

DISPUTE RESOLUTION SERVICE

D00013760

Decision of Independent Expert

Meller Braggins Limited

and

Steve Woods

1. The Parties:

Complainant: Meller Braggins Limited
37 Princess Street
Knutsford
Cheshire
WA16 6BP
United Kingdom

Respondent: Mr Steve Woods
Avtech House
Birdhall Lane
Stockport
Cheshire
SK3 0XX
United Kingdom

2. The Domain Name(s):

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

3. Procedural History:

The Complaint was submitted to Nominet on 4 February 2014. On the same date, Nominet validated the Complaint and notified it to the Respondent. The Respondent was informed in the notification that he had 15 working days, that is, until 25 February 2014 to file a response to the Complaint.

On 25 February 2014 the Respondent filed a Response. On 4 March 2014 the Complainant filed a Reply to the Response. On the same date, the case proceeded to the mediation stage. On 11 April 2014, Nominet notified the parties that mediation had been unsuccessful and invited the Complainant to pay the fee for referral of the matter for an expert decision pursuant to paragraph 8 of Nominet's Dispute Resolution Service Procedure Version 3 ("the Procedure") and paragraph 7 of the corresponding Dispute Resolution Service Policy Version 3 ("the Policy"). On 16 April 2014, the Complainant paid the fee for an expert decision. On 25 April 2014, Andrew D S Lothian, the undersigned, ("the Expert") confirmed to Nominet that he was not aware of any reason why he could not act as an independent expert in this case. Nominet duly appointed the Expert with effect from 25 April 2014.

4. Factual Background

The Complainant is an estate agency business based in the North West of England, which, through various predecessor entities, can trace its history back to 1836. The present incarnation of the Complainant's business is a limited company which was incorporated in 2007. The Complainant's predecessor firm began trading as "Meller Braggins & Co" in 1976 and the Complainant's business has continuously used the mark MELLER BRAGGINS since that date.

In 1998, the Complainant instructed its then marketing company to register the Domain Name on its behalf. Screenshots produced from the Internet Archive "Wayback Machine" by the Complainant demonstrate that the Domain Name was used to publish the Complainant's corporate website from 1999. The Complainant registered the domain name <mellerbraggins.com> in 2000 and thereafter used this domain name for its corporate website. The configuration of the Domain Name was changed after the registration of <mellerbraggins.com> so as to redirect traffic to the latter domain name.

In about 2000, the Complainant instructed associated companies named Complete Computer Services Limited and Commsite Limited to provide hosting and related IT services in respect of the Domain Name. The Complainant has been in dispute with the said companies since about August 2013 regarding termination of and payment for services.

The Complainant believed that the Domain Name was originally registered in its own name. However, the Complainant discovered in August 2013 that at a date unknown to the Complainant, the Domain Name was transferred into the name of the Respondent. The Complainant states (and the Respondent does not deny) that the Respondent is a former employee of Complete Computer Services Limited. The registrar of the Domain Name is Commsite Limited.

5. Parties' Contentions

Complainant

The Complainant asserts that it is the proprietor of rights subsisting in the mark MELLER BRAGGINS and that it has acquired substantial goodwill and reputation in that mark over a course of trade dating back to 1836. The Complainant submits that it is the legal and beneficial owner of the Domain Name and has paid all relative registration and renewal fees.

The Complainant states that it was not informed that the Domain Name was being transferred into the Respondent's name, nor did it consent to such transfer. The Complainant notes that in a meeting on 2 September 2013, Mr Forrester, the sole director of both Complete Computer Services Limited and Commsite Limited, informed the Complainant that the Domain Name had been transferred into the control of those companies in order to facilitate the provision of hosting services. The Complainant adds that on 19 August, 5 September, 6 September and 9 October, all 2013, it asked Mr Forrester and/or the said companies to transfer the Domain Name back to the Complainant but such requests were ignored. The Complainant notes that it considers that the transfer of the Domain Name into the Respondent's name was unlawful, that the failure to return the Domain Name is having a significant adverse effect on the business of the Complainant and is causing it to suffer reputational harm and financial loss. The Complainant states that the Domain Name, in the hands of the Respondent, comprises an ongoing abusive registration which is unfairly detrimental to the Complainant.

The Complainant details the terms of its contractual dispute with Complete Computer Services Limited and Commsite Limited and asserts that it has paid all outstanding invoices and has validly terminated its contractual arrangements with the said companies. The Complainant adds that it considers that the said companies are wilfully evading and refusing to process the Complainant's requests for the transfer of the Domain Name and <mellerbraggins.com>. The Complainant notes that the latter domain name is the subject of a separate complaint under the corresponding domain name dispute policy. The Complainant details the terms of correspondence between it and the said companies and notes that in a letter to the Complainant's solicitors dated 16 December 2013, Mr Forrester demanded various payments allegedly due to the said companies, including an amount of £400 which is

said to be required to allow him to authorise the transfer of the Domain Name and <mellerbraggins.com>. The Complainant concludes from the terms of this letter that Mr Forrester has the authority to transfer both domain names but is refusing to do so.

