

DISPUTE RESOLUTION SERVICE

D00021761

Decision of Independent Expert

The Accessible Property Register

and

THS Group Limited

1. The Parties:

Complainant: The Accessible Property Register
11 Stumperlowe Croft
Sheffield
S Yorkshire
S10 3QW
United Kingdom

Respondent: THS Group Limited
6 Owen Street
Suite 001
London
EC1V 7JX
United Kingdom

2. The Domain Names:

accessible-property.co.uk
accessible-property.org.uk

3. Procedural History:

I 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 such a nature as to call in to question my independence in the eyes of one or both of the parties.

23 August 2019 11:29 Dispute received
23 August 2019 14:29 Complaint validated
29 August 2019 14:33 Notification of complaint sent to parties
17 September 2019 11:34 Response received
17 September 2019 11:34 Notification of response sent to parties
20 September 2019 02:30 Reply reminder sent
23 September 2019 14:10 Reply received
23 September 2019 14:11 Notification of reply sent to parties
30 September 2019 15:35 Mediator appointed
03 October 2019 11:35 Mediation started
08 November 2019 12:40 Mediation failed
08 November 2019 12:43 Close of mediation documents sent
19 November 2019 Complainant proposes non-standard submission
20 November 2019 Complainant files non-standard submission
20 November 2019 01:30 Complainant full fee reminder sent
20 November 2019 11:25 Expert decision payment received
20 November 2019 Keith Gymer appointed as Expert wef 25 November, 2019

4. Factual Background

The Complainant is Conrad Hodgkinson, doing business using the trading name “The Accessible Property Register”. The Complainant and his wife (who was a wheelchair user) set up a website to promote and advertise wheelchair accessible residential property in or about early 2003, using the Domain Name <accessible-property.org.uk>. Subsequently, the Domain Name <accessible-property.co.uk> was also purchased, but was not actively used. In connection with this service, the Complainant incorporated a company, The Accessible Property Register Limited (UK Co. No. 4565076) on 16 October 2002. The Accessible Property Register website has been operating continuously since 2003. In 2015, after the death of his wife, the Complainant was put into contact with a Mr Goldenberg, the operator of a larger online property portal at <thehouseshop.com>, and a Licence Agreement was established whereby the Complainant, as Licensor, gave the Licensee, then Property Data Media LLP (run by Mr Goldenberg), a licence to operate the website under the Accessible Property Register name specifically using the Domain Name <accessible-property.org.uk>, in return for a share of the income generated therefrom. Subsequent to the grant of this Licence, The Accessible Property Register Limited was itself dissolved by the Complainant on 24 October 2017

The Respondent is presently identified as THS Group Limited, another company run by Mr Goldenberg, which has subsequently assumed responsibility for operating the

website. The Companies House records show that the original Licensee, Property Data Media LLP, was dissolved on 2 January 2018.

Nominet Whols records show that

- (1) the Domain Name <accessible-property.org.uk> was first registered on 12 November 2002. From 10 November 2008, the Registrant was identified as “Accessible Property Register”, with Mr Hodgkinson as administrative contact. On 10 June 2018, following an update made via GoDaddy, the Registrant was changed to THS Group Ltd; and
- (2) the Domain Name <accessible-property.co.uk> was first registered on 20 January 2008, with the Registrant identified as “Accessible Property Register” and Mr Hodgkinson as administrative contact. For this Domain Name, the Registrant was changed, on instructions via GoDaddy, to THS Group Limited on 3 January 2018.

5. Parties’ Contentions

Complainant

The Complainant asserts ownership of the Domain Names and rights established by use in particular of the Domain Name <accessible-property.org.uk> for a website using the name “Accessible Property Register” for promotion and advertising of accessible residential property continuously since 2003.

The Complainant itself operated the website until 2015 when a Licence was agreed with Mr Goldenberg for his business to run the Accessible Property Register website in conjunction with his Houseshop property portal. The Licence referred only to use of the Domain Name <accessible-property.org.uk>, but the Complainant states that he separately agreed to use of <accessible-property.co.uk> as well, if required.

The Complainant has provided a copy of the terms of the 2015 Licence, in which it is stated that the Licensee acknowledges the Complainant’s ownership of the licensed product (the website) and all intellectual property therein.

The License also provides for termination on notice if the Licensee defaults on payment of Licence fees in accordance with the Agreement. The Complaint states that payments have been received up to December 2017, but no payment has been made for 2018.

On 3 June 2019 following several exchanges of correspondence, the Complainant formally emailed a notice to Mr Goldenberg for the Respondent, requesting the default be remedied within 14 days.

A formal notification of termination of the Agreement was sent subsequently by the Complainant to Mr Goldenberg on 1 August 2019, requesting return of the Domain

Names by 7 August 2019 and that the Respondent cease use of the brand name “Accessible Property Register”.

As this has not been done, the Complainant asserts that the Domain Names are Abusive Registrations.

Remedy Requested

The Complainant requests transfer of the Domain Names.

