

Nominet UK Dispute Resolution Service

DRS 0442

1&1 Internet Limited -v- SSL

Decision of Independent Expert

1. Parties:

The Complainant is 1&1 Internet Limited of Pegasus Court, 25-26 Herschel Street, Slough, Berkshire L1 1PA.

The Respondent is SSL Webmaster of Vaerebrovej 98-5, 2860 Bagsvaerd, Denmark.

2. Domain Name:

The domain name in dispute is 1and1.co.uk.

3. Procedure:

The Complaint was received and forwarded to the Respondent by post and email on 12 June 2002. The emails were returned as undeliverable. No Response was received, and Nominet duly notified the parties on 4 July 2002 that it would appoint an Expert to determine the dispute on receipt from the Complainant of the applicable fee. The fee was received from the Complainant on 17 July 2002 and Jonathan Turner was appointed Expert on 25 July 2002. He has confirmed that he is independent of the parties and knows of no facts or circumstances which might call into question his independence in the eyes of the parties.

The Expert's review of the file has not identified any procedural deficiency, apart from the deficiencies of the Complaint identified below.

4. Facts and Contentions:

The full text of the Complaint (omitting formal parts) in the form in which it was received by Nominet is set out below:

"I confirm that Domain Name(s) in dispute are identical or similar to a name or mark in which I have Rights.

“I confirm that Domain Name(s) in the hands of the Respondent is an Abusive Registration.

“3. The domain name which is the subject of the dispute and in which the Complainant asserts it has Rights is oneandone.co.uk The name which is identical or similar is “www.1and1.co.uk”. The Complainant asserts that it has Rights as are recognised by English law in the domain name which it has registered both in respect of passing off and in respect of the following registered trade marks which are registered in the name of the Complainant’s holding company, 1&1 Internet AG, and which the Complainant is licensed to use (and which Rights the Complainant is permitted by the Complainant’s holding company to enforce): the mark “1&1” which is pending registration as a European Community mark, application for registration on 28th September 2000, and is also the subject of various registrations in the Federal Republic of Germany - applications for registration on 22nd December 1995, 30th July 1996 and 18th July 2000. “oneandone” which is pending registration as a mark in Great Britain, application for registration on 28th February 2002. “einsundeins” which is a mark registered in the Federal Republic of Germany, application for registration on 12th September 2000 “unetun” which is pending registration as a mark in France, application for registration on 2nd February 2001 4. The domain name registered in the name of the Respondent is used by a company incorporated in the UK with the name uk-2 Limited which trades as uk2.net and is a competitor of the Complainant. The domain name should be considered to be an Abusive Registration in the hands of the Respondent because it 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 and has been used in a manner which took unfair advantage of or was unfairly detrimental to the Complainant’s Rights in particular the use of the domain name represents an unfair competitive practice and an infringement of the Complainant’s rights in the registered trade marks which are owned by the Complainant’s parent company and which are used by the Complainant under licence from its parent company. 5. The Abusive Registration is evidenced by the fact that in 2001 uk-2 Limited used the domain name as a link to its own presence on the internet and only ceased use of the name following correspondence with the Complainant’s legal representatives at the time. The Complainant is a subsidiary of a company registered in the Federal Republic of Germany and has been active as a trading company in the UK for approximately two years. The German parent company is one of the largest internet service providers in the Federal Republic of Germany and intends in the very near future to commence business operations in the UK. It is feared that the current infringement of the Complainant’s Rights will directly result in a loss of trade both to the Complainant and to the Complainant’s parent company through the unfair and unlawful competitive practice of uk-2 Limited in using the name, the use of which has been made possible by the registration in the name of the Respondent. In particular it is probable that the use of the name by uk-2 Limited has confused and is likely to confuse people or businesses likely to trade with the Complainant and the Complainant’s parent company into believing that the

domain name is registered to, operated or authorised by, or otherwise connected with the Complainant or the Complainant's parent company and such confusion is likely to continue so long as the Abusive Registration is maintained. 6. The Complainant's parent company offered to purchase the domain name which is the subject of this application from the Respondent at the end of 2001 but received no response. The Complainant maintains that this lack of response indicates the intention of the Respondent to continue the use of the name for its own purposes. 7. The Complainant has already established itself by the use of the name "1&1" and become known to the public through the use of this name by its registration of its own domain name, "www.oneandone.co.uk", by its use of other similar domain names, "www.1and1.com", "www.one-and-one.co.uk" and "www.1-and-1.co.uk", by its use of its parent company's trade marks referred to above and further by the use of the name "1&1" in magazines and other publications in Great Britain."

5. Discussion and Findings:

To succeed in this Complaint, the Complainant has to prove on the balance of probabilities: first, that it has rights in respect of a name or mark identical or similar to the domain name in dispute; and, secondly, that in the hands of the Respondent the disputed domain name is an Abusive Registration as defined in §1 of Nominet UK's Dispute Resolution Service Policy ("the Policy").

In accordance with §16 of Nominet UK's Procedure for the conduct of proceedings under the Dispute Resolution Service ("the Procedure"), the Expert has to decide the complaint on the basis of the Parties' submissions, the Policy and the Procedure. It is not proper for the Expert to supplement the Parties' submissions by his own investigations or guesses.