The Complainant states that the Domain Name was registered as a result of a relationship between the Complainant and Complete Computer Services Limited/Commsite Limited in connection with which the Complainant has been using the Domain Name exclusively and has paid for registration and renewal thereof, all in accordance with paragraph 3(a)(v) of the Policy. The Complainant adds that the Respondent is deliberately causing disruption to the Complainant's business and that this is an abusive registration conform to paragraph 3(a)(c) [sic] of the Policy.

Respondent

The Response has not been provided by the named Respondent, but by Ms Julie Forrester, the Company Secretary of Complete Computer Systems Limited.

Ms Forrester does not deny that the Complainant has rights in the name MELLER BRAGGINS, however she states that the Complainant is using the Policy to avoid paying for IT services and has refused the offer of a transfer of the Domain Name on the proviso that it settle such debts. Ms Forrester details the terms of the IT service agreement which she says is in place between the Complainant and Complete Computer Services Limited/Commsite Limited and argues that this was a continuous arrangement, renewed annually subject to a thirty day notice period. Ms Forrester contends that the contract has not been validly terminated as notice has not been given. Ms Forrester notes the terms of invoices which she says remain unpaid by the Complainant.

Ms Forrester summarises the Respondent's position as being that the Complainant has decided that they no longer wish to use the services of Computer Services Limited/Commsite Limited, that the Complainant has not provided the said companies with the necessary notice of cancellation, that the Complainant disputes the outstanding invoices and that the Respondent therefore reserves the right not to carry out further work by transferring the Domain Name to the Complainant.

Complainant's Reply to Response

In reply to the Response, the Complainant denies that it has submitted the Complaint to avoid payment of outstanding debts and contends that the Respondent is in bad faith by purporting to exercise a lien over the Domain Name. The Complainant notes that the Respondent is holding the Complainant to ransom in circumstances where the Respondent has no

legitimate rights to the Domain Name and where there are alternative routes through which alleged outstanding debts could be pursued. The Complainant notes that the only work which is required is the transfer of the Domain Name and that although it does not accept that it is liable for any additional fees therefor, the Complainant has offered to pay the £400 proposed by Mr Forrester for this work.

The Complainant addresses the terms of the Response regarding the three allegedly unpaid invoices and takes issue with these on the grounds that the first invoice is a duplicate charge, the second relates to fees for services not rendered due to termination of the contract and the third invoice has already been paid. The Complainant notes that Ms Forrester included certain documentation with the Response which is said to constitute the contracts between the Complainant and Computer Services Limited/Commsite Limited and disputes whether the Complainant ever saw or approved this documentation. The Complainant states that it has "serious concerns" with the said documentation.

The Complainant summarises its position in stating that, without prejudice to its primary position on the contractual arrangements between the Parties, the contractual documentation produced by Ms Forrester does not provide a contractual right for the Respondent to exercise a lien over the Domain Name and that the refusal to transfer the Domain Name constitutes an act of bad faith which has an ongoing serious and adverse effect on the business of the Complainant.

6. Discussions and Findings

In terms of paragraph 2(b) of the Policy the onus is on the Complainant to prove to the Expert on the balance of probabilities each of the two elements set out in paragraph 2(a) of the Policy, namely 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.

Complainant's Rights

Paragraph 1 of the Policy provides that 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 requirement to demonstrate Rights under the Policy is not a particularly high threshold test. Rights may be established in a name or mark by way of a trade mark registered in an appropriate territory, or by a demonstration of unregistered so-called 'common law rights'.

The Complainant's case is that it and its predecessors have been using the name MELLER BRAGGINS as a trading name since at least 1976, such that this name constitutes an unregistered trade mark in which it has rights. The Complainant notes that it advertises its services in local press and trade publications and has produced corresponding evidence showing that its MELLER BRAGGINS name has featured in such advertising and on social media. The Respondent does not take issue with any of the Complainant's submissions on its rights in the MELLER BRAGGINS trading name.

The Expert is satisfied on the basis of these submissions and the accompanying evidence that the Complainant has used the name and mark MELLER BRAGGINS for a not insignificant period and to a not insignificant degree, such that the name is recognised by the public as denoting the services of the Complainant (see paragraph 2.2 of the Experts' Overview Version 2). In these circumstances, the Expert finds that the Complainant has rights in such name and mark. Comparing this to the Domain Name, the Expert first disregards the top and second levels of the Domain Name, namely .uk and .co respectively, on the grounds that these are required for technical reasons only and are wholly generic. This leaves a comparison between the mark MELLER BRAGGINS and the third level of the Domain Name, "mellerbraggins". Domain names are not case sensitive, and white space is not permitted, also for technical reasons. Accordingly, these differences are of no significance.