Respondent

The Respondent states that THS Group Limited have entered into a commercial agreement with the Complainant, and are promoting services on the website using the Domain Name <accessible-property.org.uk> in exchange for a revenue share.

The Complainant had requested that the Respondent develop a brand-new website in 2018, which has been done. This was on condition that the Agreement would last for five years on a revenue share basis, with the provision that the Complainant could terminate the relationship by paying a one-time fee of £10,000 for early termination to recover the Domain Name. The Respondent submits a copy of an email exchange where the Complainant wrote on 9 January 2018 “The early termination fee of 10K seems entirely reasonable in view of the investment that you will be making.”

The Respondent claims to have already tried to come to a compromise with the Complainant, asking to be paid the early termination fee as agreed, less the outstanding Licence payments due.

Alternatively, the Respondent says it offered to pay the Complainant the overdue Licence fees for its revenue share, on condition the Respondent is allowed to continue to exploit the Domain Name using the updated website it has developed for the extended five year period.

The Respondent asserts that the Domain Name <accessible-property.org.uk> was transferred to it in December 2015 by the Complainant and refutes the Complainant’s claim to this Domain Name.

Complainant’s Reply

The Complainant restates that the License Agreement dated 15 December 2015 is the only commercial agreement that has been made regarding the use of the Domain Names. The Complainant recognises that THS Group Limited are the Licensees [*Expert comment: this notwithstanding that the copy of the Licence provided refers to Property Data Media LLP*] and as such were licensed to manage the Accessible Property Register website on his behalf. The Complainant expressly

states that this agreement has never been updated or replaced, and says the terms of the License Agreement are explicit - Clause 10.1 states:

“10.1 All modifications to this Agreement must be in writing and be signed by duly authorised representatives of both parties.”

The Complainant acknowledges a meeting took place in 2017 to discuss extending the period of the licence and updating the website. Since then, the Respondent has not presented a formal amendment to the original agreement for signature, despite requests to do so. Consequently, no agreement exists beyond that expressed in the terms of the original licence, in which no penalty for any early termination is specified.

The Respondent’s claim that ownership of the Domain Name <accessible-property.org.uk> has been transferred to them is untrue. Ownership was not transferred, and the Licensee does not own the name. See Clause 3.1a of the agreement:

“3.1a The Licensee acknowledges and undertakes to the Licensor that: the Licensee will not dispute or challenge the Licensor’s exclusive ownership of the Product and all intellectual property therein;”

The Complainant notes that the Respondent does not dispute that no financial update or licence payment was made for more than 18 months despite repeated requests, and that the Licence Agreement was therefore legitimately terminated under the provisions of Clause 5.1 below:

“5.1 If the Licensee fails to pay any sum including the Licence Fee when due to the Licensor or breaches any of the provisions of this Agreement and fails to remedy the breach within 14 days of being requested by the Licensor so to do, the Licensor may at the Licensor’s absolute discretion terminate this Agreement by giving written notice to the Licensee to that effect.”

The Complainant further points out that, even if a Clause specifying a termination penalty and increased duration had been written into an amended agreement and signed by both parties as specified in Clause 10.1 above (which it was not), the Licensor would still have terminated the agreement due to breach of contract by the Licensee through non-payment of licence fees (Clause 5.1 above).

The Complainant concedes that it makes no claim on the current website content which was developed by the Respondent, but only requires return of the Domain Names.

Complainant’s Later Non-Standard Submission

The Complainant subsequently submitted a request for consideration of additional email correspondence presented after the closure of mediation. The Expert has declined to admit this correspondence for consideration.

6. Discussions and Findings

General

Paragraph 2 of the Policy requires that, for the Complainant to succeed, it must prove to the Expert, on the balance of probabilities, both that

2.1.1 The Complainant has Rights in respect of a name or mark which is identical or similar to the Domain Name; and

2.1.2 The Domain Name, in the hands of the Respondent, is an Abusive Registration

Under Paragraph 18.1 of the Policy, the Expert is required to decide a complaint on the basis of the Parties' submissions and the Policy.

Complainant's Rights

The Complainant has asserted that it is the proprietor of the brand name "Accessible Property Register". It is unchallenged that the Complainant created and used this designation from 2003 until 2015 in connection with its own website using the Domain Name <accessible-property.org.uk>. The use of the brand name and this Domain Name was plainly subject to the Licence agreement of 2015 with the then Licensee company. That the parties accepted that there were licensable rights is clearly a strong indication that such rights were in existence.

In the Expert's view, the evidence certainly supports the claim that the Complainant would indeed have established at least common law rights to the name "Accessible Property Register". The Domain Names both contain the words "accessible-property", but without the word "register". However, the long use of the Domain Name <accessible-property.co.uk> obviously means the name has a direct association with those words. Consequently, for the purposes of the Policy the Expert considers that the Complainant has Rights in respect of a name or mark which is similar to both Domain Names. The requirement of Paragraph 2.1.1 of the Policy is met.

Abusive Registration

The Complainant also must show that each Domain Name is an 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. 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.

