

Nominet UK Dispute Resolution Service

DRS 06696

**(1) Midland Heart Limited
(2) Andrew Foster**

and

Uton Black

Decision of Independent Expert

1 Parties

Complainants: Midland Heart Limited
Andrew Foster

Address: 20 Bath Row
Birmingham

Postcode: B15 1LZ

Country: United Kingdom

Respondent: Uton Black

Address: Flat 1
36 Cambridge Road
Kings Heath
Birmingham

Postcode: B13 9UD

Country: United Kingdom

2 Domain Name

[midlandheart.co.uk]

3 Procedural History

- 3.1 On 5 January 2009 the complaint was received by Nominet, which checked that it complied with the Nominet UK DRS Policy (“the Policy”) and DRS Procedure (“the Procedure”). Nominet received a response from the respondent on 29 January, and the complainant’s reply on 5 February. The dispute was not resolved in mediation. On 27 March the complainant requested referral of the matter for expert decision under the Procedure, and subsequently paid the applicable fee.
- 3.2 I, Carl Gardner, was appointed as expert on 16 April 2009. I have made the necessary declaration of impartiality and independence.

4 Factual background

- 4.1 The complainant is a housing association and registered social landlord, providing housing and housing management services in the West Midlands.
- 4.2 It is proprietor of UK trade marks registered under number 2459147B in respect of the words “midland heart” combined with a “hearts” logo. It has provided a registration certificate showing details of those trade mark registrations with the UK Intellectual Property Office. They appear from that certificate to have been registered in June 2007, rather than September 2008 as stated in the complaint.
- 4.3 The respondent is the tenant of a property let to him by the complainant.
- 4.4 The respondent registered the domain name on 22 May 2008.

5 Parties’ Contentions

Complainant

- 5.1 The complainant argues that the domain name is identical or similar to its trade mark.
- 5.2 It argues that the respondent’s use of a website at the domain name to comment on housing and building repair matters infringes that trade mark, which is registered in relation to classes 36 and 37, i.e. property management, rental and lease, and building construction and repair, among other things.
- 5.3 It argues that the respondent’s website has confused people into thinking it is connected to the complainant, and cites comments from a number of anonymous tenants to support this. It argues that the respondent has used his website to make unfair and defamatory criticisms of it. Rather than being educative and presenting appreciative as well as critical comment, it is purely focused on presenting a negative and misleading view of the complainant.

- 5.4 It argues that the respondent has no right or legitimate interests in respect of the domain name.

Respondent

- 5.5 The respondent argues that the website at the domain name is by and for tenants of the complainant and that its purposes are education, training, advice and support; and serves as a medium for tenants to make critical or appreciative comments. Those things are in no way similar to the complainant's services. The complaint that the website infringes the complainant's trademark is groundless.
- 5.6 He argues that the website does not seek to cause confusion with the complainant. On the contrary, it makes clear it is not connected to the complainant.
- 5.7 He argues that the website is linked to a nascent tenant's association, and that this association has a legitimate interest in the domain name. The domain name has been used in a genuine, fair, non-commercial way.

6 Discussion and Findings

General

- 6.1 Under paragraph 2(a) of the Policy a complainant must show on the balance of probabilities 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.

Rights

- 6.2 Rights are defined in the Policy as rights enforceable by the complainant, whether under English law or otherwise.
- 6.3 The complainant has produced documentary evidence of its trade mark relating to the words "midland heart" in combination with a pink "hearts" logo. In addition, it appears it has been in business under the name Midland Heart since 2006.
- 6.4 In those circumstances I am satisfied that the respondent has rights in respect of a name or mark which is identical or similar to the domain name.

Abusive Registration

- 6.5 Under paragraph 1 of the Policy, abusive registration means a domain name which either:
- 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

- has been used in a manner which took unfair advantage of or was unfairly detrimental to the complainant's rights.

This definition obviously covers both the time of registration, and later use.

- 6.6 Under paragraph 3(a)(ii) of the Policy, circumstances indicating that the respondent is using the domain name in a way which has confused or is likely to confuse people into believing it is connected with the complainant may be evidence of abusive registration.
- 6.7 Given that the domain name is identical to the complainant's name and trade mark text, I am satisfied that some initial interest confusion is likely between the respondent's site and the complainant, even if on arrival at the site it is said that no such connection exists.
- 6.8 Under paragraph 4(a)(i)(c) of the Policy, it may be evidence against abusive registration if, before being aware of the complainant's cause for complaint, the respondent has made legitimate non-commercial or fair use of the domain name. Under paragraph 4(b), fair use may include sites operated solely in criticism of a business. However, I do not think this helps the respondent in this case.
- 6.9 First, the respondent was obviously well aware of the complainant and its name before he registered the domain name. His use of the site, therefore, even if it were fair, took place after, not before, he was aware of the cause for complaint.
- 6.10 Secondly, in my view the respondent's use of the domain name was unfair. It would be difficult for me to take a view on whether the respondent's site fairly criticises the complainant, and I do not attempt to do so. But rather than choosing some other domain name flagging up clearly that the visitor was likely to find a tenants' site giving tenants' views, the respondent has registered and used a domain name identical to the complainant's name and trade mark text as the medium for criticism of it. Given the likelihood of initial interest confusion I have already referred to, in my view that was unfair.
- 6.11 Finally, the respondent does not dispute that his website has in the past displayed graphics similar to the complainant's pink "hearts" logo. The DRS is not directly concerned with the enforcement of trade marks legislation, and I express no opinion about whether there has been any trade mark infringement. However, this confirms me in the view that, in terms of the Policy, the respondent's use of the domain name was unfair.
- 6.12 Generally in terms of paragraph 1 of the Policy, I conclude that the respondent's registration of a domain name identical to the name the complainants are known by, for the purpose of creating a tenants' website critical of the complainant, took unfair advantage of the complainant's rights at the time when the registration took place. His subsequent use of the domain name as a medium for criticism of the complainant also means the domain name has been used in a manner which has taken unfair advantage of the complainant's rights.

6.13 In those circumstances I am satisfied on the balance of probabilities that the domain name, in the hands of the respondent, is an abusive registration.

7 Decision

7.1 I find that the complainant has rights in a name or mark which is similar or identical to the domain name; and that the domain name, in the hands of the respondent, is an abusive registration.

7.2 The complaint is upheld. I direct that the domain name be transferred to the lead complainant, Midland Heart Limited.

Carl Gardner

8 May 2009