

# **DISPUTE RESOLUTION SERVICE**

**D00021880**

## **Decision of Independent Expert**

Hang Your Glass

and

Becky Wills

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

Lead Complainant: Hang Your Glass  
5355 Redwood Retreat Rd  
Gilroy  
CA  
95020  
United States

Respondent: Becky Wills  
Grays Green Farm Breach Hill Lane  
Chew Stoke  
BS40 8YD  
United Kingdom

### **2. The Domain Name(s):**

hangyourglass.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.

25 September 2019 01:44 Dispute received

25 September 2019 10:08 Complaint validated

25 September 2019 10:13 Notification of complaint sent to parties

14 October 2019 09:49 Response received

14 October 2019 09:49 Notification of response sent to parties

17 October 2019 02:30 Reply reminder sent

21 October 2019 14:12 Reply received

21 October 2019 14:13 Notification of reply sent to parties

21 October 2019 14:20 Mediator appointed

28 October 2019 15:17 Mediation started

31 October 2019 17:21 Mediation failed

31 October 2019 17:22 Close of mediation documents sent

01 November 2019 17:12 Expert decision payment received

#### **4. Factual Background**

4.1 The Complainant is a US company called Hang Your Glass Inc. It manufactures and supplies a range of products that allow its customers to mount works of art made of glass onto a variety of surfaces. It has been using the name or mark HANG YOUR GLASS, in the US at least, since 2004.

4.2 The President of the Complainant is a Poppy Mussallem.

4.3 Ms Mussallem is the registered proprietor of a US trade mark for the mark HANG YOUR GLASS. This was filed in May 2018 and granted in September 2019. The granted trade mark gives a date for “first use in commerce” as 2004.

4.4 The Respondent is an individual called Becky Wills. Ms Willis and her husband, Caryl Wills, run a company called Adjustabail Limited. Adjustabail Limited is an English company which manufactures and supplies a range of products that allow its customers to mount works of art made of glass onto a variety of surfaces.

4.5 The Respondent registered the Domain Name in December 2011 together with the domain names hangmyglass.co.uk and hangmyglass.com

4.6 The Respondent uses the Domain Name to redirect visitors to the main Adjustabail website which uses the url [www.adjustabail.co.uk](http://www.adjustabail.co.uk)

4.7 The Complainant’s US website can be found at the url [www.hangyourglass.com](http://www.hangyourglass.com) and its UK website can be found at [www.hangyourglassart.co.uk](http://www.hangyourglassart.co.uk).

4.8 The Complainant (both directly and through and its US trade mark lawyer) has contacted the Respondent and asked the Respondent to transfer the Domain Name to it. The Respondent has refused to do so.

## **5. Parties' Contentions**

### **Complainant's Submissions**

#### **Complaint**

In its Complaint the Complainant makes the following submissions:

5.1 The Complainant has Rights because of its US trade mark registration for HANG YOUR GLASS. This was registered as of May 2018 and relates to the following goods and services, "*Metal mounting system comprised of offsets, brackets, and screws for three dimensional art pieces.*" The registration shows a "First Use in Commerce" date as December 2004.

5.2 The Respondent runs a competing company and used the Domain Name and the domain name hangmyglass.com to point to the website of Adjustabail Limited. This was a malicious attempt to confuse customers of the Complainant and for the Respondent's company to use the Complainant's name and good reputation to increase their sales.

5.3 The Respondent was aware of the Complainant as they were both exhibitors at a small show in the USA called BECon in 2013. The Respondent's actions have led to confusion in the market place especially since the Complainant opened its own online store in the UK last year.

5.4 The Complainant has tried to resolve the issue by talking with the Respondent and she originally agreed to transfer the Domain Name but then refused.

5.5 The name Hang Your Glass is a household brand in the glass art industry and has been since 2004 and the Complainant would like to be operating under this name in the UK but cannot as the Respondent has registered the Domain Name.

5.6 The Complainant also references its use on social media including its Facebook, Instagram, Pinterest, and YouTube presence and screenshots from these social media sites are attached to the Complaint.

### **Respondent's Submissions**

#### **Response**

In its Response the Respondent makes the following submissions:

5.7 She has been producing and manufacturing her products for sale in the UK since 2011. The Domain Name (and the domain names adjustabail.co.uk, and hangmyglass.co.uk) were registered in 2011 and the phrases "Hang My Glass" and "Hang Your Glass" were chosen because they describe the function of the product. The

Respondent further submits that these are terms commonly used in the UK to describe the requirement glass artists have to mount their panel work on a wall.

