

DISPUTE RESOLUTION SERVICE

D00012273

Decision of Independent Expert

HSB Engineering Insurance Limited

and

Mr Damon Ashworth

1. The Parties:

Complainant: HSB Engineering Insurance Limited
New London House
6 London Street
London
Greater London
EC3R 7LP
United Kingdom

Respondent: Mr Damon Ashworth
483 Foxdenton Lane
Oldham
Lancashire
OL9 9QS
United Kingdom

2. The Domain Name:

hsbeil.co.uk (“the Domain Name”)

3. Procedural History:

11 December 2012 10:03 Dispute received
12 December 2012 09:42 Complaint validated
12 December 2012 09:47 Notification of complaint sent to parties

03 January 2013 01:30 Response reminder sent
07 January 2013 08:41 Response received
07 January 2013 08:42 Notification of response sent to parties
10 January 2013 01:30 Reply reminder sent
10 January 2013 12:44 Reply received
10 January 2013 12:44 Notification of reply sent to parties
10 January 2013 12:45 Mediator appointed
15 January 2013 11:46 Mediation started
30 January 2013 11:57 Mediation failed
30 January 2013 11:59 Close of mediation documents sent
04 February 2013 12:05 Expert decision payment received

4. Factual Background

The Complainant was incorporated in the UK in 1989 and is a specialist engineering insurance and inspection service provider. It changed its company name to its present name in 1995.

The Complainant operates across UK, Ireland and the rest of Europe, with 10 offices in the UK and Ireland. The Complainant's turnover is approximately £45million per annum. Its main website is located at www.hsbeil.com.

Since 21 November 2006 the Respondent was employed as a file clerk by HSB Engineering Insurance Services Limited ("HSBEISL"), a wholly-owned subsidiary of the Complainant. In December 2011, the Respondent was notified that his job was at risk of redundancy as the office was moving to a paperless office environment. The redundancy consultation process began in around January 2012.

The Respondent registered the Domain Name on 8 April 2012.

The Respondent was made redundant on 21 May 2012.

In September 2012, there was a website at the Domain Name with a notice stating: "*Damon Ashworth is constructing this website to host his 2 hour documentary on the failings of a financial services company. Check back soon!*". Adjacent to this notice were a number of words and phrases including: "*illegal enhanced disclosure checks*", "*discrimination*" "*non-existent regulations*" and "*H&S failings*".

At some point in November 2012 the following words had been added at the top of the home page: "*HSB Engineering Insurance Services Ltd Time is running out!*", together with a ticking clock.

In December 2012, the website was updated with photographs of health and safety guidelines, a letter on House of Commons letterhead and photographs taken inside the Complainant's offices, as well as the following text:

"IT IS NOW MORE THAN 5 YEARS SINCE I FIRST BROUGHT TO YOUR ATTENTION THE HARMFUL EFFECTS OF YOUR DISCRIMINATORY POLICIES I HAVE WAITED LONG ENOUGH FOR SOME MEASURE OF COMPENSATION

AND WITH YOUR IMMINENT MOVE TO MANCHESTER YOU CLEARLY THINK YOU WILL AVOID TAKING ANY RESPONSIBILITY FOR YOUR FAILINGS; THINK AGAIN!"

and

"DAMON ASHWORTH IS CONSTRUCTING THIS WEBSITE TO HOST HIS 2 HOUR DOCUMENTARY ABOUT THE DISCRIMINATORY PRACTICES HE WAS SUBJECTED TO WHILST AN EMPLOYEE OF HSBEIL INCLUDING ILLEGAL DATA ACCESS VIOLATIONS AND INADEQUATE PROVISION FOR MANUAL EMPLOYEES H&S THAT LEAD DIRECTLY TO PHYSICAL HARM AND PERMANENT PHYSICAL INJURY. Check back soon!"

5. Parties' Contentions

Complaint

The Complainant contends as follows:

The Complainant has unregistered rights in the name "HSBEIL" which arise from its long use of the name and the fact that this is the abbreviation by which the Complainant is often referred to by its employees and customers and those in the insurance industry.

