

Nominet UK Dispute Resolution Service

DRS 00488

**HOYLAND FOX LIMITED v. ALEXANDER SEVEN
MARKETING COMPANY LIMITED**

Decision of Independent Expert

1. Parties:

Complainant: Hoyland Fox Limited
Address: Millhouse Green
Penistone
Sheffield
South Yorkshire
Postcode: S36 9NR
Country: GB

Respondent: Alexander Seven Marketing Company Limited
Address: Promotion House
East Bank Road
Sheffield
South Yorkshire
Postcode: S2 3PY
Country: GB

2. Domain Name:

hoylandfox.co.uk (“the Domain Name”)

3. Procedural Background:

The complaint was received by Nominet in full on 11 July, 2002. Nominet validated the complaint and informed the Respondent, by both letter and by e-mail on 16 July, 2002, noting that the Dispute Resolution Service had been invoked and that the Respondent had 15 days (until 6 August, 2002) to submit a Response. No Response or reply of any sort was received. Nominet informed the Complainant accordingly on 7 August, 2002, noting that Informal Mediation was not an option in this situation, and inviting the Complainant to pay the fee to obtain an Expert Decision pursuant to paragraph 6 of the Nominet UK Dispute Resolution Service Policy (“the Policy”). The fee was duly paid on 19 August, 2002.

On 20 August, 2002, Nominet invited the undersigned, Keith Gymer (“the Expert”), to provide a decision on this case and, following confirmation to Nominet that the Expert knew of no reason why he could not properly accept the invitation to act in this case and of no matters which ought to be drawn to the attention of the parties, which might appear to call into question his independence and/or impartiality, Nominet duly appointed the undersigned as Expert on the same day.

4. Outstanding Formal/Procedural Issues (if any):

None.

5. The Facts:

The Complainant, Hoyland Fox Ltd evidently took its present name in 1989 (it was formerly named William Hoyland & Co. Ltd.). It trades in umbrellas and umbrella frames and operates an established web site at www.hoylandfox.com (the domain name www.hoylandfox.com was registered in 1996). It has various registered trademarks in its name (under ADP number 0664653001), but there is no UK registration for the name Hoyland Fox itself.

The Respondent, Alexander Seven Marketing Company Limited, was incorporated in 1994. It is in the business of selling promotional goods. It operates a website at www.alex7.co.uk, which provides further links to other websites run by the Respondent, including www.umbrella-planet.com.

From the WHOIS records, the Domain Name www.hoylandfox.co.uk was registered for “Alexander 7 Marketing” on 25 October, 2001 with an administrative contact email address provided @alex7.co.uk and a postal address at “Promotion House, Rosedale Road, Sheffield, South Yorkshire, S11 8NW”. It is evident from the records that this was an earlier or alternative address used by the Respondent before the present address above.

6. The Parties’ Contentions:

Complainant:

The Complainant has asserted that:

1. The Complainant has Rights in respect of a name or mark which is identical or similar to the Domain Name (Policy Paragraph 2a(i)); and
2. The Domain Name, in the hands of the Respondent, is an Abusive Registration (Policy Paragraph 2a(ii)).

In support of its case, the Complainant says that the business now run under the Hoyland Fox name was first established in 1852 and the Complainant has, since then, become one of the largest and best known manufacturers of high quality and innovatively designed covered umbrellas and umbrella frames in the world. It has traded as ‘HOYLAND FOX’ since 1990 and continues to sell its umbrellas under that name. The name ‘HOYLAND FOX’ appears on all of the Company’s letterheads and in all of its marketing and other literature.

The Complainant sells its umbrellas and frames to customers in the UK, throughout Europe and to most countries around the world and, accordingly, claims that its reputation extends to all of these territories.

Hoyland Fox is said to employ some 250 people and to have an annual turnover in excess of £11m.

It was recently brought to the Complainant's attention that the hoylandfox.co.uk Domain Name directs visitors to the website of Creative Brollies, which is a trading name of Alexander Seven Marketing Company Limited. This website comprises images and information inviting visitors to contact Creative Brollies at the address of Alexander Seven Marketing Company Limited in regard to the purchase of umbrellas. This is likely to confuse people or businesses into believing that the Domain Name is registered to, operated or authorised by, or otherwise connected to the Complainant.