5.8 She had the Domain Name registered for two and half years before becoming aware of the Complainant and its products which she did when they both exhibited at BeCON, in 2013.

5.9 There has never been any attempt to trade off the HANG YOUR GLASS name.

5.10 She offered to sell the Domain Names to the Complainant in 2018, providing the Complainant was able to demonstrate that they owned a trade mark for HANG YOUR GLASS. The Respondent further submits that the Complainant was unable to do this as at the time of the offer, the mark was not registered and in any event registration was not carried out until 2019. The Respondent therefore submits that at the point of registration of the Domain Name, the Complainant had no rights in the name or mark "HANG YOUR GLASS". As at 13 October 2019, the phrase "HANG YOUR GLASS" is not registered as a trade mark in the UK.

5.11 The respective products are not in competition as the Complainant's products are made of metal the Respondent's products are made of polycarbonate (so designed to be less visible). Further, the Respondent's products contain a unique feature that involves a single point contact and adjustability which makes her products superior, easy to use and cost effective. The Complainant's products have a reputation in the UK for being extremely expensive and suffer from failure. Therefore, the Respondent submits that they cannot see how her products cause harm or constitute an Abusive Registration.

5.12 The Respondent's ownership of the Domain Name (and hangmyglass.co.uk) has gone without being challenged for 8 years and that the Complainant has only challenged the Domain Name now to exploit their product in the UK. The Respondent therefore submits that this demonstrates that the phrase has commercial value and that as such the Complainant should be compensating the Respondent for the future benefit the Domain Name may bring to the Complainant in the UK.

## **Complainant's Submissions**

### **Reply**

In its Reply the Complainant makes the following submissions:

5.13 The Complainant has been using the name Hang Your Glass since 2004 and as such has a common law trade mark for that mark. Put another way the Respondent's rights start from when the use of the mark in commerce started i.e. in 2004.

5.14 The Complainant has been in business since 2004 and has sold hardware to glass artists worldwide. It has always shipped orders directly to the UK and between 2008 and 2012 it had a reseller in the UK called Warm Glass UK. The Complainant attaches an invoice showing some sales to Warm Glass UK to evidence this.

5.15 The Complaint attaches an extract from a website at the URL [www.yellowdogglass.co.uk](http://www.yellowdogglass.co.uk) which is run by a "Becky Wills" i.e. the Respondent. This

extract shows that the Respondent has taught classes at Warm Glass UK and was also trained in the US with a company called Bullseye at their factory in Portland, Oregon. Bullseye Glass are the company behind the BeCON show which both the Respondent and Complainant attended in 2013 and are also a US reseller of the Complainant's products.

5.16 The name Hang Your Glass is used on every package that the Complainant sells as well as on its on marketing brochures and in social media. Additionally, many of the Complainant's products are engraved with this name.

5.17 The fact that the Respondent has been involved with the Complainant's UK reseller and with another of the Complainant's resellers, Bullseye Glass means that the Respondent must have registered the Domain Name with knowledge of the Complainant.

5.18 The name Hang Your Glass is not used widely in the trade to describe these products and the Complainant produces examples of other companies who use the term, "Display Hardware" to describe these products so as not to confuse the customer. Other terms used by people in the trade are, "glass display", "display and findings", "mounting assembly and display" and, "wall mounts".

5.19 The Respondent had an opportunity to object to the US trade mark registration for Hang Your Glass and failed to do so.

5.20 It is clear that the Respondent has chosen to register and use the Domain Name knowing that Adjustabail would benefit from using this trade mark.

5.18 The Complainant reproduces a letter from a client which confuses the Complainant's business with the Respondent's business and wrongly directs someone to the Adjustabail's website rather than the Complainant's website. The Complainant also reproduces a letter from a reseller who has become confused between the two products and companies.

5.19 The Complainant has had to adopt the domain name hangmyglassart.co.uk for its UK site as the Domain Name which would have been its natural choice is not available.

5.20 The Respondent is using the Domain Name in bad faith to gain sales and confuse the Complainant's customer base. Specifically the Complainant submits that given the fact that the Respondent was an instructor at Warm Glass which was also the Complainant's UK reseller and was educated at Bullseye Glass (Bullseye Glass is a manufacturer of compatible coloured glass and was also a reseller of the Complainant's products), it is inconceivable that the Respondent was unaware of the products before she registered the Domain Name.

