

NOMINET UK DISPUTE RESOLUTION SERVICE

DRS 00282

DECISION OF INDEPENDENT EXPERT

1. Parties

Complainant	:	Wolseley Centers Limited
Address	:	P O Box 21 Boroughbridge Road Ripon North Yorkshire
Postcode	:	HG4 1SL
Country	:	Great Britain
Respondent	:	Chromecoast Limited
Address	:	21 – 23 South View Billingham Cleveland
Postcode	:	TS23 1BT
Country	:	Great Britain

2. Domain Name

broughtoncrangrove.co.uk (“the Domain Name”)

3. Procedural Background

The Complaint was lodged with Nominet on 4th March 2002. Nominet validated the Complaint and notified the Respondent on 5th March 2002 and informed the Respondent by post and e-mail that it had 15 working days within which to respond to the Complaint (although the e-mail was returned on the same day marked “host unknown”). The Respondent failed to respond. Mediation was therefore not possible. Nominet so informed the Complainant and Respondent on 28th March 2002 by post and e-mail (the e-mail copy was again returned). On 16th April 2002 the Complainant paid Nominet the appropriate fee for a decision of an Expert pursuant to paragraph 6 of the Nominet UK Dispute Resolution Service Policy (“the Policy”).

On 18th April 2002 Robert Elliott, the undersigned (“the Expert”) confirmed to Nominet that he knew of no reason why he could not properly accept the invitation to act as expert in this case, and further confirmed that he knew 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.

4. Outstanding Formal/Procedural Issues

The Respondent has not submitted a Response to Nominet in time (or at all) in compliance with paragraph 5a of the Procedure for the conduct of proceedings under the Dispute Resolution Service (“the Procedure”).

Paragraph 15b of the Procedure provides, inter alia, that “If, in the absence of exceptional circumstances, a Party does not comply with any time period set down in the Policy or this Procedure, the Expert shall proceed to a Decision on the Complaint.”

Paragraph 15c of the Procedure provides that “If, in the absence of exceptional circumstances, a Party does not comply with any provision in the Policy or this Procedure, the Expert will draw such inferences from the Party’s non compliance as he or she considers appropriate”.

Although, as noted, Nominet’s e-mails to the Respondent have been returned, there is nothing in the papers before the Expert to suggest that the postal copies of the Complaint and other material addressed to the Respondent have gone astray or that the contact details are inaccurate. It therefore appears likely that the Complaint has been received by the Respondent. There is therefore no evidence before the Expert to indicate the presence of exceptional circumstances. The Expert will therefore proceed to a Decision on the Complaint notwithstanding the absence of a Response. The inferences which have been drawn from non-compliance are explained below.

5. The Facts

BROUGHTON CRANGROVE appears from the material submitted with the Complaint to be one of a number of trading names currently used by the Complainant. It would appear that the name arose from the merger of two businesses described as “Broughtons” and “Crangrove” in 1999.

The Complainant asserts that it has traded using the BROUGHTON CRANGROVE name since 1999, acquiring a significant amount of goodwill in doing so. The Complainant itself is said to be the United Kingdom’s leading building and plumbing merchant. It apparently uses the BROUGHTON CRANGROVE name for its plumbing and bathroom business, and its turnover for the plumbing and bathroom business for the year ended 31st July 2001 is said to be over £34,000,000.

The Complainant has produced some limited sales and marketing material to support its assertions about trading using the BROUGHTON CRANGROVE name, and the acquisition of goodwill.

The Respondent is said in the Complaint to be a competitor of the Complainant’s BROUGHTON CRANGROVE business. It would appear that, at least until December 2000, the Respondent was also a customer for

BROUGHTON CRANGROVE products. The Complaint asserts that the Respondent supplies plumbing and bathroom goods and bathroom furniture.

The Complaint also asserts that there was a dispute between the Complainant and the Respondent in December 2000 over the Respondent's failure to pay for certain Broughton Crangrove products supplied by the Complainant. There was apparently correspondence at the time (but none is annexed to the Complaint), leading to a resolution of the supply dispute. The Complaint asserts that by May 2001 the Complainant had become aware that the Respondent had registered the Domain Name. However, the WHOIS query result produced by Nominet indicates that the Domain Name was registered for the Respondent on 21st December 1999. The Complaint is silent on the question of the lapse of time between December 1999 and the Complainant's "awareness" that the Respondent had registered the Domain Name by May 2001. It is also silent on the details of the trading relationship between the Complainant and the Respondent at the time that the Domain Name was registered.