Since changing its name to HSB Engineering Insurance Limited in 1995, the Complainant has used, and has been commonly known, by the abbreviations "HSBEIL" or "HSB EIL".

The "HSBEIL" name is used by the Complainant and is recognised by the insurance industry as indicating the goods and services of the Complainant.

The fact that there have been cases of actual confusion between the Domain Name and the Complainant's domain name is further evidence that the Complainant has unregistered rights in the name "HSBEIL".

Since being notified of the possible redundancy, the Respondent became a disgruntled individual and began a concerted series of actions designed to cause damage to the business and reputation of the Complainant and HSBEISL. The Respondent registered the Domain Name during the redundancy consultation process and subsequently located a website at this address for the sole purpose of posting defamatory and threatening material in relation to the Complainant.

The Respondent has registered the Domain Name primarily as a blocking registration. The Complainant owns various other domain names incorporating "hsbeil" and is now blocked from adding the Domain Name to its portfolio.

The Respondent has registered the Domain Name primarily for the purpose of unfairly disrupting the business of the Complainant. The content of the website linked to the Domain Name is defamatory and this shows that the Respondent's intent in

registering the Domain Name was malicious. As a result, the Complainant has suffered damage to its reputation amongst its employees, its customers and the insurance industry generally. This could lead to a loss of customers and a resulting financial loss.

Although the later version of the website named HSBEISL rather than the Complainant, any damage caused to HSBEISL is equally damage to the Complainant. This is because (i) HSBEISL is wholly-owned by the Complainant; (ii) the business of HSBEISL and the Complainant are very closely related (as evidenced by the shared office premises, staff etc.) and (iii) the names HSBEIL and HSBEISL are very similar.

The Respondent is using and threatening to use the Domain Name in a way which has confused and is likely to confuse people or businesses into believing that the Domain Name is registered to, operated or authorised by, or otherwise connected with the Complainant.

There is initial interest confusion: The Domain Name is identical to the abbreviated name of the Complainant and to the domain name of the Complainant. Internet users guessing the URL for the Complainant's website have used the Domain Name for that purpose and there is a severe risk that other internet users will make the same guess. In this case, there is actual evidence of initial interest confusion. To create initial interest confusion for the purpose of attacking the Complainant is to take unfair advantage of the Complainant's rights.

The Domain Name has caused actual confusion among employees, brokers and customers who have guessed the URL of the Complainant and typed in the Domain Name believing it to be that of the Complainant.

On the website linked to the Domain Name, the Respondent is threatening to upload a defamatory video about the Complainant/HSBEISL.

The Domain Name was registered as a result of a relationship between the Complainant and the Respondent. The Respondent registered the Domain Name due to his former relationship with the Complainant/HSBEISL. However, the Respondent has no legitimate reason to register a domain name containing "HSBEIL" and is only using the Domain Name as a vehicle to continue his campaign against the Complainant, post-employment, with the aim of causing harm to the Complainant's reputation and business.

Apart from the damage which will occur to the Complainant's goodwill and unregistered rights in "HSBEIL" if the Respondent's actions continue, the Complainant is concerned that such activity is likely to damage the Complainant's sales.

The Respondent's use of the Domain Name does not constitute fair use pursuant to 4(b) of the DRS Policy as there is no indication in the Domain Name what the visitor is likely to find at the site. The Domain Name is likely to be believed to be a domain name of or authorised by the Complainant. The Domain Name is identical to the name in which the Complainant has rights. In DRS 6283 (rayden-engineering.co.uk) the

Panel found that it was only in exceptional circumstances that such use could be fair. No such exceptional circumstances exist in this case. The Respondent has clearly used the HSBEIL mark in order to cause confusion among the public and to cause harm to the Complainant.

Response

The Respondent contends as follows:

The Respondent has composed the Response without actually reading the Complaint, as he is tired of the corporate gesturing from a company that breaks the law.