5.21 The Complainant further submits that the periods in which the Complainant was selling its product through Warm Glass (2008-2012) coincides with when the Respondent bought the Domain Name and the time when the Respondent was an instructor at Bullseye Glass.

## **6. Discussions and Findings**

6.1 Paragraph 2.1 of the Policy requires that the Complainant must prove, on the balance of probabilities, 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*

*2.2.2 The Domain Name, in the hands of the Respondent, is an Abusive Registration.*

### **Rights**

6.2 Therefore, as a first step, it is necessary to decide whether the Complainant has Rights in respect of a name or mark which is identical or similar to the Domain Name.

6.3 The term Rights is defined in the Policy as follows:

*Rights means rights enforceable by the Complainant, whether under English law or otherwise, that may include rights in descriptive terms which have acquired a secondary meaning.*

6.4 This has always been treated in decisions under Nominet's DRS as a test with a low threshold to overcome and I think that must be the correct approach.

6.5 The Complainant claims to have Rights in the name or mark HANG YOUR GLASS for two reasons. Firstly, the Complainant points to the registered US trademark for HANG YOUR GLASS and secondly the Claimant relies on use of the mark HANG YOUR GLASS in commerce going back to 2004.

6.6 The immediate problem with both of these submissions is that the Complaint is in the name of Hang Your Glass Inc i.e. a US corporation and the US trade mark registration for HANG YOUR GLASS is in the name of the Complainant's President Ms Mussallam. I think that if this was a Court or more formal proceeding that would be an end to the matter and the case could not proceed until either the rights were transferred to the company or Ms Mussallam was joined as a Co-Complainant. I am however, conscious that the DRS is a low cost, relatively informal process (although not without formality) which does not always look at things in the same stringent way as would be the case in court proceedings for example.

6.7 Given the nature of the DRS, it does seem to me that on the balance of probabilities, that it is the Complainant that has been trading since 2004 (and not Ms Mussallam) and for example the printouts of the Complainant's website that I have seen show the Complainant (and not Ms Mussallam) trading and that is consistent with other materials annexed to the Complainant. Additionally, it also seems to me self-evident that the Complainant has the benefit of a licence from Ms Mussallam in relation to its use of the registered trade mark (which it needs to trade) notwithstanding there is no mention in the papers that I have seen of any kind of written licence agreement. It is

also, very clear that the Complainant and Ms Mussallam are closely connected and I do not think it would serve any real purpose to reject this Complaint on the basis that Ms Musallam should be at least a Co-Complainant. That would simply lead to the Complaint being refiled with both the current Complainant and Ms Musallam as Co-Complainants and/or Ms Mussallam transferring her rights to the current Complainant.

6.8 The Respondent does raise two points which are relevant to the question of Rights albeit it that they are raised more in the context of Abusive Registration. The first of these is the fact that the trade mark registration for HANG YOUR GLASS is a US and not a UK trade mark and the second of these relates to the descriptive nature of HANG YOUR GLASS.

6.9 In relation to the US trade mark point I do not think that is a good point. The definition of Rights in the Policy does not depend upon the Complainant having rights which are enforceable under English Law and indeed that is a point which is echoed in the Expert's overview as follows:

***1.5 Can an overseas right constitute a relevant right within the definition of Rights?***

*Yes. The rights must be enforceable rights, but there is no geographical/jurisdictional restriction...*

6.10 In relation to the issue of descriptiveness I agree with the Respondent that there is definitely a descriptive quality to the name or mark HANG YOUR GLASS. That is however, a consideration which needs to be taken into account when it comes to looking at the question of Abusive Registration and my view is that as far as Rights are concerned the US registration and use since 2004 are enough to get the Complainant over the (fairly low) hurdle here.

6.11 The name or mark in which Complainant has Rights i.e. HANG YOUR GLASS therefore differs only from the Domain Name by the addition of the suffix .co.uk in the Domain Name. I therefore find on the balance of probabilities that the Complainant has Rights in a name or mark which is the same or similar to the Domain Name.

**Abusive Registration**

6.12 Abusive Registration is defined at Paragraph 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.*

6.13 This definition requires me to consider whether, at the time of registration/acquisition, or subsequently through the use that has been made of it, the Domain Names are an Abusive Registration.