The Complaint records that in May 2001 the Respondent refused to transfer the Domain Name to the Complainant or take down the site accessed through that Domain Name. Again, the Complaint is silent on the details of the site at that time, referring instead to the Complainant's Representatives accessing the site in October 2001, from which it became clear that the Respondent had set up links to a site through which the Respondent's "Complete Bathrooms" products were advertised and sold. The Complainant says that the Complete Bathrooms product range competes with the range sold under the name BROUGHTON CRANGROVE. The Complainant has provided what is said to be a printout of the site "as it appeared prior to 8th November 2001", which refers to the offer of a "Complete Bathroom & Tile Service" from an address which appears to be similar (although not identical) to the Respondent's address given in its Details. However, the Expert notes that there is no express reference to the Respondent, nor is it clear from the document itself that the pages in question have been accessed through the Domain Name.

On 7th November 2001 the Complainant's Representatives wrote a formal letter to the Respondent outlining the Complainant's rights to the BROUGHTON CRANGROVE name, asserting passing-off, seeking undertakings, including the transfer of the Domain Name and damages, failing which proceedings would be commenced without further notification or delay.

The Complaint asserts that "on 8th November 2001 Mr Fretter [of the Respondent] contacted the Complainant's Representatives in response to the [letter of 7th November 2001]. He said that he did not believe that the Respondent was doing anything improper because it was not "impersonating" the Complainant, and the Complainant had no basis on which to object to the Respondent's registration of [the Domain Name] because it did not own a registered trade mark for BROUGHTON CRANGROVE, having only submitted a trade mark application. Mr Fretter acknowledged that the links to the Respondent's "Complete Bathrooms" site "should not be there", but

refused to transfer the name”. This assertion is unsupported by any contemporaneous note of that discussion.

The Complaint continues that “on or before 16th November 2001, the Complainant’s Representatives became aware that the links to the Respondent’s COMPLETE BATHROOMS products had been taken down from the site at www.broughtoncrangrove.co.uk”. In January 2002 the Domain Name was de-tagged, and there is apparently not currently an active site, although the Domain Name remains registered in the name of the Respondent.

6. The Parties Contentions

Complainant:

As regards the Complainant’s Rights, the Complainant asserts that:-

- It has been trading as BROUGHTON CRANGROVE since 1999 and has acquired a significant amount of goodwill in relation to that name;
- Its holding company (unidentified in the papers before the Expert) has submitted a trade mark application for BROUGHTON CRANGROVE in May 2001 in respect of a number of relevant classes, which is shortly to be advertised (following examination);
- It has an on-line presence through its holding company’s website at www.centers.co.uk on which the BROUGHTON CRANGROVE logo is prominently displayed;
- The Domain Name is identical to the Complainant’s trading name.

As regards Abusive Registration, the Complainant asserts that:-

- The Respondent was aware when it registered the Domain Name that BROUGHTON CRANGROVE is the Complainant’s trading name (as a result of the previous trading relationship);
- The name is not descriptive of the Complainant’s business: it is unusual and distinctive, and there can be no legitimate reason for it to have been registered by one of the Complainant’s competitors;
- Since registering the Domain Name the Respondent has traded in its own competing goods through that site;
- Accordingly, the Domain Name was registered by the Respondent in a manner which was intended to take unfair advantage of, or be detrimental to, the Complainant’s Rights, and since registration the Domain Name has been used in a like manner.

Addressing the non-exhaustive list of factors set out in the Policy which may be regarded as evidence that the Domain Name in the hands of the Respondent is an Abusive Registration the Complainant points particularly to the following:-

- The acquisition of the Domain Name was primarily for the purpose of unfairly disrupting the business of the Complainant (paragraph 3 (a) (i) (C) of the Policy). In support of this, the Complainant refers to the Respondent's trading in its own competing goods through a Domain Name consisting exclusively of the Complainant's trading name. The Complainant claims a person accessing the website when it was active would mistakenly have believed that it was owned and operated by the Complainant and selling the Complainant's goods. Alternatively, that person might buy the Respondent's products, rather than further searching for the Complainant's products. That person might also have concluded that the Complainant did not have an on-line presence;
- The Respondent has used the Domain Name in a way which has confused people or businesses into believing that the name is registered to, authorised by, or otherwise connected with the Complainant (paragraph 3 (a) (ii) of the Policy). Visitors to the site, whilst the Respondent was trading in its own products through that site, would believe that they were viewing and purchasing products sold by, or upon the authority of, the Complainant. No examples of actual confusion are produced, but the Complainant says this is unsurprising as confused visitors to the site could not typically be expected to notify the Complainant of their confusion;
- The Domain Name has been acquired as a blocking registration against a name or mark in which the Complainant has Rights (paragraph 3 (a) (i) (B) of the Policy). In support of this, the Complainant offers no evidence of the Respondent's motives at the time of registration of the Domain Name, but instead seeks to draw inferences from the Respondent's subsequent behaviour, in particular the removal of the Complete Bathrooms link, and current failure to use the Domain Name. The Complainant refers also to the continuing retention of the Domain Name by the Respondent, rather than transferring it to the Complainant.

