

## **DISPUTE RESOLUTION SERVICE**

**D00022510**

### **Decision of Independent Expert**

Daniel Field Products Ltd

and

Daniel Field Direct Ltd

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

Lead Complainant: Daniel Field Products Ltd  
Daniel Field Products Ltd  
1 Brookmans Avenue, Brookmans Park  
Hatfield  
Hertfordshire  
AL9 7QH  
United Kingdom

Complainant: Mr Daniel Field  
London  
SE19DG  
United Kingdom

Respondent: Daniel Field Direct Limited  
Flat 9-9a  
Ermington Workshops  
Ermington  
Ivybridge  
PL21 9NT  
United Kingdom

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

danielfieldmailorder.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.

14 April 2020 16:15 Dispute received  
15 April 2020 11:37 Complaint validated  
15 April 2020 11:46 Notification of complaint sent to parties  
04 May 2020 02:30 Response reminder sent  
07 May 2020 08:08 Response received  
07 May 2020 08:09 Notification of response sent to parties  
13 May 2020 02:30 Reply reminder sent  
18 May 2020 09:47 Reply received  
18 May 2020 09:48 Notification of reply sent to parties  
18 May 2020 09:51 Mediator appointed  
19 May 2020 10:45 Mediation started  
22 May 2020 14:17 Mediation failed  
22 May 2020 14:18 Close of mediation documents sent  
29 May 2020 16:43 Expert decision payment received

### **4. Factual Background**

The Complainant was incorporated on 15 March 2012. It's sole director and shareholder is Daniel Field, who has built a reputation as a pioneer of organic skin and hair care products.

The template that I was provided with by Nominet for this decision, identified the Respondent as Martyn Bailey. He is a partner of the law firm Lee and Thompson and acts on behalf of Daniel Field Direct Ltd. According to Companies House records, that company was incorporated on 25 July 2002, originally under the name Daniel Field Retail Trade Limited and changed to its current name in 2003. Its directors are Suzanne England, Keith England and Nicholas England. Its shareholders are Keith England and Daniel Field who both own 50% of the shares respectively.

I had initially determined that while Mr Bailey is the named registrant of the Domain Name, the parties (and Mr Field) have engaged in this dispute on the basis that the true parties to it are Daniel Field Products Ltd and Daniel Field Direct Ltd (hereafter referred to as "the Respondent") and I made my decision on that basis. However, after submitting my decision to Nominet, and indeed after the decision was notified to the parties, I was informed by Nominet that the template I had been provided with was incorrect and that Daniel Field Direct Limited is the registrant of the Domain Name and the proper Respondent in this dispute.

The Complainant asserts that it is the proprietor of UK trade mark 1348249 for the mark "DANIEL FIELD" (the "Mark") for the following goods and services, which has effect from 17 June 1988:

Class 3 - Preparations for dressing or the care of the hair; shampoos, conditioners, creams, tonics, lotions; preparations for the care of the skin or of the scalp.

Class 44 - Hairdressing salon services

In fact, Mr Field is himself the recorded proprietor of that registration with the UKIPO, but as he is the sole director and shareholder of the Complainant, I am prepared to accept that he has authorised the Complainant's use of the Mark.

The Complainant uses the reputation, name, likeness and intellectual property of Mr Field to sell products. It is the holder of numerous domain names that incorporate the Mark and uses them and various social media accounts to promote its business.

Mr Field (on his own behalf and on behalf of the Complainant) and the Respondent entered into what is titled a "Product Licence" in November 2012 (the "Licence"), whereby it was agreed that they would seek to sell a powdered hair colour product, with Mr Field and the Complainant focusing on the trade market and the Respondent focusing on the consumer market. That agreement contains no express provisions relating to the Respondent's entitlement to use the Mark. The consideration for the licence was the payment of a royalty to Mr Field/the Complainant. The Licence is a rather simple and poorly drafted document.

By August 2019 the relationship had soured and the Respondent wrote to Mr Field on 9 August 2019 complaining that the licensed product needed to evolve for the business to be successful and without that they would need to look elsewhere for a replacement product which would bring an end to the royalties due under the Licence. The Complainant asserts that this letter terminated the Licence and with it the Respondent's right to use the Mark. The Respondent does not accept that the Licence or its right to use the Mark has been terminated and refers to a provision in the Licence which says that in the event of a dispute the Respondent has the right to engage an independent auditor. The Licence does not identify what the auditor should do once appointed.

On 27 November 2019 CJJ Law wrote on behalf of Mr Field to the Respondent asserting that their client was owed royalty monies and that if the Respondent did not contact Mr Field within 7 days, court proceedings would be instigated against the Respondent to recover unpaid royalties.

The Respondent refers to a second agreement entered into in 2012, being a "Supply Agreement" which requires 9 months' notice prior to termination or a 90 day notice and cure provision for material breach, but has not provided a copy of this and the Complainant asserts that no such Supply Agreement exists between the parties.