6.14 Paragraph 5 of the Policy provides a non-exhaustive list of the factors which may constitute evidence that the Domain Name(s) is an Abusive Registration and Paragraph 8 of the Policy provides a non-exhaustive list of the factors which may constitute evidence that the Domain Name(s) is not an Abusive Registration.

6.15 The Policy requires the Complainant to prove, on the balance of probabilities, that the Domain Name(s) is an Abusive Registration. The burden of proof is therefore firmly on the Complainant.

6.16 In order to make a finding of Abusive Registration it is reasonably common ground amongst Nominet Experts that, in all but a minority of cases, there must be an element of knowledge on the part of the Respondent in the sense that the Respondent must, on some level, be aware of the Complainant's rights. In some cases where the name in which the Complainant Rights are particularly well known, it should be fairly obvious and straightforward, while in other cases where the name in which the Complainant has Rights is less well-known and/or where there are other meanings or uses which can be made of the name, this will require substantial evidence from the Complainant.

6.17 The approach that I intend to take in this case is to look at the overall question of whether the Respondent's registration or use of the Domain Names constitutes an Abusive Registration. Bound up with that, and indeed central to it, will necessarily be the question of the Respondent's knowledge of the Complainant's Rights.

6.18 In making this overall assessment the nature of the name or mark in which the Complainant has Rights is also clearly a factor here. The more descriptive or generic that name or mark is then the more likely it is that the Respondent simply happened upon the Domain Name as a "good domain name" without necessarily having any knowledge of the Complainant's Rights. Obviously the more well known and unique that name or mark is then the less likely it is that the Respondent did not register the Domain Name with the Complainant's Rights in mind.

6.19 The key, or at least the starting point, in determining this Complaint is therefore the Respondent's knowledge. The Respondent acknowledges that she knew about the Complainant from about 2013 when the Complainant and the Respondent exhibited at the same exhibition. The Respondent does however clearly state that this was the first time that she had become aware of the Respondent's products and was over two years after she registered the Domain Name.

6.20 The Complainant disputes this for a number of reasons which I will summarise below together with some comments:

- (i) *The name HANG YOUR GLASS has been used by the Complainant since 2004 and therefore would have been well-known to the Respondent by the time she registered the Domain Name in December 2011 – unfortunately, the Complainant's evidence could be better on this point. While the Complainant has provided examples of the Complainant's use of the mark HANG YOUR GLASS none of this is dated and it is very difficult indeed to get any feel from it about the size of the Complainant's business pre-December 2011 and therefore how well known it would have been . I accept*



of course that the mark has been used going back to 2004 in the US as evidenced by the “use in commerce” statement on the US trade mark. I must also take into account the fact that the Respondent was in the same or similar trade at about this time as well as the nature of the Domain Name and I will consider these points separately below;

- (ii) · *Relationship with Warm Glass UK* – the Complainant’s submission is that it used Warm Glass UK as a UK reseller between 2008 and 2012. To evidence that the Complainant has produced a single invoice with sales to Warm Glass UK totalling just over \$1,000. That is dated August 2011. No other sales or agreements have been produced. This is fairly thin but it does demonstrate some kind of link. The Complainant has also pointed me towards a website at [www.yellowdogglass.co.uk](http://www.yellowdogglass.co.uk) which is a website run by the Respondent. The website contains the following text:

*Becky Wills – Glass artist*

*I have been working with Kiln-formed glass for almost 20 years. Initially self-taught, I trained as a Bullseye educator at their factory in Portland, Oregon and then began teaching classing at Warm Glass UK in their wonderful studio in Wrington near Bristol.*

While this clearly links both the Respondent and the Complainant to Warm Glass UK the difficulty is one of timings. The Complainant’s submission is that it used Warm Glass UK as its UK reseller between 2008 and 2012 and there is some evidence to support that although as I have said I don’t get a feel for the volume of sales that were made of the Complainant’s products by Warm Glass. It is not at all clear when the Respondent was associated with Warm Glass UK and particularly whether that was before or after she registered the Domain Name in December 2011;

- (iii) · *Relationship with Bullseye Glass* – again, there is a common linkage with Bullseye glass. The Complainant used Bullseye Glass as a reseller of its products (although unfortunately the Complainant’s submissions do not say exactly when that would have been and particularly whether it would have been pre- or post-December 2011 or how many sales were made) and the extract from the [yellowdogglass.co.uk](http://yellowdogglass.co.uk) website shows that the Respondent was also connected with Bullseye Glass. Unfortunately, there are no timings given although one would assume from the context (and the fact that the Respondent trained at Bullseye Glass so presumably early in her career) that the Respondent’s association with Bullseye Glass was some time ago and very likely to be pre-December 2011.

