

# Dispute Resolution Service – Experts’ Overview

## Foreword by Tony Willoughby, Chair of the Panel of Experts

The purpose of this Overview is to assist all participants or would-be participants in disputes under the DRS Policy by explaining commonly raised issues and how Experts, the members of Nominet’s panel of independent adjudicators, have dealt with those issues to date. It also draws attention to areas where Experts’ views differ.

The Policy is intended to be an alternative to litigation. Complainants under the DRS Policy are rights owners (i.e. proprietors of rights enforceable by legal action). Litigation is expensive for both winners and losers and, in common with most responsible ccTLD registries, Nominet believes it appropriate that an efficient, cost-effective alternative dispute resolution policy should be in place to handle domain name disputes in its domain, the ‘.uk’ domain.

Disputes are decided by reference to the terms of the Policy, not the law, so the fact that a domain name registration and/or the registrant’s use of it may constitute trade mark infringement, for example, will not necessarily lead to a finding of Abusive Registration under the DRS Policy. Nonetheless, if the DRS Policy and the Law are too far apart, the DRS Policy will inevitably lose some of its value. Rights owners or domain name registrants (depending upon the nature of dispute) may prefer the expense of litigation to the likely result under the DRS Policy.

Accordingly, it is important that all concerned are aware of relevant legal developments and it is for this reason that in this Overview there are references to UK court decisions, most if not all of which are to be found in full text form on the Nominet web site.

While there is no system of precedent under the DRS Policy, for the DRS Policy to be effective there has to be a measure of consistency in the decisions and the panel of Experts does its best in that regard, although, as will be seen below, there are a few areas where differing views prevail. If anyone involved in a dispute under the DRS Policy proposes to rely upon the rationale of any previous DRS decision, the more recent decisions (whether at first instance or appeal level) are more likely to represent current thinking.

Finally, it should be stressed for the benefit of those who have had experience of domain name disputes under the Uniform Domain Name Dispute Resolution Policy (“UDRP”), that the DRS Policy and the UDRP are different systems. In some places they share very similar wording, but there are significant differences and the citation of UDRP decisions in a dispute under the DRS Policy is rarely likely to be helpful. Additionally, under the UDRP it is now common practice for panellists to make enquiries of their own by way of, for example, the WaybackMachine. This is not the practice of the DRS Experts. It is the responsibility of the parties to include within their submissions all evidence upon which they wish to rely.

This Overview is the product of deliberations among the panel of Experts over the last 12 months<sup>1</sup>.

**Tony Willoughby**

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<sup>1</sup> i.e. up to October 2009.

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## **1. Definitions**

### **1.1 (a) Who should the Complainant be? (b) When is it necessary or appropriate for there to be more than one Complainant?**

(a) The Complainant should be the owner/licensee of the Rights in the name or mark, which the Complainant contends is identical or similar to the domain name in dispute. Surprisingly often, complaints under the DRS Policy (“the Policy”) are lodged in the names of persons and entities not demonstrably the proprietor of the relevant Rights.

(b) For example, when the Rights relied upon are owned or shared by one entity but used by a group or associate company whose business is disrupted or confusingly connected with the Respondent. Another example could be in circumstances where the Rights relied on have been licensed and, depending on the facts, it may be desirable for both the Licensor and Licensee to be Complainants. If more than one Complainant is named, it is important that the Complaint nominates one of them as the transferee of the domain name in the event that the Complaint succeeds.

### **1.2 Does renewal of a registration by the existing registrant count as “registered or otherwise acquired” in the definition of Abusive Registration [paragraph 1 of the Nominet DRS Policy (“the Policy”)]?**

No. While arguably it constitutes a re-registration, an innocent registrant could be deprived of his domain name, simply because, by the time that the registration comes up for renewal, he has been given notice of a rights owner’s rights, rights which may post-date the original registration. This is not what the Policy was intended to cover.

For the avoidance of doubt, the term “otherwise acquired” covers acquisition of a domain name otherwise than by way of registration e.g. typically transfer of ownership by way of sale or gift.

### **1.3 Can a threatened abusive use constitute use within subparagraph (ii) of the definition of Abusive Registration if the domain name has NOT in fact been used in any ordinary sense (e.g. as part of a URL or email address)?**

Yes. Paragraph 3 of the Policy (Evidence of Abusive Registration) in sub-paragraph (a)(ii) expressly provides that evidence of a threatened use may constitute evidence of an abusive use

### **1.4 Does the definition of Rights in paragraph 1 of the Policy embrace rights other than trade mark and service mark rights?**

Yes, although in the vast majority of cases to date the relevant rights relied upon have been trade mark rights or service mark rights (whether registered or unregistered). In relation to trade mark rights, it is worth noting that rights in a logo or device mark may not equate to trade mark rights in respect of any words featured in the logo/device; much will depend upon the nature of the words in question and their prominence.

### **1.5 Can an overseas right constitute a relevant right within the definition of Rights?**

Yes. The rights must be enforceable rights, but there is no geographical/jurisdictional restriction. If the Upper Volta Gas Board can demonstrate rights in respect of its name enforceable in Upper Volta, the Policy is broad enough to deal with a cybersquatter, for example, registering

<uppervoltgasboard.co.uk>. If it was otherwise, the '.uk' domain would be likely to become a haven for cybersquatters.