A non-exhaustive list of factors which may be evidence that a Domain Name is an Abusive Registration are set out in Paragraph 5 of the Policy. Paragraph 5.1.2 may be relevant to the Complainant's case:

5.1.2 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;

However, the factors listed in Paragraph 5 are only intended to be exemplary and indicative. They are not definitive. It is Paragraph 1 of the Policy, which provides the applicable definitions as indicated above.

In this case, there is no dispute that both Domain Names were indeed originally registered in the name of "Accessible Property Register", with Mr Hodgkinson as administrative contact, and that the Accessible Property Register website was exclusively operated by him until the end of 2015 using the Domain Name <accessible-property.org.uk>. As of December 2015, it is also agreed by both sides that a Licence agreement (unsigned copies of which have been submitted in evidence in these proceedings), was entered between the Complainant and a company operated by Mr Goldenberg. The parties have not contested the wording of that agreement as submitted.

It is said to be between:

Conrad Hodgkinson, Accessible Property Register, ... **(the Licensor)**

AND

Property Data Media LLP, ... **(the Licensee)**.

No evidence has been provided of any formal amendments to this agreement and, indeed, the Complainant has expressly stated "this agreement has never been updated or replaced", placing particular reliance on Clause 10.1:

"10.1 All modifications to this Agreement must be in writing and be signed by duly authorised representatives of both parties."

Companies House records show that the Licensee, Property Data Media LLP was actually dissolved on 2 January 2018. The Respondent, THS Group Limited, is

therefore not the Licensee under that agreement. Clause 10.2 of that agreement also states:

“10.2 This Agreement may not be assigned or transferred by either party without the prior written consent of the other.”

In such event, the Licence might well be considered to have terminated automatically upon dissolution of the Licensee. Clause 5.2 states:

“5.2 Upon termination through breach or expiry of the Term the Licensee must immediately:
(a) cease to use the Product; and
(b) return all of the Licensor’s property in the Licensee’s possession.

The Product is specified in Part A of the Schedule to the Licence Agreement as:

“PART-A. Website:
1.) Property website at <http://accessible-property.org.uk/>”

Under Clause 3.1 of the Licence:

“3.1 The Licensee acknowledges and undertakes to the Licensor that:
(a) the Licensee will not dispute or challenge the Licensor’s exclusive ownership of the Product and all intellectual property therein;
(b) nothing herein confers on the Licensee any interest in the Product or right to use the Product except to the extent permitted in this licence;
(c) all enhancements, new uses and adaptations of the Product discovered by the Licensee are owned exclusively by the Licensor and the Licensee must sign all documents, assignments or transfers of intellectual property as the Licensor may reasonably require to ensure that the Licensor is the exclusive owner thereof.

Under Part-B of the Schedule the Licensor identifies the License purpose to be:

“Part-B. To enable the Licensee to operate the products mentioned in the agreement as a business, provide the Licensee access to the entire website, front end, back end, the domain registrar and allow the licensee to instruct any party to maintain or upgrade the Product if needed.”

There is no indication whatever in the Licence of any intention to transfer ownership of property from the Licensor to the Licensee.

Evidently in anticipation of moving the website hosting for the planned website update, the Licensor provided information by email of 26 June 2017 with its then domain name Registrar details to allow the Licensee to transfer the Domain Name <accessible-property.org.uk> to a new Registrar.

The Respondent's Registrar GoDaddy subsequently acted to change the Registrant for both Domain Names to THS Group Ltd, for <accessible-property.co.uk> on 3 January 2018, and for <accessible-property.org.uk> on 10 June 2018. Both actions took place after dissolution of the original Licensee.

There is no evidence whatever that the Respondent, THS Group Limited, had any written agreement to change the Registrant in this way.

The parties both appear to have acted on the basis of assumptions and presumptions and the Accessible Property Register website has continued to operate, presumably in anticipation of a new Licence being granted on corresponding terms.

However, in the absence of any written evidence to the contrary, it appears to the Expert that the Respondent has acted without any written Licence in place, and that its appropriation of the Domain Names into its name would be in breach of such Licence terms in any event. The Complainant, as actual (and putative) Licensor has also expressly terminated its Licence to use the Domain Name <accessible-property.org.uk> and the brand name "Accessible Property Register" consistent with such terms. There is also no evidence that appropriation of the Domain Name <accessible-property.co.uk> was ever authorised by the Complainant.

The Expert concludes that continuing use and appropriation of the Domain Names by the Respondent in these circumstances takes unfair advantage of and is unfairly detrimental to the Complainant's Rights. The Domain Names are therefore to be considered as Abusive Registrations for the purposes of the Policy. The requirement of Paragraph 2.1.2 of the DRS Policy is met.

7. Decision

Having found that the Complainant has relevant Rights and that the Domain Names, in the hands of the Respondent, are Abusive Registrations, the Expert orders that the Domain Names be transferred to the Complainant.

Signed
Keith Gymer

Dated 11 December 2019