The Complaint seeks transfer of the Domain Name to the Complainant.

Respondent:

The Respondent has not responded.

7. **Discussion and Findings**

General

The Complainant must prove its case to the Expert on the balance of probabilities (paragraph 2 (b) Policy). It must prove two elements: firstly that it has Rights in respect of a name or mark which is identical or similar to the Domain Name; secondly that the Domain Name, in the hands of the Respondent, is an Abusive Registration. Both “Rights” and “Abusive Registration” are defined in paragraph 1 of the Policy.

Complainant’s Rights

“Rights” as defined in the Policy “includes, but is not limited to, rights enforceable under English law”.

The Complaint fails to distinguish clearly between the Complainant and its (unidentified) holding company. The holding company is said to be the applicant for a number of registered trade marks. It is also said to “trade” through the website at www.centers.co.uk. However, elsewhere in the Complaint, the thrust of the Complainant’s case appears to be that trading under the BROUGHTON CRANGROVE name is done through the Complainant itself, implying that the goodwill generated in that trade attaches itself to the Complainant. The evidence in this respect is not ideal. It is, of course, uncontradicted by the Respondent, who has not responded. The Complainant has submitted nothing by way of evidence which directly links the Complainant with the BROUGHTON CRANGROVE business. The advertising and promotional material either bears the “BROUGHTON CRANGROVE” name or (in the case of the press clippings) is unspecific.

However, the Expert is conscious that the Complaint is supported by a statement that the information within it is to the best of the Representatives’ knowledge, true and complete, and that the blurring of identity between a holding company and a trading subsidiary is relatively common. In those circumstances, and in the absence of a response, the Expert is prepared to find that, on the balance of probabilities, the Complainant has shown that it has Rights for the purposes of satisfying the relevant requirements in paragraph 2 of the Policy.

Comparison of the Complainant’s Rights and the Domain Name

The first and second level suffixes (“.co” and “.uk”) are purely functional parts of the Domain Name, and are essentially irrelevant to a comparison of the name/mark and the Domain Name, which are otherwise identical.

Abusive Registration

The Policy (paragraph 3) contains a non-exhaustive list of factors which may be evidence of an Abusive Registration.

The definition of “Abusive Registration” itself (paragraph 1 of the Policy) is “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”.

Two of the Complainant’s submissions are essentially directed at the Respondent’s motives (or its “purpose”) at the time of registration or acquisition of the Domain Name. In terms of the non-exhaustive list of factors set out in paragraph 3 of the Policy, those submissions are specifically addressed to the question of whether the acquisition of the Domain Name was as a blocking registration, or primarily for the purpose of unfairly disrupting the business of the Complainant. Notwithstanding the absence of a Response, the Expert considers that the Complainant does not make a clear enough case in respect of either submission for the Expert to be able to conclude on a balance of probabilities that either of those was the primary purpose of the Respondent at the time that the Domain Name was acquired. The Expert has already referred to the unexplained period between December 1999 and May 2001, when it is said that the Complainant first became aware of the registration of the Domain Name by the Respondent. The Complaint contains very little information as to the relationship between the Complainant and the Respondent in December 1999, which was the time of registration. The Expert infers that, at that time, there was a trading relationship between the Complainant and the Respondent under which the Complainant sold its products to the Respondent. The Expert accepts that the name BROUGHTON CRANGROVE is unusual and distinctive, and that the Respondent appears to have been aware of it when it registered the Domain Name. However, under the Policy it is equally possible for the Respondent to show (as one of the non-exhaustive list of factors which may be evidence that the Domain Name is not an Abusive Registration) that he has used the Domain Name in connection with a genuine offering of goods or services. It would appear at the time that the Respondent was selling the Complainant’s goods in some way (but there is no indication from the Complaint of the quantity or type of goods involved, or any applicable contractual terms). In short, the Expert does not consider that he has before him sufficient evidence to conclude what the “primary purpose” of registration or acquisition was in December 1999 and in the circumstances, although noting the absence of a Response, the Expert does not consider that the Complainant has proved its case in respect of either registration as a blocking registration, or registration primarily for the purposes of unfairly disrupting the business of the Complainant.