#### **1.6 Can a contractual right constitute a right within the definition of Rights?**

Yes it can. A specific example of this is given in the Policy at paragraph 3(a)(v). However where the right is disputed and/or the surrounding circumstances are particularly complex, the complaint may nevertheless be rejected as not being appropriate for adjudication under the Policy. See the Appeal decision in DRS 04632 (ireland.co.uk), which was just such a case. This decision reviews all the previous DRS cases involving contractual rights.

#### **1.7 Can a company name registration (per se) give rise to a right within the definition of Rights?**

There are decisions going both ways (qv DRS 00228 (activewebsolution.co.uk) and DRS 04001 (generaldynamics.co.uk)). The issue is this: does the mere fact that under the Companies Acts (section 28(2) of the Companies Act 1985 and sections 66 and 67 of the Companies Act 2006) the Secretary of State can direct NewCo to change its name because it is the same as, or 'too like', OldCo's name mean that OldCo enjoys 'rights enforceable under English law' and/or 'Rights' within the full meaning of the Policy?

The consensus view of recent Experts' meetings has been that mere registration of a company name at the Companies Registry does not of itself give rise to any rights for this purpose.

#### **1.8 Can rights in a personal name give rise to a right within the definition of Rights?**

Yes. If the personal name in question is a trade mark (registered or unregistered), clearly that name is the subject of an enforceable right. If on the other hand, the name in question is not the name under and by reference to which the complainant conducts a trade or business, the position is not so clear. In DRS 00693 (tahirmohsan.co.uk), the Expert held that it was sufficient that the Complainant's name was identical to the domain name and that his name was uncommon in the United Kingdom, but it is by no means certain that all Experts will adopt that approach. Complainants seeking to assert rights in respect of personal names need to be able to establish that there is an enforceable right in respect of the name.

#### **1.9 Can the mere existence of a trade mark application give rise to a right within the definition of Rights?**

No. The validity of a trade mark application has not yet been determined and ordinarily it affords the proprietor no legal right to prevent others from using the mark. In and of itself an application will not constitute 'Rights' under the Policy. Of course in some cases an applicant for a trade mark will also have separate parallel unregistered rights in the mark in question and may be able to show Rights in this way.

It is the case that in certain circumstances and in certain jurisdictions, trade mark applications may form the basis for legal claims of one kind or another, but insofar as the Policy is concerned the majority view among Experts is as set out in the previous paragraph.

#### **1.10 Does the definition of Rights embrace unenforceable rights?**

No. The wording of the previous version of the Policy was ambiguous. The wording of the current version is clear.

## **2. The Essential Elements to be proved in a Complaint**

### **2.1 What is the required Standard of Proof?**

Paragraph 2(a) of the DRS Policy sets out what a Complainant needs to prove in a proceeding under the DRS Policy. Paragraph 2(b) provides that the Complainant must prove that the requisite elements are present on the balance of probabilities. This is the normal standard of proof required in civil court Proceedings and is also variously referred to as “more probable than not” and “on the preponderance of the evidence”. It is to be contrasted with the criminal standard of “beyond all reasonable doubt”.

However there are cases in which a party makes very serious allegations about the opposing party. The more serious the allegation, the more that the Expert will be looking for in the way of evidence to support the allegation. See DRS 07599 [chiesi.co.uk](http://chiesi.co.uk) in which the Complainant was effectively alleging fraud against the Respondent and the Expert was looking for evidence of the alleged fraud to the criminal standard of proof. He said that “such an approach is entirely consistent with the standard of proof required by paragraph 2 of the DRS Policy. It is simply a recognition of the fact that the more serious an allegation, the less likely it is that it occurred and accordingly the stronger the evidence required to prove it on the balance of probabilities: See e.g. per Lord Nicholls in *re Hand and Others* [1996] AC586”

### **2.2 What is required for a Complainant to prove that he/she/it “has rights” in paragraph 2(a)(i) of the Policy?**

As indicated above, the relevant right has to be an enforceable right (i.e. a legally enforceable right). Bare assertions will rarely suffice. The Expert needs to be persuaded on the balance of probabilities that relevant rights exist. The Expert will not expect the same volume of evidence as might be required by a court to establish goodwill or reputation, but the less straightforward the claim, the more evidence the better (within reason – this is not an invitation to throw in the ‘kitchen sink’).

If the right arises out of a trade mark or service mark registration, a copy of the registration certificate or print out from the registry database will suffice together with, in the case of a licensee, evidence of the licence. If the Complainant can demonstrate that it is a subsidiary or associated company of the registered proprietor, the relevant licence, if asserted, will ordinarily be assumed. [Appeal decision in DRS 00248 ([seiko-shop.co.uk](http://seiko-shop.co.uk))].

If the right is an unregistered trade mark right, evidence needs to be put before the Expert to demonstrate the existence of the right. This will ordinarily include evidence to show that (a) the Complainant has used the name or mark in question for a not insignificant period and to a not insignificant degree (e.g. by way of sales figures, company accounts etc) and (b) the name or mark in question is recognised by the purchasing trade/public as indicating the goods or services of the Complainant (e.g. by way of advertisements and advertising and promotional expenditure, correspondence/orders/invoices from third parties and third party editorial matter such as press cuttings and search engine results).