The Respondent continues to use the Domain Name to sell products under the Mark.

The Complainant asserts that the Respondent is diverting traffic away from the Domain Name via links, vouchers and discounts, to a website located at [aliceengland.com](http://aliceengland.com), operated by Family England Ltd (which has a common director with the Respondent). In response the Respondent asserts that the Complainant has consented to sales of products bearing the Mark by the Alice England site pursuant to an agreement made in or around July 2019.

On 30 March 2020, another firm of solicitors wrote a cease and desist letter on behalf of Mr Field to Family England Ltd, demanding that it cease use of the Mark failing which legal proceedings would be instigated seeking an injunction, damages and various other remedies.

On 14 May 2020 (approximately 1 month after the Complaint was filed), the same firm of solicitors wrote to Family England Ltd and the Respondent asserting that as a result of the Respondent's breaches of the Licence and its failure to respond to the 27 November 2019 correspondence referred to above, the Complainant had terminated the Licence as of 3 December 2019.

On 18 June 2020, I was provided with a copy of a letter sent by Lee & Thompson on behalf of the Respondent to Mr Field and the Complainant. The Policy provides at paragraph 16.1 that once an expert has been appointed, the Parties and the expert must not communicate directly

in relation to the dispute. On 23 June 2020, Nominet notified the parties that they should not communicate directly with the appointed Expert. I have therefore ignored the letter and in doing so am mindful that the Respondent has had the opportunity to file a Response, which they have done.

On 24 June 2020, via Nominet, I received a request from the Respondent for permission to file a further (non-standard) submission. I refused that request on the basis that I considered that both parties had been given a fair opportunity to state their respective cases via the standard process.

## **5. Parties' Contentions**

### **a. The Complaint**

The Complainant asserts that it has rights and it relies upon its trade mark registrations and the substantial goodwill it has developed as a result of its use of the Mark to establish that it has Rights.

It identifies the following factors in support of its contention that the Domain name is an Abusive Registration:

- As the Respondent has breached the Licence, they have ended any association with the Complainant and are not entitled to use the Mark or sell products under the Mark.
- The ongoing use of the Domain Name infringes the rights that the Complainant has in the Mark.
- The Respondent is seeking to use the Domain Name to siphon customers for the products to [aliceengland.co.uk](http://aliceengland.co.uk).
- Customers for Daniel Field products are confused by use of the Domain Name and are unable to find genuine Daniel Field products online.
- The Domain Name is taking unfair advantage of the Complainant and the Mark by creating a false connection between the Daniel Field brand and the Alice England brand.

### **b. The Response**

The Respondent does not dispute that the Complainant has Rights (although it does point out that the Mark is not registered for hair colour) or that the Domain name is similar or identical to a name in which the Complainant has rights, however it disputes that the Domain name is an Abusive Registration on the following grounds:

- It is fundamental to and implicit in the agreement(s) between the parties that the Respondent has the right to use the Mark.
- The Respondent is entitled to use the Domain Name under the Licence which remains effective and, contrary to the assertion by the Complainant, has not been terminated.
- To the extent that the Domain Name is causing any confusion, that has occurred because of the Complainant's conduct in communicating to third parties that the products advertised via the Domain Name are not authorised, or such confusion relates to a website at [danielfield.com](http://danielfield.com), which has until recently been operated by a third party, with whom the Complainant and the Respondent were in dispute.
- The Complainant has consented to sales of products bearing the Mark on the Alice England website.
- The issue relating to the Alice England website is in reality a dispute between shareholders and not relevant to the Nominet dispute process.
- The Nominet Complaint filed by the Complainant is being used as a tool to improve

- its negotiating position in the wider dispute.
- The Domain Name is and has always been used for legitimate purposes.

c. The Reply

The Complainant asserts the following:

- On 9 August 2019 the Respondent renounced their key contractual obligation (payment of royalties) and in response solicitors for the Complainant notified the Respondent on 27 November 2019 that a material breach had occurred and gave them 7 days to respond to a request to mediate.
- By 3 December 2019 the Complainant was entitled to treat any future obligations as discharged.
- On 30 March 2020 solicitors sent a cease and desist to all relevant parties including a director of the Respondent and no adequate response was received.
- The products sold via the website to which the Domain Name is pointed are all unlicensed.
- The Complainant terminated the Licence and this was clarified to the Respondent by the solicitors letter sent on 14 May 2020.
- The Licence has no relevance to this dispute, other than to provide context.
- It is not the case that use of the Mark is fundamental to and implicit in the Licence.
- The Complainant has never previously heard of Family England Ltd and has no commercial relationship with it.

