

**DISPUTE RESOLUTION SERVICE**

**DRS 8559**

**Decision of Independent Expert**

**British Institute of Hypnotherapy**

**- and -**

**David Holland**

**1. The Parties:**

Complainant: Peter Lawrance  
Address: 12 Heycroft Road  
Eastwood  
Leigh on Sea  
Essex  
Postcode: SS9 5SW  
Country: UK

Respondent: David Holland  
24 Penswick Road  
Hindley Green  
Wigan  
Postcode: WN2 4GA  
Country: UK

**2. The Domain Names:**

- *britishinstituteofhypnotherapy.co.uk*
- *the-british-institute-of-hypnotherapy.co.uk*
- *britishinstituteofhypnotherapist.co.uk*
- *thebritishinstituteofhypnotherapy.co.uk*
- *british-institute-of-hypnotherapy-nlp.co.uk*
- *thebritishinstituteofhypnotherapy.org.uk*
- *british-institute-of-hypnotherapy.org.uk*
- *british-institute-of-hypnotherapy.co.uk*

### 3. Procedural History:

The Complaint was received by Nominet on 28 April 2010. Nominet validated the Complaint and sent a copy to the Respondent.

The Response was received by Nominet on 29 April 2010 and a copy sent to the Complainant.

Nominet received the Reply from the Complainant on 5 May 2010 and forwarded a copy to the Respondent.

On 14 May 2010 the Complainant paid Nominet the required fee for a full decision of an Expert pursuant to the Nominet UK Dispute Resolution Service Policy ("the Policy").

Nominet invited the undersigned, Jason Rawkins ("the Expert"), to provide a decision on this case and duly appointed the undersigned as the Expert with effect from 26 May 2010.

### 4. Factual Background and Findings:

The Nominet records show that the first and last of the Domain Names listed under section 2 above, namely *britishinstituteofhypnotherapy.co.uk* and *british-institute-of-hypnotherapy.co.uk*, were registered on 19 March 2009; and the others during the period from January to March 2010.

Based on the parties' submissions (see section 5 below) and a review of the materials annexed to the Complaint, together with the current home page of the Respondent's website at <http://www.britishinstituteofhypnotherapy.co.uk>, set out below are the main facts which I have accepted as being true in reaching a decision in this case:

- (1) The Complainant has operated under the name "British Institute of Hypnotherapy" from at least as early as 2002. Whilst the Complainant asserts that it has done so since 1984, there is insufficient evidence filed to make a finding on the operation dating that far back. However, the documentation filed by the Complainant, which consists of invoices for stationery and advertising, is enough for a finding that it has operated under the name since at least 2002. As will be apparent from section 6 below, it makes no difference to the decision in this case whether the Complainant has in fact operated under the name from earlier than that.
- (2) The Complainant has operated by use of a website at <http://www.britishinstituteofhypnotherapy.org> for around 5 years. Whilst the Complainant has not filed any evidence in support of this, I have checked the "whois" data for the domain name and it was registered under the name "British Institute of Hypnotherapy" in May 2001. I am therefore prepared to find on the balance of

probabilities that the Complainant has operated such a website for around 5 years.

- (3) The Respondent registered the Domain Names, in full knowledge of the Complainant's organisation, having previously been a member of it.
- (4) The Respondent sent emails to the Complainant on 27 January 2010, informing the Complainant of his registration of the Domain Names, claiming to "*now own the UK rights to the name British Institute of Hypnotherapy*" and going on to state that, unless the Complainant reinstated his listing on the Complainant's website and removed "*those who cannot teach hypnotherapy*" within 7 days, then he would "*have no option but to take what is legally mine*".
- (5) The Respondent sent emails to a number of the Complainant's members on 30 January 2010, stating "*FREE membership offer for the first five new members Feb 2010 only*" and going on to give a link to his website at <http://www.britishinstituteofhypnotherapy.co.uk>. When one of the Complainant's members sent an email in reply stating that the Respondent was not the British Institute of Hypnotherapy, the Respondent sent emails back stating "*I can assure you that we are*" and "*We are the real BIH*".
- (6) On 31 January 2010 the Respondent sent emails to training organisations, including Motivation Training, stating inter alia "*We now own the legal rights to the name British Institute of Hypnotherapy, we also own the official UK domain name britishinstituteofhypnotherapy.co.uk.... You will receive your new BIH logo with your name on as shown on the accredited courses page... The new logo is professional and easy for the general public to understand..., whereas the original logo was meaningless and the old site hard to navigate and unprofessional. The BIH needed a total rethink to push the image...forward in a professional light. The new website is user friendly....Your membership is free as you are already on the old site...All we ask is that you add your new logo to your website and a link to <http://www.britishinstituteofhypnotherapy.co.uk> "*.
- (7) The home page of the Respondent's website at <http://www.britishinstituteofhypnotherapy.co.uk> states that it is the "*official UK site for the British Institute of Hypnotherapy*". It is also noteworthy that no address is given for the organisation, only a mobile telephone number.

## 5. Parties' Contentions:

### Complainant:

The Complainant's submissions can be summarised as follows:

1. The Complainant has rights in a name which is identical or similar to the Domain Names:
  - (1) The Complainant has traded under the name "British Institute of Hypnotherapy" since 1984, including advertising under that name for many years.
  - (2) The British Institute of Hypnotherapy run by the Complainant is an accrediting body which gives accreditation to training courses, and to students who have completed their training, and who are then entered on the Complainant's register of qualified hypnotherapists.
  - (3) The Complainant has operated a website at <http://www.britishinstituteofhypnotherapy.org> for around 5 years.
2. The Domain Name is an Abusive Registration in the hands of the Respondent:
  - (1) The Respondent has sent emails to a number of the Complainant's members stating that he has taken over ownership of the British Institute of Hypnotherapy, including false claims that the "old version" has a criminal element attached to it, hence the Respondent's new website.
  - (2) The Respondent has also been selling home study courses using the name "British Institute of Hypnotherapy".
  - (3) The Respondent's activities have led to complaints being made to the Complainant.