If the right is a contractual right, the Expert will need to see evidence of the contract.

### **2.3 What is meant by “identical or similar” in paragraph 2(a)(i) of the Policy?**

Those responsible for the drafting of the Policy were aware of some of the difficulties arising under the UDRP (the policy covering disputes in the gTLDs) as a result of its wording, “identical or confusingly similar”. The wording of the Policy is broader and less restrictive, which matches the reality that the first hurdle (i.e. proving the existence of rights in a relevant name or mark) is intended to be a relatively low-level test. Issues relating to confusion are best addressed under the second hurdle. The objective behind the first hurdle is simply to demonstrate a *bona fide* basis for making the complaint.

For the purposes of the first hurdle, nothing turns on the distinction between “identical” and “similar”, but a name or mark will ordinarily be regarded as identical to the domain name if, at the third level, and ignoring the presence of hyphens and the absence of spaces and ampersands, they are the same. However, because nothing turns on the distinction, Experts will usually not bother to draw a distinction and will merely find that the Complainant’s name or mark is “identical or similar” to the domain name in issue. See, for example, DRS 04478 (bandq.co.uk). Mis-spelled versions of names are normally found to be similar to their originals. Additional elements rarely trouble experts. For example, in DRS 06973 veluxblind.co.uk the expert commented “The Domain Name consists of the Complainant’s distinctive trademark and the descriptive word “blind”, which does nothing to distinguish the Domain Name from the mark, since the mark is associated in the public mind with the Complainant’s blinds.”

If the name or mark in which the Complainant claims rights is a word mark, the task for the Expert is reasonably straightforward. The task may be more difficult where the name or mark is in logo form. If the Complainant’s mark is a logo, the Complaint should acknowledge the fact and address the point (i.e. explain why the logo and the domain name should be treated as similar).

#### **2.4 The definition of Abusive Registration in paragraph 1 of the Policy is broad and leaves scope for subjective assessment as to what is and what is not unfair. Are there any guiding principles?**

The best guide as to what does constitute an Abusive Registration is to be found in section 3(a) of the Policy (see below) and the best guide as to what does not constitute an Abusive Registration is to be found in section 4 of the Policy (see below).

Both of those ‘guides’ comprise non-exhaustive lists and it will be seen that Experts have a broad discretion when it comes to determining abusiveness. The question of whether a Domain Name is an Abusive Registration is a multi-factorial assessment which affords some flexibility to Experts, enabling them to keep pace with the fast moving world of the Internet. What was once thought to be unfair may in time be regarded as fair and vice versa.

The body of expert decisions under the Policy is developing and certain principles are emerging. The section of the Appeal decision in DRS 04331 (verbatim.co.uk) dealing with ‘knowledge’ and ‘intent’ sets out one panel’s views on that topic. However, new domainer practices (e.g. automated bulk transfers of domain names) are becoming commonplace and to the extent that the *Verbatim* decision suggests that for a finding of Abusive Registration, the Respondent must have had knowledge of the Complainant and/or its Rights at the relevant time, it is now thought by some Experts that that might overstate the position.

A particular area of current debate among the panel of Experts is the extent to which the concepts of unfair advantage and unfair detriment as set out in the definition of Abusive Registration [paragraph 1 of the Policy] embrace a subjective element. The members of the

Appeal panel in the *Verbatim* case took the view that for a registration to be labelled “Abusive” there had to be something morally reprehensible about the Respondent’s behaviour, a view more recently adopted in DRS 07066 ([whistleblower.co.uk](http://whistleblower.co.uk)). Others have expressed the view that what is or is not fair can be judged wholly objectively and that to gain or cause damage by way of trade mark infringement is necessarily unfair irrespective of the motives of the Respondent.

To date this divergence of view has emerged primarily in the cases where the Complainant’s trade mark rights have post-dated registration of the domain name - a very small proportion of the overall body of cases.

### **3. Evidence of Abusive Registration**

#### **3.1 The list of factors in paragraph 3(a) of the Policy is expressed to be non-exhaustive. Are there any limitations?**

Paragraph 3(a) of the Policy constitutes a guide. The only limiting factor is the definition of Abusive Registration in Paragraph 1 of the Policy.

#### **3.2 The circumstances set out in paragraphs 3(a)(i) all concern the registrant’s motives at time of registration of the domain name. Can a subsequent intention (i.e. formed after registration of the domain name) to sell the domain name to the Complainant at a profit or to unfairly disrupt the Complainant’s business constitute an abusive use within the meaning of subparagraph ii of the definition of Abusive Registration in paragraph 1 of the Policy?**

Deciding to sell a domain name at a profit is unlikely of itself to constitute an abusive intent, unless this was the registrant’s intent at time of registration of the domain name and the circumstances set out in paragraph 3(i)A of the Policy apply. Trading in domain names is of itself unobjectionable (see paragraph 4(d) of the Policy).

Unfair disruption of the Complainant’s business by way of a domain name is very likely to constitute an abusive use of the domain name (DRS 02223 [itunes.co.uk](http://itunes.co.uk)). Similarly, a threat to unfairly disrupt the Complainant’s business by such a means is also likely to constitute an abusive use of the domain name (cf. the wording “is using or threatening to use the domain name ...” in paragraph 3(a)(ii) of the Policy).