Complainant's rights

As regards the first requirement, the Complainant alleges that it has rights (a) by virtue of various trade mark "registrations" of its parent company; (b) in respect of passing off; and (c) through its registration of a similar domain name.

As to (a), no documentary evidence of the trade mark "registrations" relied upon was attached to the Complaint, contrary to §3(x) of the Procedure, but it seems clear from the text of the Complaint that they are merely pending applications for registered trade marks. Had the trade marks actually been registered, the Expert might have been able to accept that the Complainant had rights in respect of them as a member of the proprietor's group of companies, in accordance with the recent decision of a Nominet Appeal Panel in *Seiko-shop.co.uk* and an earlier Expert decision in *montesa.co.uk*. However, pending applications for registered trade marks do not confer legal rights unless they are granted, and they may never be granted. In line with the decisions of a Nominet Expert in *aviance.co.uk* and of a WIPO Panel under a somewhat similar provision of the ICANN UDRP in *pointmail.com*, this Expert considers that pending

trade mark applications cannot be regarded as “rights” for the purpose of the Nominet Policy.

As to (b), no evidence of reputation is attached to the Complaint, again contrary to §3(x) of the Procedure. The Complaint states at §5 that the Complainant has been active as a trading company in the UK for approximately two years, but does not specify whether or how the Complainant has used a trading name similar to the Domain Name. The paragraph goes on to say that the Complainant’s parent company is one of the largest internet service providers in Germany and that it intends to commence operations in the UK in the very near future. Again, no details are given as to what name has been used by the parent company in Germany.

§7 of the Complaint states that the Complainant has already established itself and become known to the public through the use of “1&1” and similar names, including various domain names. However, it does not state or provide evidence that any of these names has become associated exclusively with the Complainant by a substantial number of members of the public, as is required to confer rights in goodwill protectable by an action for passing off. This Expert is not able to conclude on the basis of the Complaint that the Complainant has rights of this kind in a name similar to the Domain Name.

As to (c), the Complainant’s registration of the domain name “oneandone.co.uk” confers certain contractual rights in respect of that domain name under Nominet’s terms of registration, including in particular a right not to have the registration cancelled or transferred except in accordance with those terms. The rights required by the Policy are not limited to trade mark rights and this Expert is prepared to accept that they include contractual rights to a domain name. Furthermore, that domain name is obviously similar to the domain name in dispute.

On this narrow basis, this Expert concludes that the Complaint meets the first requirement. However, the fact that this is the only basis on which the Complainant has established relevant rights has implications for the second requirement.

Abusive registration

“Abusive Registration” is defined in §1 of the Policy as a domain name which was registered or acquired or which has been used in a manner which took unfair advantage of or was unfairly detrimental to the Complainant’s rights. The rights referred to are the rights which the Complainant has in a name or mark which is identical or similar to the disputed domain name. In this case, the only rights established by the Complaint are the Complainant’s contractual rights in respect of the domain name “oneandone.co.uk” under Nominet’s terms of registration.

The Complainant contends that abusive registration is evidenced by the fact that the disputed domain name has been linked to the presence on the internet of another internet service provider (ISP), uk-2 Limited, and that this only ceased following correspondence with the Complainant’s legal representatives. No details of the nature of the linkage are provided in the Complaint and copies of the correspondence are not attached, contrary to §3(x) of the Procedure.

Since the Complainant has not proven that it has any trade mark rights or goodwill under a name similar to the disputed domain name in relation to internet services, it is not in a position to rely on any unfair advantage of or detriment to such rights by confusion with a competing supplier of such services. The Complainant is only entitled to rely on unfair advantage of or detriment to its contractual rights in respect of a similar domain name. However, the linkage of a domain name to an internet presence of another party does not of itself take unfair advantage of or cause unfair detriment to the contractual rights of the holder of a similar domain name. These contractual rights are unaffected by the mere linkage of a similar domain name to a different website.

Even if it would be proper for the Expert to take into account the page of the website of UK2.net to which the disputed domain name currently resolves, this would not justify a finding of abusive registration. The Expert would also have to take into account the fact that the domain name appears to have been registered by the Respondent through UK2.net as its ISP and the widespread practice of leaving domain names pointing to the website of the ISP unless a specific website has been created. This use of the disputed domain name does not in itself take unfair advantage of or cause unfair detriment to the Complainant's contractual rights in a similar domain name.

Finally, even if this use of the domain name could be said to be abusive, the Complainant has not shown that the disputed domain name is an abusive registration in the hands of the Respondent, SSL, as is required by §2(a)(ii) of the Policy. This requirement implies some responsibility on the part of the Respondent for the objectionable use. It may perhaps be satisfied if the Respondent has failed to use its power as the holder to prevent an objectionable use which has been drawn to its attention. However, without seeing the correspondence to which the Complaint refers or knowing to whom it was addressed, it is not possible to determine whether SSL was made aware that its ISP had left the domain name pointing to the ISP's own website.

6. Decision:

In light of the above finding, that the disputed domain name, 1and1.co.uk, is not an Abusive Registration in the hands of the Respondent, the Expert decides that the Complaint should be rejected.

Jonathan Turner

Date