In all of these circumstances, the Expert finds that the Complainant has proved on the balance of probabilities that it has Rights in a name which is identical to the Domain Name.

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 has taken unfair advantage of or has been unfairly detrimental to the Complainant's Rights;*

This general definition is supplemented by paragraph 3 of the Policy which provides a non-exhaustive list of factors which may be evidence that the Domain Name is an Abusive Registration. Paragraph 4 of the Policy provides a similar non-exhaustive list of factors which may be evidence that the Domain Name is not an Abusive Registration.

In the present case, the Complainant asserts that the Domain Name is an Abusive Registration on the basis of the general definition, namely that the Domain Name has been used in a manner which is unfairly detrimental to the Complainant's Rights. The Complainant also makes specific cases under paragraphs 3(a)(v) of the Policy regarding the relationship between the Parties and paragraph 3(a)(i)(C) of the Policy regarding unfair disruption caused to the Complainant's business.

With regard to the last of these points, paragraph 3(a)(i)(C) of the Policy contemplates that a respondent has registered or acquired a domain name primarily for the purpose of unfair disruption. While the effect and consequence of the Respondent's actions in the present case may be to cause disruption to the Complainant's business, there is no evidence before the Expert to demonstrate on the balance of probabilities that this was the Respondent's primary purpose in acquiring the Domain Name. Accordingly, the Expert does not consider that the Domain Name is an Abusive Registration in terms of paragraph 3(a)(i)(C) of the Policy.

Turning to paragraph 3(a)(v) of the Policy, this indicates that where the Domain Name was registered as a result of a relationship between the Complainant and the Respondent, and the Complainant has been using and has paid for the Domain Name registration and any renewals exclusively, this may be evidence that the Domain Name is an Abusive Registration.

The general thrust of paragraph 3(a)(v) is to provide a remedy in the not uncommon situation where a rights holder finds that the domain name which they have paid for and used exclusively has been registered in the name of a connected party, typically a web developer, service provider or employee. There are many reasons why this circumstance may come about, covering everything from the registrant's administrative convenience (for example, in holding the domain in a registrar account which is tied to a single registrant name), to less honourable motivations on the part of the registrant such as a desire to retain control over the domain name, against the wishes of the rights holder, in future dealings.

It seems to the Expert that the Domain Name in the present case is held by the Respondent as a result of a very similar set of circumstances to that contemplated by paragraph 3(a)(v). There are some slight differences between the exact scenario described in that paragraph and the present circumstances, notably the fact that in this case the Domain Name has been registered not by the Respondent but rather by the Complainant's former marketing agency - an unrelated third party - at some point in the past, and

that the Respondent is, strictly speaking, a former employee of an entity which has had a subsequent relationship with the Complainant. However, the Expert reminds himself that the list of factors in paragraph 3 of the Policy is non-exhaustive and in any event considers that the differences are not of any significance to the question of Abusive Registration. In the Expert's opinion, the actions of the Respondent in the present case are caught by the general thrust of paragraph 3(a)(v) as discussed above, if not by the precise words, and also constitute Abusive Registration on the general definition that the Domain Name is being used in a way that is unfairly detrimental to the Complainant's Rights.

The Expert notes that the author of the Response at no point claims any rights in the name associated with the Domain Name, nor denies that the Complainant is entitled to use the Domain Name, nor provides any evidence that the Complainant's permission was sought to any transfer, nor offers an adequate explanation as to why the Respondent now appears as the registrant of the Domain Name. Instead, the entirety of the Response focuses on the grievances of the Complainant's former IT service providers. While it is accepted that there may be a *bona fide* contractual dispute between these entities and the Complainant, the substance of which is beyond the scope of the Policy, the Expert cannot see any way in which it could be considered fair in the circumstances of the present case for the Respondent to retain the Domain Name as a lever in such dispute, effectively holding it to ransom.

In all of these circumstances, the Expert finds that the Domain Name has been used in a manner which was unfairly detrimental to the Complainant's Rights. Accordingly the Expert finds that the Domain Name, in the hands of the Respondent, is an Abusive Registration.

7. Decision

The Expert finds that the Complainant has proved that it has Rights in a name or mark which is identical to the Domain Name and that the Domain Name, in the hands of the Respondent, is an Abusive Registration. The Expert therefore directs that the Domain Name be transferred to the Complainant.

Signed
Andrew D S Lothian

Dated 14 May, 2014