#### **3.3 Paragraph 3(a)(ii) concerns confusing use of the domain name. What is meant by confusing use?**

The ‘confusion’ referred to in this paragraph of the Policy is confusion as to the identity of the person/entity behind the domain name. Will an Internet user seeing the domain name or the site to which it is connected believe or be likely to believe that “the domain name is registered to, operated or authorised by, or otherwise connected with the Complainant”?

In the case of *BT v One In A Million* [1999] 1 WLR 903, the Court of Appeal cited, as one example of how confusion of this kind could occur, the making of a Whois search of the registry/registrar database. The enquirer conducts such a search and because of the similarity of the domain name to the well-known trade mark (the case was concerned solely with well-known trade marks), assumes that the registrant is in some way associated with the trade mark owner. Whether or not this is still (if it ever was) a likely scenario, the English Courts have clearly held that mere registration of a domain name can constitute unfair use of a domain name for the purposes of

passing off and trade mark infringement, even if nothing more is done with the domain name. The prevailing approach under the DRS is consistent with this.

Commonly, Internet users will visit web sites either by way of search engines or by guessing the relevant URL. If the domain name in dispute is identical to the name of the Complainant and that name cannot sensibly refer to anyone else, there is bound to be a severe risk that a search engine, which is being asked for the Complainant, will produce high up on its list the URL for the web site connected to the domain name in issue. Similarly, there is bound to be a severe risk that an Internet user guessing the URL for the Complainant's web site will use the domain name for that purpose.

In such cases, the speculative visitor to the registrant's web site will be visiting it in the hope and expectation that the web site is a web site "operated or authorised by, or otherwise connected with the Complainant." This is what is known as 'initial interest confusion' and the overwhelming majority of Experts view it as a possible basis for a finding of Abusive Registration, the vice being that even if it is immediately apparent to the visitor to the web site that the site is not in any way connected with the Complainant, the visitor has been deceived. Having drawn the visitor to the site, the visitor may well be faced with an unauthorised tribute or criticism site (usually the latter) devoted to the Complainant; or a commercial web site, which may or may not advertise goods or services similar to those produced by the Complainant. Either way, the visitor will have been sucked in/deceived by the domain name.

Findings of Abusive Registration in this context are most likely to be made where the domain name in issue is identical to the name or mark of the Complainant and without any adornment (other than the generic domain suffix). See for example DRS 00658 (chivasbrothers.co.uk).

The further away the domain name is from the Complainant's name or mark, the less likely a finding of Abusive Registration. However, the activities of typosquatters are generally condemned - see for example DRS 03806 (privilege.co.uk) - as are those people who attach as appendages to the Complainant's name or mark a word appropriate to the Complainant's field of activity. See for example the Appeal decision in DRS 00248 (seiko-shop.co.uk).

Another potential for confusion (frequently overlooked) is the use of a domain name for the purposes of email. There are many examples of registrants of domain names receiving email traffic intended for the Complainant. See for example Global Projects Management Ltd v Citigroup Inc. (citigroup.co.uk) [2005] EWHC 2663 Ch., and DRS 0114 (penquin.co.uk). Whether evidence of this occurring will lead to a finding of Abusive Registration will, of course, depend to a large extent on the nature of the domain name and the circumstances of its use. If, at the third level, it is a name which is lawfully in use by a number of people (e.g. a surname), the resultant confusion may just be a hazard which the Complainant will have to accept.

### **3.4 Paragraph 3(a)(ii) concerns confusing use of the domain name. What is required in the way of proof?**

Whatever is enough to satisfy the Expert on the balance of probabilities. That is to say, the Expert must be able to conclude that it is more likely than not. Much depends upon the clarity of the case. If one is contending that there is evidence available to demonstrate that actual confusion has taken place, the Expert will expect to see that evidence. If the contention is that confusion is likely to occur, an explanation should be given as to how that confusion is likely to arise.

### **3.5 What is meant by “pattern” in paragraph 3(a)(iii) of the Policy? What is meant by “and the domain name is part of that pattern” in the same subparagraph?**

The purpose behind this paragraph is to simplify matters for a Complainant, where the only available evidence against the registrant is that he is a habitual registrant of domain names featuring the names or marks of others. However, there is a divergence of view among Experts as to what constitutes a pattern for this purpose.

One view, as expressed by the Appeal Panel in DRS 04884 (maestro.co.uk), is that the mere fact that a registrant has some objectionable domain names in his portfolio cannot of itself be enough to render the domain name in issue an Abusive Registration. To get the benefit of this provision, the Complainant must show that the domain name in issue is part of a conscious policy on the part of the registrant. There must be evidence to justify the linking of the domain name in issue to the other objectionable domain names. The link may be found in the names themselves and/or in the dates of registration, for example.

The contrary view is that the pattern does not need to result from any conscious policy on the part of the Respondent. If the domain name in issue is a well-known name or mark of the Complainant and the Respondent is the proprietor of other domain names featuring the well-known names or marks of others, the pattern is likely to be established, even if there is no obvious link between the names or the manner or their dates of registration.

In practice this difference of view is unlikely to have much of an impact. If the domain name in issue is a well-known trade mark of the Complainant and there is no obvious justification for the Respondent being in possession of the domain name, it is probable that the Complaint will succeed on other grounds.

