

Nominet UK Dispute Resolution Service

DRS 00936

Bernard Matthews Ltd –v- Jason McCluskey (aka Bernard Matthews)

Decision of Independent Expert

1. Parties

Complainant: Bernard Matthews Ltd
Address: Great Witchingham Hall
Norwich
Norfolk
Postcode: NR9 5QD
Country: UK

Respondent: Mr Jason McCluskey (aka Bernard Matthews)
Address: 298 Holt Road
Horsford
Norwich
Norfolk
Postcode: NR10 3EG
Country: UK

2. Domain Name

bernardmatthews.co.uk (“the Domain Name”)

3. Procedural Background

The Complaint was lodged with Nominet on 4th April 2003. Nominet notified the Respondent of the validated Complaint on 9th April 2003. The Respondent provided a respond within the required time period on 7th May 2003. The Complainant replied to the response on 16th May 2003 and Nominet sent a copy to the Respondent on the same day. Informal mediation failed to find a resolution to the dispute. The Complainant paid Nominet the appropriate fee for a decision of an Expert, pursuant to paragraph 6 of the Nominet UK Dispute Resolution Service Policy (“the Policy”), before the stated deadline of 18th June 2003.

Steve Ormand, the undersigned, (“the Expert”) confirmed to Nominet on 11th June 2003, that he knew of no reason why he could not properly accept the invitation to act as expert in this case and that he knew of no matters which ought to be drawn to the attention of the parties, which might appear to call into question his independence and/or impartiality.

4. Procedural Issues

There are no outstanding procedural issues.

5. The Facts

The Complainant is a company trading in the United Kingdom since 1959, using the name Bernard Matthews Limited, and is a producer and supplier of turkeys and other meat products which it sells primarily under the brand name "Bernard Matthews". Copy documents have been submitted to show successful registration of the trade mark "Bernard Matthews" in several classes in the UK between July 1985 and October 1997.

The Respondent registered the Domain Name on 10th August 1999.

6. The Parties' Contentions

History to the Dispute

There is a lengthy history to this dispute prior to the Complaint being lodged with Nominet:

- The Complainant states that he discovered the Respondent's website in Sept 1999
- The Complainant made enquires of the Respondent in Oct 1999 and attempted unsuccessful contact by telephone in Dec 1999. The Complainant's solicitors wrote to the Respondent in Dec 1999.
- The Respondent replied in Dec 1999 confirming he was Jason McCluskey and he was the c/o person registered for the Domain Name.
- In Feb 2000 the Complainant requested Nominet to cancel the Domain Name.
- In March 2000 the Respondent stated to Nominet that Jason McCluskey's views were not necessarily the same as his, Bernard Matthews.
- In May 2000 Nominet requested the Respondent to provide evidence that he was Bernard Matthews. The Respondent provided copies of a passport, credit and bank cards, and a mobile phone bill. The mobile phone bill is addressed to Bernard Matthews but has Jason McCluskey as the name on the payment slip.
- Nominet rejected the request to cancel the Domain Name in June 2000.
- In June/July 2000 the Complainant took steps to confirm that Jason McCluskey and Bernard Matthews (the Respondent) were the same person and submits evidence to show that this is the case.
- In July 2000 the Complainant took legal action to prevent the Respondent from using the Domain Name on the grounds of trade mark infringement. The action failed since the Respondent was not trading. The Respondent appeared as Jason McCluskey aka Bernard Matthews.
- An interim agreement was reached in July 2000 that until trial or further order the Respondent would remove references to the Complainant from his website and return misdirected e-mails to the senders with a note explaining the Domain Name is not connected to the Complainant.
- In June 2001 the Complainant paid the Respondent £350 in settlement of costs for the court action.

Complainant

The Complainant's submission includes 298 pages of supporting evidence of e-mails, correspondence and so on. The substance of the Complaint is as follows:

1. The Complainant is the registered proprietor of the trade mark "Bernard Matthews" and the company has unregistered rights in the name "Bernard Matthews" by virtue of its extensive use of the name and substantial reputation and goodwill under it.
2. The Domain Name is identical to the Complainant's principal brand name and trademark. Thus, the burden of proof is on the Respondent to show that it is not an abusive registration as per §4b of the Dispute Policy. Although this refers specifically to a domain name used for a tribute or criticism site, the point is stronger where the domain name is not used for such a site and hence not capable of justification on this ground.
3. Impersonation by the use of an identical domain name can rarely be justified: see the Decision of the Nominet Appeal Panel in DRS00389 (scoobydoo.co.uk).
4. False contact details were given to Nominet at registration, an indication of abusive registration (Dispute Policy §3(a)(iv)). The Respondent registered the Domain Name with contact details: Mr J R McCluskey, Bernard Matthew and Son Painters. This is inconsistent with the Respondent's claims that he had already changed his name to Bernard Matthews and with his stated intention of trading in digital painting/art work; Bernard Mathew & Son Painters connotes a home decorator not a digital graphics studio. There was no such entity as Bernard Matthew & Son Painters. The telephone contact number provided was unobtainable.
5. The Complainant alleges that the Respondent's claim to be called Bernard Matthews is an attempt to justify the registration of the Domain Name. In support of this, the Complainant cites a forged copy telephone bill, false statements made to Nominet in a letter of 19th March 2000, the findings made by private detectives engaged by the Complainant's solicitors, and the lack of any use of the Domain Name for a digital graphics business (or any other genuine use) in the 3½ years since the Domain Name was registered.
6. The Respondent adopted the name Bernard Matthews on account of the Complainant's reputation. He could have easily chosen another domain name to avoid confusion.
7. The Respondent's registration and use of the Domain Name have caused and continue to cause significant confusion and disruption to the Complainant's business. The Respondent further increased the likelihood of confusion by using the e-mail address bernard.matthews@bernardmatthews.co.uk. This format is typical of a large company but not normal for an individual or sole trader. The e-mail format firstname.lastname@bernardmatthews.co.uk is an obvious address for the Complainant's employees and very similar to the actual e-mail address firstname.lastname@bernardmatthews.com. The evidence provided is likely to be the tip of the iceberg since the Respondent only forwards e-mails now and then. The Respondent was confused when he sent an e-mail to the Complainant's managing director at @bernardmatthews.co.uk.
8. Early instances of misdirection were sometimes due to confusion on the part of the Complainant's staff. The Complainant has repeatedly stressed to staff the importance of giving the correct e-mail address but still misdirection keeps occurring. Specific

examples of misdirected e-mails indicate the difficulty of preventing misdirection.

9. Other examples indicate the damage caused or liable to be caused to the Complainant by the Respondent's use of the Domain Name. The Respondent has replied to some senders in an abusive manner. The Respondent replied to a member of the Complainant's staff in an abusive manner and the recipient believed it had come from the Complainant's chairman Bernard Matthews.
10. The Respondent's strapline on the home page of his website "Whatever you need from digital painting to a turkey sandwich" was intended to cause confusion with the Complainant, at any rate on the part of search engines. When challenged he gave a false explanation.

Respondent

The substance of the Respondent's assertion that the Domain Name is not an abusive registration is as follows:

1. The Respondent is Mr Bernard Matthews and his occupation is self-employed painter. He has never claimed to be Bernard T Matthews or anyone from the Complainant. His website has never claimed to be that of the Complainant and has never resembled that of the Complainant's nor would any sensible layperson think that it was that of BM Foods.
2. When the Respondent purchased the Domain Name he never envisaged he would receive any emails other than his own.
3. The Domain Name has only ever been registered to Bernard Matthew & Son Painters or Bernard Matthews not J R McCluskey. The name J R McCluskey is an AKA (also known as) for "himself/agent name".
4. Domain names are sold on a first come first served basis. The Nominet rules include: "No Limitation is placed on ...the use for which [domain names] are being put to subject to any request meeting the rules as applying at the time when the request is made."
5. The phone number used on registration was correct at the time of registration. The ISP did not notify Nominet of the change.
6. The Complainant has tried to Cancel the Domain Name previously and failed.
7. The Complainant has also tried to seek an injunction preventing the Respondent's use of the Domain Name, an agreement was reached out of court and the case was discontinued. The Complainant paid the Respondent's costs.
8. The agreement remains in force and invalidates this Complaint. There were no restrictions placed on the Respondent's use of his e-mail address only to remove all references to Bernard Matthews PLC and their investigations. Thus, the agreement consents to his use of the Domain Name.
9. The format of the Respondent's e-mail is a personal preference not an attempt to confuse.
10. The Complainant made an offer of £2000 to purchase the Domain Name which the Respondent declined. He has never sought to make money from the use or sale of the Domain Name.

11. The Respondent is not responsible for the Complainant's staff giving out e-mail addresses @bernardmatthews.co.uk, which they regularly do, or for someone failing to verify an email address before sending an email.
12. The Respondent replies to most emails that seem intended for the Complainant, advising the sender of their error or forwarding them to the Complainant. He advised the Complainant that a person at Sainsburys was sending about 50 incorrectly addressed e-mails a month. A stern email to a persistent "offender" cannot be conceived as detrimental.
13. The Respondent offered a solution that would allow any e-mails intended for the Complainant to be accessed by pop3 or automatically sent to the [@bernardmatthews.com](http://bernardmatthews.com) domain. It would only have taken the Complainant about 3-5 minutes to set-up per user. His ISP would have charged him £500 for this service to which he did not ask the Complainant to contribute. His offer was declined. His ISP forwards all e-mails sent to bernardmatthews.co.uk to a single user number email box so he is unable to filter e-mails.
14. The Respondent did not send an e-mail in error to the Complainant's MD at @bernardmatthews.co.uk. The email was a CC to himself so sorted e-mails sent to or received from the Complainant's MD are listed together.
15. The Respondent questions how a member of the Complainant's staff could confuse an e-mail from bernard.matthews@bernardmatthews.co.uk with one from their Chairman.
16. The Respondent does not remember the strapline cited by the Complainant ever being on his website. In any case the strapline is an image thus there is no text for a search engine to pick up.