Respondent:

The Respondent made no Response to, and raised no challenge to, any of the facts and evidence submitted by the Complainant.

7. Discussion and Findings:

General

Paragraph 2 of the Policy requires that, for the Complainant to succeed, it must prove to the Expert, on the balance of probabilities, both that it has Rights in respect of a name or mark which is identical or similar to the Domain Name; and that the Domain Name, in the hands of the Respondent, is an Abusive Registration as defined in Paragraph 1 of the Policy.

Complainant's Rights

The Complainant in this case has asserted that it has rights in the name and mark HOYLAND FOX and that this name is identical or similar to the Domain Name.

Although the Complainant has a number of trade mark registrations, some dating back over 100 years, unfortunately it has no registration for HOYLAND FOX itself.

However, as the Complainant has stated, it is clear that it has used the HOYLAND FOX name at least since 1990 in general and since 1996 in relation to the internet. Its name clearly appears on its correspondence and on the website at www.hoylandfox.com. It is apparent that such use predates the registration of the Domain Name at issue by the Respondent.

The Respondent has not challenged any of the submissions made by the Complainant regarding the Complainant's rights and reputation in the name HOYLAND FOX. In the Expert's view, in these circumstances, these submissions are sufficient to establish a basic claim to common law rights in the name as a company name and as an unregistered trade mark.

Accordingly, for the purposes of the Policy, the Expert concludes that the Complainant does have Rights in this case in respect of a name or mark, which is similar to the Domain Name.

Abusive Registration

The Complainant also has to show that the Domain Name is 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 are set out in Paragraph 3a of the Policy. The most relevant factor in the present case is as set out in Paragraph 3a(i)C:

- C primarily for the purpose of unfairly disrupting the business of the Complainant.

Also potentially applicable is the example in Paragraph 3a(ii):

- ii Circumstances indicating that the Respondent is using the Domain Name in a way which has confused people or businesses into believing that the Domain Name is registered to, operated or authorised by, or otherwise connected with the Complainant.”

However, the factors listed in Paragraph 3 of the Policy are only exemplary and indicative. They are not definitive. It is Paragraph 1 of the Policy, which provides the applicable definition as indicated above.

The evidence shows that the Domain Name has been used for a webpage which was identical to that at www.creativebrollies.com, and which included the same telephone and address details for contact as the Respondent’s own website at www.alex7.co.uk. The domain name creativebrollies.com is registered to the Respondent.

On the evidence, which has in no way been countered or debated by the Respondent, the obvious inference is that the Respondent, as a competitor of the Complainant, has knowingly taken the Complainant’s name and used it in the Domain Name for the specific purpose of diverting potential customers of the Complainant away from the Complainant and towards the Respondent’s business. Subject to being able to meet the more stringent evidential requirements for Court action, the Complainant would appear potentially to have good grounds for asserting that the Respondent’s actions amount to a flagrant case of passing-off and that the Domain Name is being used as an “instrument of fraud”, as contemplated by the Court of Appeal in its judgment in the “One In A Million” case (*British Telecommunications plc & Others v. One In A Million Limited & Others*, [1999] FSR 1), in that the motivation and action of the Respondent has evidently been to misappropriate the Complainant’s property – their goodwill in the HOYLAND FOX name – and to use that name in the Domain Name hoylandfox.co.uk in a calculated misrepresentation with the deliberate intention of taking business away from the Complainant. It is difficult to imagine how even the most naïve businessman could believe that such course of action could be anything other than unfair, to say the least.

Consequently, the Expert has no difficulty in concluding that the Domain Name has manifestly been used by the Respondent in a manner which took unfair advantage of or was unfairly detrimental to the Complainant's Rights and that it is an Abusive Registration for the purposes of the Policy.

8. Decision:

Having concluded that the Complainant has Rights in respect of a name or mark which is similar to the Domain Name and that the Domain Name, in the hands of the Respondent, is an Abusive Registration, the Expert determines that the Domain Name, hoylandfox.co.uk, should be transferred to the Complainant.

Keith Gymer

August 23, 2002

Date