### **3.6 What is required for independent verification under paragraph 3(a)(iv) of the Policy?**

Delivery service or post office certification will certainly suffice, but it is not necessary to obtain formal verification. An authoritative letter, email or note from a third party explaining how the contact details are known to be false will usually suffice.

### **3.7 What is the purpose behind paragraph 3(b) of the Policy?**

In the early days of the UDRP, many decisions were issued to the effect that non-use of a domain name was of itself evidence of bad faith under the UDRP.

In certain circumstances, evidence of non-use of a ‘.uk’ domain name may persuade an Expert that the domain name in issue is an Abusive Registration, but Nominet was concerned to ensure that non-use of a domain name should not automatically be regarded as indicative of abusive intent.

### **3.8 How does a Complainant prove that the Respondent has been found to have made an Abusive Registration in three or more DRS cases in the two years before the Complaint was filed for the purposes of paragraph 3(c) of the Policy?**

Nominet publishes a "3 Cases Respondent Table" listing those Respondents who have been found to have made an Abusive Registration in three or more DRS cases. The Expert will decide in any new decision whether the listed cases occurred within the relevant two year period. A decision overturned on appeal will not count against a Respondent. Experts may also take into account

findings of bad faith registrations under the UDRP against the same Respondent although they will not give rise to any presumption of an Abusive Registration.

#### **4. Evidence that a domain name is not an Abusive Registration**

##### **4.1 Paragraph 2(b) of the Policy requires the Complainant to prove the requisite elements of the complaint. Paragraph 4 comprises a list of the evidence a Respondent may choose to submit. Why should the Respondent have to prove anything?**

The Respondent does not have to prove anything. However, it should not be overlooked that the obligation upon the Complainant is not to prove his case beyond all reasonable doubt, but to do so on the balance of probabilities. Accordingly, if the Respondent does not respond to the Complainant's allegations and the Expert takes the view that the Complaint sets out a convincing prima facie case, the Complaint is likely to succeed. To put it another way, if the Complainant has satisfied the Expert that the Respondent has a case to answer, the Expert will be looking for an answer. The safest course for a Respondent is to file a Response.

Paragraph 4 simply sets out the matters, which, if established to the satisfaction of the Expert, are likely to be regarded as a satisfactory answer to the Complainant's case.

##### **4.2 What is meant by “before being aware of the Complainant’s cause for complaint” in paragraph 4(a)(i) of the Policy?**

The circumstances set out in paragraph 4(a)(i) of the Policy are only likely to constitute satisfactory answers to the Complaint if they commenced when the Respondent was unaware of the Complainant's name or mark forming the basis for the Complaint. Matters which only arise after the Respondent has become aware of the Complainant's name or mark forming the basis for the Complaint are more likely to have been contrived for the purpose of defending an apprehended Complaint or legal action.

##### **4.3 What is required in the way of evidence to demonstrate “preparations to use” in paragraph 4(a)(i)A of the Policy?**

Most abusive registrants do not respond to complaints, but those who do will commonly assert the existence of plans, which are designed to defeat the complaint. Experts will generally view purported 'plans' which are totally unsupported by any contemporaneous evidence with a heavy measure of scepticism.

Accordingly, if the registrant has genuine plans for the domain name, arrived at wholly without reference to the rights of the Complainant, it makes sense for the registrant to produce evidence to show that they are genuine and were not dreamt up simply to defeat the complaint. The more straightforward the registrant's case, the less that the Expert is likely to need in the way of supporting evidence. However, any evidence produced should sensibly include evidence pre-dating the registrant's awareness of the Complainant's rights. Failing that, the evidence may not be worth a lot, but a credible explanation for the absence of any such evidence may assist.

The usual evidence will comprise correspondence with third parties (banks, lawyers, partners etc) in which the plans are identified.

##### **4.4 When is an “offering of goods or services” NOT “genuine” [paragraph 4(a)(i)A of the Policy]?**

When it is fictitious and/or 'created' to defeat the complaint and/or designed to take unfair advantage of or damage the Complainant's rights/business.

**4.5 If a Respondent can demonstrate that it has at one time been "legitimately connected with a mark which is identical or similar to the domain name" under paragraph 4(a)(i)B, will that be enough to defeat the complaint?**

Not necessarily. Note the word 'may' in the first line of paragraph 4(a) of the Policy. That fact may or may not be sufficient to defeat a complaint based upon the Respondent's intent at time of registration of the domain name in issue, but if the complaint is based upon an abusive use of the domain name, the fact that the Respondent was at one time known by the name may have no bearing at all on whether or not the complaint should succeed.

Even in relation to a complaint based upon the Respondent's intent at time of registration of the domain name in issue, if, for example, there has been a significant time lapse since the Respondent was commonly known by the name in question, the Respondent's justification for having adopted the domain name may be in doubt.

**4.6 Do the cases provide any guidance as to what is meant by "legitimate non-commercial or fair use of the domain name"? [Paragraph 4(a)(i)C of the Policy.]**

The meaning of 'non-commercial' is clear, but the terms 'legitimate' use and 'fair' use leave significant scope for subjective assessment on the part of the Expert. By and large the cases demonstrate the breadth of that scope.

