

DISPUTE RESOLUTION SERVICE

D00022255

**Decision of Independent Expert
(Summary Decision)**

ESigns

and

Giant Imaging Ltd

1. The Parties:

Complainant: ESigns
14 Hanover Street
London
W1S 1YH
United Kingdom

Respondent: Giant Imaging Ltd
4 Low Road
Carleton Forehoe
Norwich
Norfolk
NR9 4AP
United Kingdom

2. The Domain Name:

esigns.co.uk (the "Domain Name").

3. Notification of Complaint

I hereby certify that I am satisfied that Nominet has sent the complaint to the Respondent in accordance with section 3 and 6 of the Policy.

Yes No

4. Rights

The Complainant has, to my reasonable satisfaction, shown rights in respect of a name or mark which is identical or similar to the Domain Name.

Yes No

5. Abusive Registration

The Complainant has, to my reasonable satisfaction, shown that the Domain Name is an Abusive Registration.

Yes No

6. Other Factors

I am satisfied that no other factors apply which would make a summary decision unconscionable in all the circumstances.

Yes No

7. Comments (optional)

On 25 October 2018, a decision in case number D00017688 was issued in respect of the Domain Name (the "Earlier Case"). The Expert in the Earlier Case granted the complainant's application for a summary decision and stated that in accordance with section 12 of the Policy the Domain Name would be cancelled. The respondent's registration of the Domain Name was duly cancelled on 12 November 2018 by Nominet, in accordance with section 19 of the Policy.

It is important, and relevant in the context of my decision in the case before me now, to note that if a complainant requests a remedy of cancellation of a domain name registration in its complaint brought under the Policy, and if its complaint is successful, then ordinarily the effect of this remedy is that the domain name will become available for re-registration by any entity, on a first come first served basis in accordance with general principles regarding availability and registration of .uk domain names. I make a further comment on this at the end of this section 7.

Ordinarily, pursuant to sub-section 21.1 of the Policy, if a complaint has reached the Decision stage on a previous occasion, it will not be re-considered otherwise than by way of an appeal under section 20 of the Policy. However, there may be exceptional circumstances justifying a re-hearing, guidance on which is to be found in sub-section 21.2 of the Policy, which reads as follows:

“21.2 In determining whether a complaint is a resubmission of an earlier complaint, or contains a material difference that justifies a re-hearing the Expert shall consider the following questions:

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

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?

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;

21.2.4 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.”

In order to determine whether or not I can proceed to consider the substantive issues raised in the case before me in order to decide the Complaint, I must first consider whether the Complaint is a resubmission of the complaint in the Earlier Case, or contains a material difference that justifies a re-hearing. I will therefore take each of the relevant questions set out in sub-section 21.2 of the Policy in turn and provide my answers underneath each, as follows:

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

Yes. While on the face of it, the details of each of the Complainant and the Respondent appear different to those in the Earlier Case, I find that the Complainant and the Respondent are the same as in the Earlier Case for the reasons given below.

The complainant in the Earlier Case is listed as ‘Lewis Critchley t/a E Signs’ with an address in Cambridgeshire, UK, whereas the Complainant in the current case is listed as ‘ESigns’ with an address in London, UK. The Complainant infers that it is the same complainant as in the Earlier Case. In addition, the name Lewis Critchley is mentioned as the founder of the Complainant’s business in the ‘About Us’ section of the Complainant’s website located at the domain name <e-signs.co.uk>. I therefore find that the Complainant in this case is the same as the complainant in the Earlier Case.

The respondent in the Earlier Case is listed as 'Matthew Howman' with an address in Norfolk. The Respondent in the current case is listed as 'Giant Imaging Ltd' with the same address as the respondent in the Earlier Case.

Having inspected the information publically available on the Companies House website, I note that the only active director of Giant Imaging Ltd at the date of this decision is Mr Matthew Howman who has the same correspondence address of the respondent in the Earlier Case. Matthew Howman is also one of the two people listed at Companies House as being a person with significant control of Giant Imaging Ltd. Further, the Complainant submits that at 12:06h on 13 November 2018, an application to register the Domain Name was submitted through the registrar, Namesco Ltd, by the same respondent as in the Earlier Case, namely Matthew Howman.