The Complainant filed a complaint within 24 hours of his informing Munich Re, the Complainant's parent company, of the Respondent's intended use for the website at the Domain Name yet it took the Complainant 14 months to respond to irrefutable proof which the Respondent provided about the Complainant's illegal policies.

The Complainant has been around since 1866 and has had ample time to buy the Domain Name. Several years earlier, whilst employed by the Complainant, the Respondent suggested buying the Domain Name when the company was looking for a way to inform staff about closures due to weather conditions but the Complainant decided instead to use a dedicated telephone line.

There is no attempt to mimic the Complainant's website.

The content of the website is not abusive. The website is purely for the purpose of factual communications. Everything on the website is backed up by evidence in much the same way as online newspapers operate.

The Complainant should have refrained from breaking the law, it should not have allowed multiple members of staff to lie about rules and regulation and it should not have ignored communications from senior politicians. The Complainant should have acted on the health and safety issues identified by the Respondent and honoured its grievance procedures. It should have removed from involvement in multiple redundancy consultations those persons whom the Respondent identified as having conflicts of interest.

The Complainant continues to seek every legal angle to silence the Respondent by using indirect strong arm tactics against those whose services he may use. Yet the Complainant cannot challenge him on grounds of defamation because his accusations are factual and can be backed up with evidence.

It is over six years since the Complainant first illegally accessed the Respondent's personal data and since the Respondent first complained about the potential harmful effects of discriminative work practices to which he was subjected as a manual worker. The Complainant has still not admitted liability for any of these occurrences and so the Respondent will continue to name the company and the individuals involved until the Complainant takes responsibility and the Respondent receives compensation or a court of law rules directly against him.

The Respondent has been unemployed for over seven months, during which time he has received no income whatsoever and has had to borrow his mother's life savings to live on. If the Respondent signs on as unemployed, he will be forced to work in manual employment. This will inevitably cause his medical condition to deteriorate but the Complainant will declare that it is not responsible.

The Respondent wants compensation or justice in some other form. If the Complainant wants to buy the Domain Name, the cost is £250,000 which is the amount of compensation which the Respondent considers that the Complainant owes him.

If the Domain Name is taken away from him, the Respondent will inform the police that he intends to organize a demonstration outside the Complainant's new offices in Manchester on its opening day.

(The Response includes a link to a pdf file with information which the Respondent says will provide a better grounding as to the issues surrounding this complaint. The Respondent says that this document is available for the Expert only, but that the Expert is free to discuss all the contents with the Complainant or their representative. In fact, the Complainant has viewed and commented upon the document in its Reply and so I have treated it as it were an exhibit to the Response; I would not have considered the document without the Complainant having had an opportunity to read and comment on it.)

Reply

The Complainant contends as follows:

The majority of the Response is not relevant to the questions which arise under the DRS Policy.

The fact that the Complainant has not previously registered the Domain Name does not indicate that the Respondent is now free to do so or that the Complainant has in any way forfeited its rights in "HSBEIL" or that these rights have lapsed.

The majority of the Response, including the documents in the download link, is concerned with the Respondent's allegations that the Complainant has breached the law in various ways and various other grievances in relation to the Complainant. The Respondent seems to suggest that his use of the website at the Domain Name is for the purposes of airing those allegations/grievances. Even if the Respondent's allegations/grievances were true, which the Complainant maintains they are not, this would not prevent the Domain Name from constituting an abusive registration.

The fact that the Respondent is now offering to sell or transfer the Domain Name to the Complainant for valuable consideration in excess of the Respondent's out-of-pocket costs directly associated with acquiring or using the Domain Name is further evidence that the Domain Name is an abusive registration pursuant to paragraph 3(a)(i)(A) of the DRS Policy.

The Respondent's statement that, if the Domain Name is "taken away from" him, he will inform the police of his intention to organise a demonstration outside the Complainant's new Manchester office on the day that it opens, is further evidence that the Respondent registered the Domain Name primarily for the purpose of unfairly disrupting the business of the Complainant.