However, in reality, this paragraph of the Policy adds little to the definition of Abusive Registration in paragraph 1 of the Policy.

The key issue is not whether the use in question is 'legitimate non-commercial or fair' but whether that use (commercial or non-commercial) has "taken unfair advantage of or has been unfairly detrimental to the Complainant's Rights". [Appeal decision in DRS 00248 (seiko-shop.co.uk - paragraph 8.1).

**4.7 Is it possible for a Respondent to make fair use of a domain name where (a) that name is also the Complainant's trade mark and (b) the Respondent's use of the domain name is causing confusion?**

Yes. While, ordinarily, a confusing use of such a domain name will be regarded as unfair, it may not be regarded as unfair where, for example, the Respondent's registration and use of the domain name predates the Complainant's rights, the Respondent has not changed his use of the domain name to take advantage of the Complainant's rights and the Respondent's behaviour has been unobjectionable. Decisions involving domain name registrations pre-dating the Complainant's rights are DRS 02223 (itunes.co.uk), the decision and Appeal decision in DRS 04962 (myspace.co.uk), the decision and Appeal decision in DRS 05856 (t-home.co.uk) and the decision and Appeal decision in DRS 06365 (oasis.co.uk). The final decisions in all but the first of those cases went in favour of the Respondents.

The principles to be derived from those decisions, each of which differed on their facts, are as follows:

1. Where the domain name registration pre-dates the coming into existence of the Complainant's rights, the act of registration is unlikely to lead to a finding of Abusive

Registration. It is not possible to be categorical on this point, because it is not inconceivable that a finding of Abusive Registration could result in circumstances where the Respondent effected the registration in breach of an obligation of confidence and with knowledge of the Complainant's plans.

2. Ordinarily, provided that the Respondent has done nothing new following the coming into existence of the Complainant's rights to take advantage of those rights, the Respondent's use of the domain name is unlikely to lead to a finding of Abusive Registration.
3. However, where the domain name is connected to a parking page operated on behalf of the Respondent by a third party (eg a hosting company), the Respondent is unlikely to be able to escape responsibility for the behaviour that third party.

An as yet unresolved issue is where the dividing line lies between fair confusing use and unfair confusing use.

Another use, which may not be regarded as unfair within the terms of the DRS Policy, is where the Complainant's name or mark is a dictionary word or a combination of dictionary words and not well-known and the Respondent reasonably registered and has been using the domain name in ignorance of the Complainant's rights. In such circumstances, if the confusion is likely to be very limited, an Expert might conclude that it would be unjust to deprive the Respondent of his domain name. [The Appeal decision in DRS 04889 (wiseinsurance.co.uk)]. However, there is a view among some Experts (albeit a minority) that a confusing use which is likely to constitute trade mark infringement cannot be anything other than unfair.

#### **4.8 Do tribute and criticism sites necessarily constitute fair use unless proved otherwise? [Paragraph 4(b) of the Policy]**

No. Paragraph 4(b) of the Policy provides that "Fair use may include sites operated solely in tribute to or in criticism of a person or business". Note the use of the words "may" and "solely"—it will depend on the facts. If, for example, commercial activity beyond that normally associated with a bona fide fan site takes place, the registration may be abusive. See the Appeal decision in DRS 00389 (scoobydoo.co.uk). Note also that the use of the word "may" means that even if a site is operated solely as a tribute or criticism site it is still open to the Expert to find that it is abusive. In assessing the fairness or otherwise of the use, the Expert needs to have regard to both the nature of the domain name in dispute and its use. Some decisions in the past have concentrated solely upon whether the site fairly pays tribute to or criticises the Complainant (often a very difficult thing for an expert to assess in a proceeding of this kind).

The appeal decision in DRS 06284 (rayden-engineering.co.uk) confirmed the consensus view among experts today that the nature of the domain name is crucial to the exercise. A criticism site linked to a domain name such as <IhateComplainant.co.uk> has a much better chance of being regarded as fair use of the domain name than one connected to <Complainant.co.uk>. The former flags up clearly what the visitor is likely to find at the site, whereas the latter is likely to be believed to be a domain name of or authorised by the Complainant.

In DRS 06284 the domain name was identical to the name in which the Complainant had rights. A modified name that made it clear that this was a protest site would presumably have been less successful in drawing the protest to the attention of customers of the Complainant. The Panel

concluded there was a balance to be drawn between the right to protest (which could be effected via a modified name) and the Complainant's rights in its own name, and that in this case at least the latter outweighed the former. Note that the Panel did not rule that use of an identical name would always and automatically be unfair, but did conclude that it was only in exceptional circumstances that such use could be fair. The Panel declined to find that such exceptional circumstances existed in the case in question.

#### **4.9 Can use of a purely generic or descriptive term be abusive?**

Yes but, depending on the facts, the threshold level of evidence needed to establish that this is the case is likely to be much higher. It may well often depend upon the extent to which such a term has acquired a secondary meaning, which increases the likelihood that any registration was made with knowledge of the rights that existed in the term in question. In many such cases where there is little or no evidence of acquired secondary meaning the Respondent is likely to be able to show that the domain name in question has been arrived at independently and accordingly cannot have been as a result of an Abusive Registration. A helpful discussion is found in DRS 04884 (maestro.co.uk) where the Appeal Panel observed "Where a domain name is a single ordinary English word, the meaning of which has not been displaced by an overwhelming secondary meaning, the evidence of abuse will have to be very persuasive, if it is to be held to be an Abusive Registration under the DRS Policy".