In light of these facts and submissions, I find that the current registrant of the Domain Name as at the date of this decision, and therefore the Respondent in this case, is the same as that in the Earlier Case.

Finally, the Domain Name is exactly the same as the domain name in the Earlier Case, namely <esigns.co.uk>.

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?

The substance of the complaint is that the Respondent re-registered the Domain Name almost immediately upon it becoming available again for registration, following the cancellation of the Domain Name given a finding under the Policy that it was an Abusive Registration in the hands of the Respondent.

Accordingly, I find that the substance of the complaint in this case relates to an act that occurred subsequent to the close of submissions in the Earlier Case.

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;

Not relevant here.

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.

The act on which the re-filed complaint is based is the re-registration of the Domain Name in the circumstances set out above. By definition, this cannot be, in substance, the same as any of the acts on which the previous complaint was based as at the time of the previous complaint, the Respondent held its previous registration of the Domain Name.

I am therefore prepared to find that as a result of the Respondent re-registering the same Domain Name almost immediately following a finding that the Domain Name, in the hands of the Respondent, was an Abusive Registration, there are exceptional grounds for the rehearing or reconsideration of this case, at all times bearing in mind the need to protect the integrity and smooth operation of the DRS.

Accordingly, I am required to make a decision on the Complaint on the basis of the submissions before me and the Policy, pursuant to paragraph 18 of the Policy. My decision is set out below.

Rights

The Complainant is a signage business based in the UK. It has been operating under the ESigns brand and website located at the domain name <e-signs.co.uk> for the last 18 years. The Complainant submits that it has considerable goodwill under its name 'ESigns' as a result of its business with a number of high profile clients including Harvey Nichols, the UK Government, the Intellectual Property Office and Disney.

In addition, the Complainant is the owner of a UK trade mark registration for the word mark 'ESIGNS'. This mark was registered on 9 September 2016 in classes 6 and 19.

I therefore find that the Complainant has Rights in respect of the name "ESigns", and that this name is identical to the Domain Name (excluding the generic .co.uk suffix).

Abusive Registration

The Complainant submits that the Respondent has knowingly registered a domain name which was previously found to be an Abusive Registration in the Respondent's hands.

The Complainant also submits (i) that the Domain Name was registered with the primary purpose of stopping the Complainant from using it and/or disrupting the Complainant's business by passing off its website under the Domain Name as that of the Complainant, (ii) that the Domain Name has been used to confuse internet users as it is almost identical to the Complainant's domain name <e-signs.co.uk>, and (iii) that the products and

services being offered by the Respondent on the website to which the Domain Name resolves are identical to those of the Complainant.

While I accept the Complainant's submissions in this regard, I am also of the opinion that re-registration of the same Domain Name by the Respondent, having had an adverse finding against him under the Policy in respect of the Domain Name, constitutes taking unfair advantage of the Complainant's Rights. The correct course of action, had the Respondent wished to have the opportunity to potentially avail itself of the fair registration of the Domain Name, would have been to appeal the decision in the Earlier Case in accordance with the appeal provisions of the Policy.

I therefore find, on the balance of probabilities, that (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.

As a final note, this case highlights a potential consequence of a complainant requesting the cancellation of a domain name in a complaint brought under the Policy. I appreciate that not all complainants will want the domain name that is the subject of the complaint to be transferred to it (for many reasons, including having to manage a further domain name as part of its portfolio which it has no use for), and in some cases it may not be appropriate for the domain name to be transferred to the complainant. A complainant should, however, ensure that it is fully informed as to the consequences of its requested remedy before drafting and filing its complaint.

8. Decision

I grant the Complainant's application for a summary decision. In accordance with section 12 of the Policy, the Domain Name will therefore be transferred to the Complainant.

Signed: Ravi Mohindra

Dated: 6 March 2020