The Response also clearly demonstrates that the Domain Name was registered as a result of a relationship between the Complainant and the Respondent and the Respondent does not provide any legitimate reason to register a domain name containing "HSBEIL".

6. Discussions and Findings

General

To succeed, the Complainant has to prove in accordance with paragraph 2 of the DRS Policy on the balance of probabilities, first, that it has rights (as defined in paragraph 1 of the DRS Policy) in respect of a name or mark identical or similar to the Domain Name and, second, that the Domain Name, in the hands of the Respondent, is an abusive registration (as defined in paragraph 1 of the DRS Policy).

Complainant's rights

The meaning of "rights" is clarified and defined in the Policy in the following terms:

"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 says that it has made long-standing use of the name "HSBEIL", which is an acronym of its company name: HSB Engineering Insurance Limited. The Complainant has produced evidence of its own use of this acronym, as well as use by others including the trade press and suppliers. The Complainant's main website has been located at www.hsbeil.com for many years.

I also note that, in the Response, the Respondent consistently refers to the Complainant as "HSBEIL".

I am satisfied from the above that the Complainant has become known and recognised by the acronym "HSBEIL". It is worth adding that the establishment of "rights" under the DRS has consistently been held to be a low threshold test.

I conclude therefore that the Complainant has established rights in a name or mark which is identical to the Domain Name (disregarding the domain name suffix).

Abusive registration

Is the Domain Name an abusive registration in the hands of the Respondent?

Paragraph 1 of the DRS 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.”

Initial Interest Confusion

Paragraph 3a(ii) of the Policy identifies the following as one of the non-exhaustive factors which may be evidence that a domain name is an abusive registration:

“ii. [c]ircumstances indicating that the Respondent is using or threatening to use the Domain Name in a way which has confused or is likely to confuse people or businesses into believing that the Domain Name is registered to, operated or authorised by, or otherwise connected with the Complainant”

Has there been such confusing use of the Domain Name?

One form of confusion, known as “initial interest confusion”, is explained in paragraph 3.3 of the DRS Experts’ Overview as follows:

“Commonly, Internet users will visit web sites either by way of search engines or by guessing the relevant URL. If the domain name in dispute is identical to the name of the Complainant and that name cannot sensibly refer to anyone else, there is bound to be a severe risk that a search engine, which is being asked for the Complainant, will produce high up on its list the URL for the web site connected to the domain name in issue. Similarly, there is bound to be a severe risk that an Internet user guessing the URL for the Complainant’s web site will use the domain name for that purpose.

In such cases, the speculative visitor to the registrant’s web site will be visiting it in the hope and expectation that the web site is a web site “operated or authorised by, or otherwise connected with the Complainant.” This is what is known as ‘initial interest confusion’ and the overwhelming majority of Experts view it as a possible basis for a finding of Abusive Registration, the vice being that even if it is immediately apparent to the visitor to the web site that the site is not in any way connected with the Complainant, the visitor has been deceived. Having drawn the visitor to the site, the visitor may well be faced with an unauthorised tribute or criticism site (usually the latter) devoted to the Complainant; or a commercial web site, which may or may not advertise goods or services similar to those produced by the Complainant. Either way, the visitor will have been sucked in/deceived by the domain name.

Findings of Abusive Registration in this context are most likely to be made where the domain name in issue is identical to the name or mark of the Complainant and without any adornment (other than the generic domain suffix). See for example DRS 00658 (chivasbrothers.co.uk).”

In my view there is a high likelihood of initial interest confusion arising in this case. The Domain Name is identical to the name of the Complainant, without any adornment other than the generic domain suffix. The Complainant has produced evidence that its employees, as well as a third party broker, have stumbled on the

Respondent's site when looking for the Complainant's site. There is every reason to think that other internet users are doing likewise. Such users will have been sucked in / deceived by the Domain Name, as explained in the Experts' Overview.