### **5. Procedural Issues/Questions**

#### **5.1 When a dispute has passed through the mediation stage without resolution, how much is the Expert told of what happened in the mediation process?**

Nothing. All that the Expert is told is that the mediation failed to resolve the dispute. None of the papers generated for and/or within the mediation are given to the Expert

#### **5.2 Why does the without prejudice rule not generally apply to proceedings under the Policy? [Paragraph 6 of the Policy]**

Whether or not the without prejudice rule is to apply in the context of any particular case is an issue for the Expert to decide. The reason why the rule is generally thought to be inappropriate for proceedings under the Policy is dealt with at some length in the Appeal Decision in DRS 00389 (scoobydoo.co.uk).

#### **5.3 What is a repeat or re-filed complaint? [Paragraph 10 of the Policy].**

A second or subsequent complaint lodged under the Policy by the same Complainant against the same Respondent in respect of the same domain name. These are discouraged and only permitted in very exceptional circumstances. If a Complainant is unhappy with a decision, ordinarily the appropriate step for the Complainant to take is to appeal the decision, not seek to have a second bite of the cherry. Whether or not a Complaint is a repeat or re-filed Complaint is a matter for the Expert.

Decisions dealing with this issue are DRS 01136 (1and1.co.uk) and the Appeal Decision in DRS 01295 (bravissimo.co.uk), the reasoning in which led to paragraphs 10.f and 10.g of the current Policy.

#### **5.4 What constitutes due service of a document under the Policy? [Paragraph 2 of the Procedure]**

Paragraph 2 of the Procedure deals with communications in the course of a proceeding under the Policy.

The issue which most commonly arises in this context is whether Nominet has properly served the complaint on a Respondent who has failed to respond.

Nominet's practice is to post, by Special Delivery, the complaint to the postal address provided by the Respondent for the Whois database and, if the Respondent is a limited company, to the Respondent's registered office. In addition, Nominet commonly faxes the complaint to any fax number provided by the Respondent for the Whois database and emails the complaint to any email address provided by the Respondent for the Whois database. On top of all that Nominet will normally also email the complaint to <postmaster@[domain name]> (see the Appeal Decision in DRS 05861 (greengiant.co.uk)) and, where practicable, any email address appearing on a web site connected to the domain name.

However, that is more than is necessary. The sending of the complaint to any one of the addresses provided by the Respondent for the Whois database will suffice for the purposes of Paragraph 2.a. and 2.e. of the Procedure.

All domain name registrants are under an obligation to keep Nominet notified of their up-to-date contact details. Indeed it is a ground of Abusive Registration for a Respondent to give false contact details to Nominet (Policy paragraph 3(a)(iv)). Accordingly Experts cannot be expected to, and will not ordinarily, concern themselves with issues of effective service. Experts are only concerned to see that Nominet has complied with the terms of Paragraph 2 of the Procedure.

#### **5.5 What is the consequence of a party's submission exceeding a word limit?**

Paragraph 3 of the Procedure deals with the complaint, the substance of which must not exceed 5000 words. Nominet will check the complaint for compliance when it is lodged by the Complainant and, if it is not compliant, will return it to the Complainant to be rendered compliant [Paragraph 4.b. of the Procedure]. It remains to be seen what will happen if a non-compliant complaint slips through the Nominet net. For an indication of some of the possibilities, see what occurred in proceedings under the UDRP in WIPO Cases D2007-1816 (tristan.com) and D2008-0268 (stas.com). Online submission and electronic word count should prevent this ever happening.

Annexes should not be used to circumvent the 5000 word limit. Annexes or Appendices to the Complaint should contain documentary evidence and not further submissions or argument.

There are no equivalent provisions in the Procedure covering non-compliant responses and replies, but Nominet's practice is to check these documents for compliance and when the defects are noticed the documents are returned to the sender for rectification.

#### **5.6 If the Respondent fails to respond to the complaint, is it inevitable that the complaint will succeed?**

No. Whether the Complainant seeks a full decision or a summary decision, it is still necessary for the Expert to be satisfied that the elements necessary to make a finding of Abusive Registration are present. See, for example, the decision in DRS 04635 (martinyale.co.uk), a case where, in spite of the lack of a response, the Complainant failed to establish Abusive Registration to the satisfaction of the Expert. The case was decided under the previous version of the Policy, but the essential criteria remain the same.

## **5.7 How can Nominet be certain as to the impartiality and independence of the Experts?**

The Experts sign a declaration to that effect each time they accept an invitation to adjudicate a dispute. The normal practice of those of the Experts who are legal practitioners is to conduct conflict checks around their firms. Experts are encouraged to err on the side of caution. This is taken seriously and Experts routinely decline to provide a Decision in circumstances where their doing so might give rise to an appearance of partiality.

To date, very few allegations of partiality have been levelled at Experts. None of those allegations has been adjudged to have any substance.