Complainant's Reply to Respondent's Submission

The Complainant submits that:

1. The most significant feature of the Response is that it does not challenge many of the key points of the Complaint. These unchallenged points in themselves justify a finding that the Domain Name is an abusive registration. These are:
 - (a) Complainant's rights in the name "Bernard Matthews".
 - (b) Respondent called himself J R McCluskey when registering the Domain Name.
 - (c) Respondent provided a forged copy of a telephone bill and false explanations to Nominet to justify registration of the Domain Name.
 - (d) Respondent adopted the name Bernard Matthews on account of its association with the Complainant.
 - (e) Respondent has never used the Domain Name to advertise his alleged business as a self-employed painter.
 - (f) The Respondent's use of the Domain Name continues to cause significant confusion and disruption to the Complainant's business.
 - (g) The Respondent could easily use a different domain name which would avoid this confusion and disruption.
2. With regard to the Respondent's claims:
 - (a) He did not call himself Bernard Matthews when he registered the Domain Name and when he responded to the Complainant's solicitors in Dec 1999 and Jan 2000.
 - (b) The Complainant doubts that the Respondent never envisaged that he would receive e-

mails intended for the Complainant. The Respondent's use of his e-mail address represents that he is the Bernard Matthews of the Complainant company.

- (c) The allocation of domain names is subject to the Nominet DRS now in force.
- (d) The Respondent provided several telephone number which were all unobtainable, not just the one he claims his ISP failed to notify.
- (e) The Respondent previously stated that the agreement expired with discontinuance of the action and he was right on this point. It was an interim agreement until trial which would lapse on discontinuance of the action. The Respondent has not, in any case, complied with the agreement and has admitted this.
- (f) The agreement did not address the Respondent's e-mail address as it was as much as the Complainant's advisers thought could be achieved as an interim agreement at that time.
- (g) The Respondent chose a domain name that was bound to cause confusion.
- (h) The Domain Name is an abusive registration if it has been registered or used in a manner unfairly detrimental to the Complainant whether or not the respondent has sought to make money out of it.
- (i) Some people sending incorrect e-mails blame the Complainant for the Respondent's registration of a confusing name.
- (j) The registration and use of a confusing domain name is not justified by the possibility that exceptionally careful people might avoid the problem.
- (k) The Respondent does not reply to most senders advising of the error and has supplied no evidence to show that he does.
- (l) No evidence provided of e-mails sent by the Respondent to Sainsburys.
- (m) There was no persistence in error by persons employed by the Complainant that justified the Respondent's offensive messages.
- (n) The Respondent's proposed solution would require him to have access to the names of all the Complainant's staff and ongoing administration costs, both unacceptable.
- (o) The Respondent's explanation of CC mails being sorted is not accepted.
- (p) The Respondent's explanation of the "turkey sandwich" strapline does not detract from his dishonesty on this point.

7. Discussion and Findings

General

To succeed in this Complaint, the Complainant has to prove to the Expert on the balance of probabilities, pursuant to §2 of the Policy, both legs of the test that:

1. it has rights (as defined in §1 of the Policy) in respect of a name or mark identical or similar to the Domain name; and
2. the Domain Name, in the hands of the Respondent, is an Abusive Registration (as defined in §1 of the Policy).

Complainant's Rights

The Complainant is the proprietor of registered trade mark rights in the name or mark "Bernard Matthews". The Domain Name comprises the name or mark <bernardmatthews> and the suffix <.co.uk>. The domain suffix is discounted as it is of no relevant significance and wholly generic. The lack of a space between bernard and matthews in the Domain Name is considered irrelevant by the Expert.

The Expert finds that the Complainant has rights in respect of a name or mark that is identical to the Domain Name.

Abusive Registration

The Complainant asserts that since the Domain Name is identical to the Complainant's mark, the burden of proof is on the Respondent to show that it is not an abusive registration even though the Domain Name is not being used for a tribute or criticism site.