The remaining submission of the Complainant relates to the use of the website. The Complainant says that the Domain Name has been used by the Respondent 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. The Complaint refers to a dispute over the supply of goods in December 2000, leading to the Complainant having been aware of the registration and use by the Respondent of the Domain Name by 4th May 2001 (no further details are given as to precisely when this awareness

arose, or what it involved). The Complainant did not then apparently do anything about the Domain Name until November 2001 (some 6 months later). It may be that the correspondence at the time throws some light on that delay, but none has been produced for the Expert. The Complaint then annexes what is said to be a print of the site in question. The document produced by the Complainant contains no clear reference to the Domain Name. It does not bear a date (and is submitted as evidence of how the site “appeared prior to 8th November 2001”). The page in question contains no reference to the Complainant or its products. The Complainant refers to it being used for the purposes of the Respondent’s sale of competing products, although it is unclear to the Expert whether, having resolved its other differences with the Respondent in May 2001, the Respondent was in fact still selling the Complainant’s products at that time.

The Complainant’s case is that the Respondent telephoned the Complainant’s Representatives the day after the Complainant sent a letter, through its solicitors. The relevant parts of the Complaint are set out above (but are, as the Expert has already noted, unsupported by evidence). Although there appears to have been an acknowledgment by the Respondent that the links to the “Complete Bathrooms” site should not have been there, there was at the same time a refusal to transfer the Domain Name because the Respondent believed it was not doing anything improper because it was not ““impersonating” the Complainant”. The link was quickly taken down, and the Domain Name subsequently de-tagged. The Expert does not consider that the Complainant’s argument in this respect that the Respondent “has, in effect, acknowledged that its actions in respect of the name have been contrary to honest commercial practices” is made out – the limited information available about the conversation on 8th November 2001 would suggest the Respondent was trying to justify its position, at least to a substantial extent.

No direct evidence of confusion has been produced. The Complainant says that this is unsurprising: “confused visitors to the site could not typically be expected to notify the Complainant of their confusion”. However, the Expert notes that the factors set out as part of the non-exhaustive list dealing with confusion refer to “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”. There is nothing to suggest that such confusion is likely to arise from the site itself and the Expert does not agree with the bald assertion that the absence of any examples of actual confusion is “unsurprising”. The Expert would have expected there to be some relevant evidence (such as complaints over faulty goods) if there had been any substantial confusion. In essence it seems to the Expert that the Complainant’s case boils down to a submission that the fact that its name was being used as part of a Domain Name to sell competing products (perhaps alongside its own) was likely to have led to confusion in the period during which it was operated with that link (a period which the Complainant appears to be unable to prove beyond a period of at most a few days).

The Complaint is, therefore, less than convincing on this point. However, as the Complainant points out, it would appear that the Respondent has never tried to establish that it has any Rights to the name. It has had opportunities to do so, both in response to the Complaint, and in response to the letter of 7th November 2001 from the Complainant's Representatives. It would have been a comparatively easy matter for the Respondent to have asserted that it was (say) an authorised dealer in the Complainant's products. Aside from selling the Complainant's own products as a genuine offering, it is difficult to conceive what other legitimate reason the Respondent could have had for registering and for subsequently using the Domain Name in the way in which the Respondent appears to have done in November 2001 (and again the Expert notes that the Respondent could have contested the evidence in this respect, if the material put forward by the Complainant in this respect was inaccurate).

On the balance of probabilities, the Expert finds that the Domain Name was being used by the Respondent in November 2001 to link to a site which had little or no connection with the Complainant, and that that link itself was sufficient to give rise to the likelihood of people or businesses being confused into believing that the Domain Name was registered to, operated or authorised by, or otherwise connected with the Complainant. In the circumstances, and in the absence of any positive case put forward by the Respondent, the Expert finds that the Domain Name is an Abusive Registration.

8. **Decision**

The Expert finds that the Complainant has Rights in the name BROUGHTON CRANGROVE, that the name in which the Complainant has rights is identical to the Domain Name, and that the Domain Name is an Abusive Registration in the hands of the Respondent.

The Complainant seeks transfer of the Domain Name to the Complainant. This seems to the Expert to be the appropriate remedy in the light of the foregoing findings and the Expert therefore directs that the Domain Name broughtoncrangrove.co.uk be transferred to the Complainant.

Robert G. Elliott

7th May 2002