## **5.8 By what criteria would an Expert grant a request for an extension of time?**

Extensions of time are rare and will be granted only very sparingly. An Expert will approach such a request having regard to all the circumstances of the case (12a of the Procedure). The discretion lies with the Expert. Typically, if the request is likely to cause undue delay to the process, it is unlikely to be granted. If the request is felt to be no more than a delaying tactic, it is unlikely to be granted. If, on the other hand, the Expert believes it necessary to ensure that all the necessary facts are before the Expert to enable the Expert to come to a suitably informed decision, it is likely to be granted, provided that it does not cause undue prejudice to the other party.

Nominet frequently grants extension of time in mediation where both parties consent to it.

## **5.9 How do Experts approach the question of further statements from the parties?**

The Procedure is intended to provide a satisfactory basis for expeditious and cost-effective resolution of domain name disputes within the ambit of the Policy. Unsolicited further statements from the parties tend to run counter to that intention. If one party is permitted to submit a further statement, the Expert will normally, in the interests of justice, permit an answering submission from the other party. The case gets weighed down with paper and delays ensue. Experts will normally require an explanation from the party wishing to submit an additional submission, justifying a departure from the prescribed procedure.

On occasion, Experts will decide that in order to come to a just decision, they need further information from one or other or both of the parties. In such circumstances a request will be issued by the Expert for further information pursuant to Paragraph 13.a. of the Procedure. However, this power will be exercised with caution. Not only does it risk prolonging the proceeding, it can also effectively allow one party to improve its case to the prejudice of the other party. If parties get the idea that they can simply improve their cases as the proceeding progresses, there will be no incentive upon them to adhere to the Procedure and put their best case forward first time around.

## **5.10 Paragraph 16(a) of the Procedure provides that “the Expert will decide a complaint on the basis of the Parties’ submissions, the Policy and the Procedure” but then goes on to say that the Expert may in addition “look at any web sites referred to in the Parties’ submissions”. To what extent are the Experts permitted to make their own investigations?**

The basic rule is that Experts should not make any investigations of their own. They should make their decisions “on the basis of the parties’ submissions, the Policy and the Procedure”. The second sentence of paragraph 16(a) enables Experts to view web sites mentioned in the parties’

submissions, but no party should assume that the Expert will necessarily do so. If the content of a web site is important to a Party's case, the safest course is to exhibit print-outs from the web site.

No party should assume that the Expert will make any investigations to support a bare assertion made in a party's submission. However, there may be occasions where an Expert will find it expedient to conduct a simple online enquiry of a publicly available database, where, for example, an exhibit purporting to support a party's contention does not do so and it appears that the 'error' is a simple oversight and not one of any major significance. In such circumstances, a simple enquiry of that kind may be a proportionate alternative to either ignoring a point made in the submission in question or initiating a further round of submissions by way of requests for further information. See DRS 00658 ([chivasbrothers.co.uk](http://chivasbrothers.co.uk)). If, however, an Expert comes by material information as a result of any such enquiry (or indeed by any other means) and proposes to rely upon it in coming to a decision, the Expert will so inform the parties and invite them to make submissions as appropriate.

#### **5.11 When adjudicating disputes, do Experts allow greater room for manoeuvre to unrepresented parties?**

While there may be occasions when this is appropriate, the general rule is that parties will be treated equally whoever they are and whether or not they are represented. It is for this reason that Nominet has gone to considerable trouble to include on its web site a very high level of information and guidance to persons wishing to launch or defend against a complaint under the Policy. Parties engaged in a dispute under the Policy would do well to study carefully the advice to be found on the Nominet web site.

#### **5.12 What is a Chairman's letter?**

This is a letter sent out by Nominet in the name of the Chairman of Experts, when Nominet receives a submission from a party, which by reason of its brevity or lack of supporting evidence (i.e. exhibits), is thought might possibly be unfit for purpose. The person responsible for the submission is invited to reconsider. For an example of a Chairman's letter, see the decision in DRS 04635 ([martinyale.co.uk](http://martinyale.co.uk)).

#### **5.13 Summary Decisions**

Summary decisions are what they purport to be, namely short sharp decisions made in default of a Response. All that the Expert is required to do is to satisfy himself/herself on the basis of the Complaint, that the Complainant has relevant rights and that the domain name in the hands of the Respondent is an Abusive Registration. The fee is much reduced because the Expert is not required to spend the time providing a reasoned decision.

Nominet has received adverse comment from some sections of the Internet community complaining that it is not always apparent why a Complaint has succeeded by way of the summary process and Experts ought to enter a brief form of reasoning in the comment section.

The comment section is rarely used. If used at all, it is likely to be to explain to a losing Complainant why the Complaint has failed. [See DRS 06473 ([goweb.co.uk](http://goweb.co.uk)).] Having paid a fee and lost, it would not be unreasonable for the Complainant to want to know why.

However, as a general rule, the view of the Experts is that short-form reasoning would be likely to raise more questions than it answers.

#### **5.14 Respondent's consent to transfer**

Occasionally, following the filing of the Complaint, but before the case papers have been passed to an Expert for decision, the Respondent informs the Complainant (and/or Nominet) that he is willing to transfer the domain name to the Complainant without charge. If the Complainant agrees to accept the domain name on that basis, there is a procedure whereby Nominet can process the transfer. If, however, the Complainant insists on a decision and pays the prescribed fee, the papers will be sent to an Expert for a decision.