

DISPUTE RESOLUTION SERVICE

D00020611

Decision of Independent Expert

Roof Maker Ltd

and

Yakub Ismail

1. The Parties:

Lead Complainant: Roof Maker Ltd
1 Pinfold Road
Thurmaston
Leicestershire
LE4 8AS
United Kingdom

Respondent: Yakub Ismail
96 Villiers Street
Nuneaton
Nuneaton
CV11 5PJ
United Kingdom

2. The Domain Name(s):

roofmaker.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.

18 September 2018 15:28 Dispute received
19 September 2018 14:58 Complaint validated
19 September 2018 15:03 Notification of complaint sent to parties
20 September 2018 13:40 Response received
20 September 2018 13:41 Notification of response sent to parties
25 September 2018 02:30 Reply reminder sent
25 September 2018 16:42 Reply received
25 September 2018 16:43 Notification of reply sent to parties
28 September 2018 12:22 Mediator appointed
28 September 2018 14:45 Mediation started
15 October 2018 13:39 Mediation failed
15 October 2018 13:39 Close of mediation documents sent
25 October 2018 02:30 Complainant full fee reminder sent
29 October 2018 12:09 Expert decision payment received

4. Factual Background

The Complainant has since 2012 traded under the mark "Roof Maker" in respect of the manufacture and sale of roof windows to trade and consumers. It is the proprietor of the UK trade mark registration No 3122199 for the words "ROOFMAKER" and "ROOF-MAKER" registered with effect from 13 August 2015 in respect of goods/services covering its activities. It uses the domain name roof-maker.co.uk. A simple search on Google for "roof maker" produces extensive links, both sponsored and otherwise, to the Complainant.

The Domain Name was registered in May 2018 by the Respondent, who works in the roofing trade as a marketing manager. At the time this complaint was filed, it was directed to a holding page that showed an image of the inside of a roof with multiple roof windows, with the words "Coming Soon Making Roofing Easy". The Respondent intends to use the Domain Name in due course to offer prefabricated roofs.

The Complainant wrote to the Respondent in July 2018, complaining about the Domain Name and offering to pay the Respondent's costs of registering a replacement domain name. The Respondent declined that proposal.

5. Parties' Contentions

a. The Complaint

The Complainant contends that it has Rights because of the registered trade mark that it owns and the extent of its trading, and further that the Domain Name is an Abusive Registration because it was registered with the intention of confusing potential customers and disrupting the Complainant's business.

b. The Response

The Respondent contends that the Complainant's Rights are limited to skylights and blinds and are not in respect of those goods or services that he intends to offer using the Domain Name, which will be pre-fabricated roofs. He points to the difference between a roof, being made of tiles, timber and felt, and rooflights, being made from glass and aluminium. He struggles to see how it can be claimed that he has tried to confuse customers and disrupt the Complainant's business, when he hasn't even launched his website yet.

The Respondent refers to previous email correspondence with the Complainant and says that following the Complainant's complaint he has already agreed not to offer roofs with rooflights

(windows). He says that he is just a working-class person looking to set up his first business, having been offered the opportunity to sell pre-fabricated buildings, which is why he registered the Domain Name. He believes that the complaint has been brought to bully him in to handing over the Domain Name.

c. The Reply

The Complainant denies that it is bullying the Respondent and asserts that as a marketing manager the Respondent would have been aware of the Complainant's brand.

They believe that the category that the Respondent intends to operate in (i.e. roofing materials) will confuse customers and mislead them into visiting the wrong website, regardless of whether he sells rooflights.

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 marks and the use of its ROOF MAKER 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 .co.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 disputed Domain Name is an Abusive Registration.

The Complainant asserts that the Domain Name is an Abusive Registration for the reason 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"*

and goes on to set out a (non-exhaustive) list of factors which may be evidence that a domain name is an Abusive Registration (see paragraph 5), including at paragraph 5.1.2 that:

"Circumstances 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".

It seems to me that the Complainant's assertion that the Respondent did know of the former's use of the mark "ROOF MAKER" is likely to be correct. I say this because (a) I would have expected a marketing manager and particularly one operating in the same sector, to have carried out research of the market prior to adopting a trading name, and (b) the image used on the landing page to which the Domain Name is directed shows the inside of a roof featuring rooflights very prominently. In my view it is therefore likely that the Domain Name was registered with the intention to confuse people. Notwithstanding the Respondent's actual intention, it does seem to me that as a result of the use of an identical mark in respect of identical or very similar goods/services there is a strong likelihood that such use will take unfair advantage of or be unfairly detrimental to the Complainant Rights.

I am therefore persuaded that the Domain name is an Abusive Registration.

7. Decision

For the reasons set out above, I find that the Complainant does have Rights in respect of a name which is identical to the Domain Name <roofmaker.co.uk> and the Domain Name in the hands of the Respondent is an Abusive Registration. The Complaint therefore succeeds and the Domain Name should be transferred to the Complainant.

Signed

Dated

Simon Chapman