The Expert disagrees. The Policy is quite clear: the Complainant is required to prove both legs of the test on the balance of probabilities. If, and only if, the Respondent submits that the site is in fair use as a tribute or criticism site does the burden of proof shift to the Respondent to show that the Domain Name is not an abusive registration.

The Complainant's claim falls for consideration into the following categories defined by the Policy as factors which may be evidence that the Domain Name is an abusive registration:

1. That when the Respondent registered the Domain Name and adopted his e-mail address he knew that it would unfairly disrupt the Complainant's business contrary to §3a i C of the Policy.
2. That the Respondent is using the Domain Name in a way which has confused and continues to confuse people or businesses into believing that the Domain Name is registered to, operated or authorised by, or otherwise connected with the Complainant (§3a ii of the Policy).
3. That the Respondent has given false contact details to Nominet in contravention of §3a iv of the Policy.

In the Expert's opinion, although there is thread of suspicion running throughout this case regarding the Respondent's motives, the Complainant has not presented sufficient evidence to substantiate that the Respondent knew he would unfairly disrupt the Complainant's business when he registered the Domain Name.

However, the weight of evidence clearly shows that the Respondent's use of the Domain Name has confused and continues to confuse people or businesses into believing that they are sending e-mails to the Complainant. The Respondent claims that he cannot be held responsible for other people giving out incorrect e-mail addresses or confusing the Complainant's e-mail address with his. This does not justify the confusion that clearly arises from the Respondent's use of the Domain Name. The Expert concurs with the Complainant's citing of the Appeal Panel in DRS00389.

The Respondent registered the Domain Name as Jason McCluskey and has at some point chosen to use the name Bernard Matthews. Despite evidence that the Respondent does not keep his registration details up to date, this has not prevented Nominet from contacting him as Jason McCluskey at the given address. Furthermore, it has not been independently verified that the Respondent has given false contact details to Nominet in contravention of §3a iv of the Policy.

The Respondent's submission falls under the following categories defined by the Policy as factors which may be evidence that the Domain Name is not an abusive registration:

- That before being informed of the Complainant's dispute the Respondent has:
1. used or made demonstrable preparations to use the Domain Name in connection with a genuine offering of goods or services (§4a i A of the Policy);
 2. been commonly known by the name Bernard Matthews, a name identical to the Domain Name (§4a i B of the Policy);
 3. made legitimate non-commercial or fair use of the Domain Name (§4a i C of the Policy).

The Respondent's website as at 9th April 2003 does not present a genuine offering of goods or services. The Respondent presents no evidence that he has made preparations to use the Domain Name for a genuine offering of goods or services. An inspection of the website as at 28th June reveals the website now presents Bernard Matthews Property Maintenance which provides painting, tiling, bathroom and kitchen installation services and includes photography/restoration. The Expert considers that the Respondent's use of the website does not justify or excuse the confusion and disruption caused to the Complainant's business and it is unfair as the Complainant's name and mark is outside of its control, particularly with respect to e-mail.

The question then is whether the Respondent has been commonly known as Bernard Matthews prior to being informed of the Complaint and, if so, is this factor sufficient to mitigate the confusion caused to the Complainant's business? The Respondent has submitted evidence that he is Bernard Matthews and has been known by this name for 15 years due to his strong Norfolk accent. He states that Jason McCluskey is an "also known as". However, in the audio files he has submitted of his telephone calls he does not have a strong Norfolk accent. The Complainant has submitted evidence that Jason McCluskey and Bernard Matthews are the same person and that the Respondent was known as Jason McCluskey around the period 1997. The Respondent has on occasions held out, to Nominet and the Complainant, that Jason McCluskey and Bernard Matthews are different people.

Furthermore, the Respondent registered the Domain name as Jason McCluskey and did not inform Nominet of the change to Bernard Matthews until he was informed of this Complaint, when he stated that the change had taken place 3 years previously. It is the responsibility of the registrant of a domain name to provide Nominet with accurate contact details and to keep such details updated as per §2 of Nominet's terms and conditions of registration.

In the Expert's opinion the Respondent's claim to the name Bernard Matthews is insufficient to justify that his use of the Domain Name is not an abusive registration.

With regard to the out of court agreement, the expert agrees with the Complainant: the agreement has clearly lapsed, both parties have stated this intent.

Accordingly, the Expert finds that on the balance of probabilities the Domain Name is an Abusive Registration within the definition of that term in §1 of the Policy on the basis that the Respondent is using the Domain Name in a way which has confused people or businesses into believing that the Domain Name is registered to, operated or authorised by, or otherwise connected with the Complainant.

8. Decision

In light of the foregoing findings, namely that the Complainant has rights in respect of 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 directs that the Domain Name, bernardmatthews.co.uk, be transferred to the Complainant.



Signed: _____

Steve Ormand

Date: 29th June 2003