Criticism site

The gist of the Response is that the Domain Name was registered, and has been used, for the purpose of making criticisms of the Complainant which are not defamatory as they are true and backed up by evidence. These assertions involve, amongst other things, grievances as to the way in which the Respondent's redundancy was handled and allegations that the Complainant broke the law in various respects.

Is it fair for the Respondent to register and use the Domain Name in this way notwithstanding the initial interest confusion mentioned above?

Paragraph 4(b) of the Policy states that:

“Fair use may include sites operated solely in tribute to or in criticism of a person or business.”

The fairness or otherwise of using a domain name for a criticism site is addressed in the DRS Experts' Overview:

“4.8 Do tribute and criticism sites necessarily constitute fair use unless proved otherwise? [Paragraph 4(b) of the Policy]

No. Paragraph 4(b) of the Policy provides that “Fair use may include sites operated solely in tribute to or in criticism of a person or business” ... Note also that the use of the word "may" means that even if a site is operated solely as a tribute or criticism site it is still open to the Expert to find that it is abusive. In assessing the fairness or otherwise of the use, the Expert needs to have regard to both the nature of the domain name in dispute and its use. Some decisions in the past have concentrated solely upon whether the site fairly pays tribute to or criticises the Complainant (often a very difficult thing for an expert to assess in a proceeding of this kind).

The appeal decision in DRS 06284 (rayden-engineering.co.uk) confirmed the consensus view among experts today that the nature of the domain name is crucial to the exercise. A criticism site linked to a domain name such as <IhateComplainant.co.uk> has a much better chance of being regarded as fair use of the domain name than one connected to <Complainant.co.uk>. The former flags up clearly what the visitor is likely to find at the site, whereas the latter is likely to be believed to be a domain name of or authorised by the Complainant.

In DRS 06284 the domain name was identical to the name in which the Complainant had rights. A modified name that made it clear that this was a protest site would presumably have been less successful in drawing the protest to the attention of customers of the Complainant.

The Panel concluded there was a balance to be drawn between the right to protest (which could be effected via a modified name) and the Complainant's

rights in its own name, and that in this case at least the latter outweighed the former. Note that the Panel did not rule that use of an identical name would always and automatically be unfair, but did conclude that it was only in exceptional circumstances that such use could be fair. The Panel declined to find that such exceptional circumstances existed in the case in question.”

Here, the Domain Name is the exact name of the Complainant with no modifier. As I have indicated above, in my view users are likely to arrive at the website expecting to find the Complainant’s own site. Instead, they will encounter a site that is highly critical of the Complainant.

In my view this is unfair, for the reasons explained in the Experts’ Overview. And, just to be clear, this is not because I have reached any conclusion that the claims on the website are unjustified or defamatory. The Respondent has produced a lot of information relating to his complaints, which in turn are strongly disputed by the Complainant. As the Overview indicates, DRS Experts are not generally well-placed to assess the fairness of such criticisms.

In short, the unfairness here does not flow from the fact or nature of the criticism levelled by the Respondent but, rather, from the nature of the domain name used to criticize the Complainant, namely one consisting of the Complainant’s exact name.

Complainant’s failure to acquire the Domain Name for itself

In his Response, the Respondent also says that the Complainant, having been around for many years, had ample opportunity to by the Domain Name for itself. The Respondent adds that he even suggested this some years previously, whilst an employee of the Complainant’s group.

However, the fact that for whatever reason the Complainant did not itself register the Domain Name cannot, of itself, justify the Respondent doing so in the circumstances of this case.

Abusive registration - conclusion

For the reasons stated above I find that the Domain Name is an abusive registration in that it has been registered and/or used in a manner which took unfair advantage of or was unfairly detrimental to the Complainant’s rights.

7. Decision

I find that the Complainant has rights in a mark which is identical to the Domain Name and that the Domain Name is, in the hands of the Respondent, an abusive registration. I therefore direct that the Domain Name be transferred to the Complainant.

Signed: Adam Taylor

Dated: 26 February 2013