## 6. Discussions and Findings

a. General

To succeed in this Complaint, the Complainant must, in accordance with Paragraph 2 of the Policy, prove to the Expert on the balance of probabilities that:

- (i) it has Rights (as defined in paragraph 1 of the Policy) in respect of a name or mark identical or similar to the Domain Name; and
- (ii) the Domain Name in the hands of the Respondent is an Abusive Registration (as defined in paragraph 1 of the Policy).

b. Complainant's Rights

The DRS Policy defines Rights as follows: "Rights means 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 Complainant relies upon its registered trade mark and the use of its DANIEL FIELD trade mark, which in my view are sufficient to meet the definition identified above. For the purpose of analysing whether the Domain Name is identical or similar to the name or mark in which Rights are claimed, one should ignore the .uk suffix. In my opinion, the Complainant has established that it has Rights in a mark identical to the disputed Domain Name.

c. Abusive Registration

I now go on to consider the extent to which the Domain Name is an Abusive Registration.

The Complainant asserts that the Domain Name is an Abusive Registration for the reasons identified above.

The Policy defines an 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. 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"*

The Policy sets out certain factors that may evidence that a Domain name is not an abusive registration, and included within those factors are that the Respondent has used the Domain Name in connection with a genuine offering of goods (para 8.1.1.1), or been commonly known by the name or legitimately connected with a mark which is identical or similar to the Domain Name (para 8.1.1.2).

Answers to the following questions are therefore fundamental to the determination of whether the Domain Name is an Abusive Registration:

- i. Did the Complainant and/or Daniel Field grant the Respondent the right to use the Daniel Field name/mark?
- ii. If the Complainant and/or Daniel Field did grant such a right, has the Complainant legitimately terminated that right such that as at the filing of the Complaint, the Respondent no longer had any entitlement to use the Daniel Field name/mark?

With regard to the first question, while the Licence lacks any express provision regarding the use of the Daniel Field name/mark, it is clear from the parties' conduct that they envisaged when they entered into it, that the products the Respondent was agreeing to sell would be sold under the Daniel Field name/mark. I therefore accept that it was an implied term of the Licence that the Respondent would be able to use the Daniel Field name/mark in connection with the sale of those products.

Further, the name of the Respondent is Daniel Field Direct Ltd. Mr Field is a 50% shareholder in the Respondent. The Respondent was incorporated in 2002, some 10 years prior to the Licence, and no objection to the use of that name (or the former company name), has been made by the Complainant or Mr Field, and no steps have been taken by Mr Field to prevent the Respondent using his name or the Mark in the name of the company. I therefore take him and the Respondent to have consented to use of his name and/or the Mark in the Respondent's business.

With regard to the second question, there are four letters which need to be considered. The first is a letter from the Respondent to Mr Field dated 9 August 2019, in which the Respondent complains that Mr Field has not fulfilled his obligations under the Licence and notifies him that future royalty payments will be withheld pending his compliance with the Licence. This letter does not give notice to terminate the Licence and I do not consider that it terminates the Licence.

The second letter, dated 27 November 2019, is from CJJ Law to the Respondent. It asserts Mr Field's rights under the Licence and rejects the Respondent's withholding of royalties. It gives the Respondent 7 days to meet with the Complainant, failing which court proceedings would be instigated. It does not seek to terminate the Licence, but rather relies upon its existence to claim the royalties that it says are due and owing. I do not consider this letter terminates the Licence.

The third letter, dated 30 March 2020, is a cease and desist letter sent by Fletcher Day on behalf of Mr Field to the directors of Family England Ltd objecting to that company's use of the Mark. As this letter is not addressed to the Respondent, I do not consider that it can properly terminate the Licence.

The fourth letter, dated 14 May 2020 (which post-dates the filing of the Complaint), is from Fletcher Day to the Respondent and Family England Ltd. It asserts that the Respondents was in material breach of the Licence and that it was terminated by Mr Field on 3 December 2019, that being 7 days after the letter from CJJ Law referred to above. As I have found above, the letter from CJJ Law does not terminate the Licence and nor does this letter.

I therefore find that the Licence has not been terminated. Even if I had found that it had been terminated, that would not terminate the Respondent's entitlement to use the Daniel Field name/Mark in the Respondent's company name and its business, which substantially pre-dates the Licence.

The Respondent has (i) been using the Domain Name in connection with a genuine offering of goods, and (ii) been commonly known by a name which is identical or similar to the Domain Name. I make no findings as to whether or not the Complainant or the Respondent have legitimate grievances under the Licence, but would observe that the Nominet Dispute Resolution Procedure is not the appropriate forum for those grievances to be resolved.

## **7. Decision**

In light of the above conclusions I therefore find that the Complainant does have Rights in respect of a name or mark which is identical to the Domain Name danielfieldmailorder.co.uk, but that it is not an Abusive Registration. The Complainant's request that the Domain Name be transferred is therefore refused.

**Signed**  
**Simon Chapman**

**Dated 2 July 2020**