### Respondent:

The Respondent's submissions can be summarised as follows:

- (1) The Complainant does not own any rights in the name "British Institute of Hypnotherapy". The Complainant is not an official institution as it has not been recognised by the UK government.
- (2) The Respondent's decision to buy the first Domain Name and set up a business around it was therefore in no way abusive. The Respondent had the legal right to do so, and proceeded with good intentions.

## 6. Discussion and Findings:

### General

Paragraph 2 of the Policy (amended below to allow for there being more than one Domain Name) provides that, to be successful, the Complainant must prove on the balance of probabilities that:

- i it has Rights in respect of a name or mark which is identical or similar to the Domain Names; and*
- ii the Domain Names, in the hands of the Respondent, are Abusive Registrations (as defined in paragraph 1 of the Policy).*

### Complainant's Rights

"Rights" are defined under paragraph 2 of the Policy as meaning:

*"rights enforceable by the Complainant, whether under English law or otherwise, and may include rights in descriptive terms which have acquired a secondary meaning."*

Enforceable rights in a name or mark can be by way of a trade mark registration or registrations. However, it is also possible to have rights without a trade mark registration. If a person uses a name or mark for a period of time, he can build up unregistered rights in the nature of goodwill in that name which can then (depending on the facts) be enforced against another party using the same, or similar, name by way of a passing off claim. A person will have established such goodwill, and therefore rights, if people in the relevant field recognise the name as denoting that person's business or product (meaning in turn that the consequence of someone else using the same or similar name is that its doing so will cause, or be likely to cause, people to believe mistakenly that the person is in fact the rights holder or connected with him in some way).

As the definition in the Policy makes clear, it is also possible for a person to have rights in a descriptive term. For this to be possible, however, the person (or business) must have made sufficient use of the name in his field of business for people to associate the term with that person. In other words, a position needs to have been reached where, in that field, the name is in fact no longer purely descriptive with no connection to anyone. This is what is meant in the definition of Rights by the term having acquired a "secondary meaning". By way of examples, the publishers of the "Homes & Garden" magazine have clearly established rights in that title in spite of the words being descriptive of the magazine's content; or, of greater parallel to this case, British Airways has rights in its name even though the words, taken literally, are just descriptive of a British airline.

Although the Complainant does not have a trade mark registration for the name "British Institute of Hypnotherapy", there remains the possibility of the type of unregistered rights described above. In addition, the name "British

Institute of Hypnotherapy" is also descriptive in nature. In order to qualify for legal rights, sufficient use therefore needs to have been made of the name for people to recognise it as belonging to the Complainant. It needs to have acquired a "secondary meaning".

As a result of having operated under the name "British Institute of Hypnotherapy" since at least 2002, including by use of a website at <http://www.britishinstituteofhypnotherapy.org> since around 2005, I find that the Complainant has established Rights in the nature of legally protectable goodwill in that name. Whilst the Complainant's business is on a very different scale to British Airways, in my opinion the evidence is sufficient for a conclusion that, in the Complainant's field of hypnotherapy, people associate the name "British Institute of Hypnotherapy" with the Complainant.

The Respondent's belief that the Complainant does not have such Rights because it has not registered a trade mark is accordingly mistaken.

Disregarding the generic *.co.uk* and *.org.uk* suffix, each of the Domain Names is identical or similar to British Institute of Hypnotherapy. I therefore find that the first limb of paragraph 2 of the Policy is satisfied.

#### Abusive Registration

Paragraph 1 of 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 has been used in a manner which has taken unfair advantage of or has been unfairly detrimental to the Complainant's Rights."*

Paragraph 3 of the Policy sets out a non-exhaustive list of factors which may be evidence that a Domain Name is an Abusive Registration. The factor under paragraph 3a which is most relevant in this case is as follows:

- "ii. 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 is clear from the communications which the Respondent has sent to training organisations and members of the Complainant's organisation that his aim has been to persuade people that he is the British Institute of Hypnotherapy (i.e. the Complainant's organisation) or some relaunched version of the same. Whilst some of the recipients were not in fact deceived, as is apparent from their responses to the Respondent and/or their having notified the Complainant of the Respondent's activities, those activities are very likely to have deceived others and/or to do so in the future. This conclusion is

reinforced by the content of the Respondent's website which does nothing to prevent the likelihood of such confusion, in fact the opposite. Based on the Respondent's communications with the Complainant, I also find that the Respondent is threatening to use all the Domain Names to create similar confusion.

Such confusion takes unfair advantage of the Complainant's Rights because it serves unfairly to attract people to the Respondent's website and alternative organisation. It is also unfairly detrimental to the Complainant's Rights because, when people are deceptively diverted in this way, there is the prospect of them joining the Respondent's organisation mistakenly believing it to be the Complainant's organisation and thereby ceasing to be members of the Complainant's body. Needless to say it is also unfairly detrimental to the Complainant's Rights for the Respondent, masquerading as the "new" British Institute of Hypnotherapy and taking advantage of that assumed identity, to have made accusations to the Complainant's members and training organisations that the "old" organisation (i.e. the Complainant) was run in an unprofessional manner.

I am therefore satisfied that the Domain Name is an Abusive Registration.

**7. Decision:**

Having found that the Complainant has rights in respect a name which is identical or similar to the Domain Names and that the Domain Names in the hands of the Respondent are Abusive Registrations, the Expert directs that the Domain Names be transferred to the Complainant.

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**Jason Rawkins**

**11 June 2010**