6.21 Against all this I must also take into account the nature of the mark HANG YOUR GLASS. The Respondent says that this is simply the kind of mark which one would naturally adopt to describe a business which sells “fixings” for glass based products and I must say that I have some sympathy for that view. It is certainly the kind of mark that would not lead one to the immediate conclusion that the Respondent must have known about the Complainant. It is descriptive and although in one sense it

describes what the product does it is a slightly “clunky” formulation and is perhaps not the most obvious description.

6.22 Against that point the Complainant points to the fact that there are plenty of other companies who sell similar products none of whom use the description HANG YOUR GLASS. The Complainant also points to the fact that the Complainant’s business has been going since 2004 and during that time one might assume that the mark HANG YOUR GLASS has acquired a fair degree of distinctiveness when used by the Complainant (albeit that the Complainant’s submissions are notably thin on the details of the size and extent of the Complainant’s business).

6.23 As I say above the definition of Abusive Registration allows me to consider whether the Respondent’s conduct amounts to an Abusive Registration either at the time when the Domain Name was registered or subsequently. What this means in practice therefore is that if I am satisfied that when the Respondent registered the Domain Name she had no knowledge of the Complainant I would then go on to look at whether, after the Respondent acquired that knowledge (which by the Respondent’s own admission was some point in 2013) the Respondent’s behaviour changed such as to constitute an Abusive Registration.

6.24 In this case, I do not have any evidence to consider about whether or not the Respondent’s conduct changed in any way at any time nor am I told when the Respondent’s use of the Domain Name started. I think therefore that in the absence of these details (which would have been helpful in deciding this case) I must therefore assume that the Respondent has used the Domain Name in materially the same way since the date that it was registered i.e. to direct to a site which sells fixings and similar products for glass works of art.

6.25 Ultimately, I should say that I have found this a difficult case to decide. It does however seem to me that notwithstanding the paucity of detailed evidence that the Complainant has submitted that there are simply too many coincidences here. It is clear that the Respondent has been involved in the glass industry for nearly 20 years and also trained with Bullseye Glass which is or was a reseller of the Complainant’s products. There is also a connection between the Respondent and a UK reseller of the Complainant, Warm Glass UK albeit I am uncertain about the relevance of this given the lack of information on when the Respondent’s involvement with Warm Glass would have been.

6.26 I am also slightly confused by how the Respondent has used the Domain Name and why, if HANG YOUR GLASS, was such a good description for her business, she only used the Domain Name to redirect to the website of her company, Adjustabail. It might have been more obvious to use the name HANG YOUR GLASS on the site itself or even as the name of her business rather than simply in the Domain Name to re-direct traffic to the Adjustabail site.

6.27 Given all this, I think it very likely that on some level the Respondent would have known about the Complainant when she registered the Domain Names in December 2011. It may well be that this knowledge was only subconscious or subliminal but given the fact that the Respondent was in the same or closely connected industry with the Complainant at that time I think that is the most likely conclusion.

6.28 Having therefore found, on the balance of probabilities, that the Respondent had some knowledge of the Complainant's Rights when she registered the Domain Name I therefore find that the Domain Name is the in the hands of the Respondent an Abusive Registration.

6.29 I would add that it is clear from the papers that I have seen that as well as the Domain Name the Respondent has also registered at least one other UK domain name namely hangmyglass.co.uk and there are also references to hangmyglass.com although that may have been made in error. In any event neither of those domain names form part of this Complaint and I make no finding about them. If the Complainant wishes to obtain a transfer of those domain names then it will need to address them separately in the usual way.

## **7. Decision**

I find that the Complainant has Rights in a name or mark which is identical or similar to the Domain Name. Further, on the balance of probabilities, I find that the Complainant has established that the Domain Name in the hands of the Respondent is an Abusive Registration. I therefore direct that the Domain Name should be transferred to the Complainant.

**Signed** .....

**Dated** .....