. There being no suggestion that the Respondent has offered to sell the Domain Name (other than an offer to hand it over for the costs of rebranding which appears to be a request for out of pocket expenses), given false contact details, has a pattern of registrations or registered the Domain Name for the Complainant or to block the Complainant, the only potentially relevant 'factors' in paragraph 5 are to be found in subparagraph 5.1.1 and 5.1.2 which read as follows:

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

5.1.1.1 [intentionally omitted]

5.1.1.2 [intentionally omitted]

5.1.1.3 for the purpose of unfairly disrupting the business of the Complainant;” and

“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”;

The Complainant alleges that the Domain Name is confusing, that the Respondent was aware of the Complainant’s rights at the time of registration and registered the Domain Name with the purpose of unfairly disrupting the business of the Complainant.

There is evidence that the Respondent was aware of the Complainant’s common law rights through use in the MULTIPRINT DRIVEWAYS name due to the Complainant’s post to complain about the Respondent’s use of that name on the Respondent’s facebook page in July 2018 before registration of the Domain Name on September 1, 2018. There is also some evidence that an ex employee of the Complainant now works for the Respondent and it seems highly unlikely that such a person would not mention the similar name to the Respondent.

Accordingly, since MULTIPRINT DRIVEWAYS is not a generic term the Respondent’s appropriation of this name in the Domain Name in full knowledge of the Complainant’s Rights for the purpose of offer competing services is confusing and likely to disrupt the Complainant’s business and the Respondent must have realised that this was likely to be so having already received a complaint from the Complainant prior to registration of the Domain Name.

Accordingly, the Panel finds that the Complainant has adduced sufficient evidence to show that on the balance of probabilities the Domain Name is an abusive registration.

7. Decision

The Expert determines that the Domain Name shall be transferred to the Complainant.

Signed

Dated